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

| | |
|---|---|
| Attorney Docket Number: 100.666US01 | |
| Application Number: 11/145,518 | Filing Date (or 371(b) or (f) Date): 6/3/2005 |
| Patent Number: 7,668,230 | Issue Date: 2/23/2010 |
| First Named Inventor: Robert S. Kroninger | |
| Title: NON-INTRUSIVE DIGITAL SUBSCRIBER LINE TRANSMIT ADJUSTMENT METHOD | |

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 / J. Patrick Kendrick / | Date August 17, 2010 |
| Name (Print/Typed) J. Patrick Kendrick | Registration Number 53109 |

***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

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www.uspto.gov

FOGG & POWERS LLC
5810 W 78TH STREET
SUITE 100
MINNEAPOLIS, MN 55439

Mail Date: 09/10/2010

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|---|---|---|
| **Applicant** | : Robert S. Kroninger | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7668230 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/145,518 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/03/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1097** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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

APR 29 2011

OFFICE OF PETITIONS

**LEE & HAYES, PLLC**
**601 W RIVERSIDE, SUITE 1400**
**SPOKANE, WA 99201**

In re Application of
**Edward K.Y. JUNG**, et *al.*
Application No. 11/145,547
Filed: June 3, 2005
Attorney Docket No. **QQ1-0054US**

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 January 25, 2011.

The request is **NOT APPROVED**.

The request to withdraw as attorney/agent of record and change of correspondence address is hereby not accepted. Petitioner has not complied with current USPTO requirements, set forth in 37 CFR 10.40 concerning Request for Withdrawal as Attorney and Change of Correspondence Address.

Petitioner has not properly submitted forwarding correspondence address information for the application.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71, or if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71 (c) states:

> ***An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73 (b) that is signed by a party who is authorized to act on behalf of the assignee.***

The Office will no longer change the correspondence address to that of a new practitioner unless the Request is accompanied by a power of attorney to a new practitioner (e.g., Form PTO/SB/82). All future communications from the Office will be directed to the above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address has been submitted.

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

Inquires concerning either the examination or status of the application should be directed to the Technology Center at (571) 272-3700.

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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L.C. BEGIN & ASSOCIATES, PLLC
510 HIGHLAND AVENUE
PMB 403
MILFORD, MI 48381

**MAILED**

NOV 04 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Masafumi Muramatsu, et al. | : | |
| Application No. 11/145,731 | : | ON PETITION |
| Filed: June 6, 2005 | : | |
| Attorney Docket No. 5754-00014 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 23, 2010, to revive the above-identified application.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of December 11, 2007. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). Since the amendment submitted does not prima facie place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b).

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 $1620; and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing application No. 12/075,578.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

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PMB 403
MILFORD, MI 48381

MAILED
MAY 23 2011
OFFICE OF PETITIONS

In re Application of
Masafumi Muramatsu, et al.
Application No. 11/145,731
Filed: June 6, 2005
Attorney Docket No. 5754-00014

ON PETITION

**CORRECTED DECISION**

This is a corrected decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 23, 2010, to revive the above-identified application.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of December 11, 2007. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). Since the amendment submitted does not prima facie place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b).

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 $1620; and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing applications No. 12/075,578 filed March 11, 2008 and 12/924,288 filed concurrently with this petition.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

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DELPHI TECHNOLOGIES INC
M/C 480-410-202
PO BOX 5052
TROY MI 48007

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SEP 08 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Long, et al. | : | |
| Application No. 11/145,765 | : | ON PETITION |
| Filed: June 6, 2005 | : | |
| Attorney Docket No. DP-312349 | : | |

This is in response to petition to revive under 37 CFR 1.137(b), filed August 18, 2011, and the RCE, filed August 19, 2011.

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

The above-identified application became abandoned for failure to file a proper response to the final Office action, mailed October 20, 2010, which set a shortened statutory period for reply of three months. No reply having been received, the application became abandoned on January 21, 2011. The Office mailed a Notice of Abandonment on June 1, 2011.

With the instant petition, petitioner paid the petition fee, made the proper statement of unintentional delay, and submitted the required reply in the form of an RCE (together with the required submission).

The application is being forwarded to Group Art Unit 2481 for consideration of the RCE, filed August 19, 2011.

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

Cliff Congo
Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03-25-11

TO SPE OF : ART UNIT 1639

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/145861 Patent No.: 7858323

CofC mailroom date: 03-01-11

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

Angela Green
Certificates of Correction Branch
(703) 756-1541

**Thank You For Your Assistance**

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

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

**Comments:** _____

Ardin H. Marschel 1/19/12

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

**SPE** **Art Unit**

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 7,235,992 | 2007-06-26 | 11/146,008 | 2005-06-07 | LKSP0166USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-09 |
| Name | Winston Hsu | Registration Number | 41526 |

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
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www.uspto.gov

In re Patent No. 7235992
Issue Date: June 26,2007
Application No. 11146008
Filed: June 7,2005
Attorney Docket No. 0941-1230PUS1

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

This is a decision on the electronic petition, filed April 9,2012 ,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 April 9,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

NOV 02 2010

OFFICE OF PETITIONS

**HANIFY & KING PROFESSIONAL CORP.**
**1055 THOMAS JEFFERSON, NW**
**SUITE 400**
**WASHINGTON DC 20007**

| | | |
|---|---|---|
| In re Application of | : | |
| Syuuichi MURATA. et al | : | |
| Application No. 11/146,076 | : | DECISION ON PETITION |
| Filed: June 7, 2005 | : | |
| Attorney Docket No. 5243-107-US01 | : | |

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 non-final Office action mailed, September 3, 2009, which set a shortened statutory period for reply of three (3) months. A three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on March 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 $1620; and (3) a proper 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 2618 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
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Finnegan Henderson Farabow Garrett Dunner LLP
901 New York Avenue NW
Washington DC 20001-4413

MAILED
DEC 08 2011
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,435,410 | : |
| Fleer et al. | : DECISION UPON REMAND AND |
| Issue Date: October 14, 2008 | : RECONSIDERATION OF |
| Application No. 11/146,077 | : PATENT TERM ADJUSTMENT |
| Filed: June 7, 2005 | : AND NOTICE OF INTENT |
| Attorney Docket No. 6832.0004-13 | : TO ISSUE CERTIFICATE OF CORRECTION |
| Title: Methods of Treatment with Interferon and Albumin Fusion Protein | : |

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 hundred and ninety-four (194) 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 hundred and ninety-four (194) 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

Adjusted PTA calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,435,410

DATED : October 14, 2008 **DRAFT**

INVENTOR(S) : Fleer 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 122 days

Delete the phrase "by 122 days" and insert – by 194 days--

# Patent Term Adjustments

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

Application Number*: 11146077. Search | Explanation of PTA Calculation | Explanation of PTE Calculation

## PTA Calculations for Application: 11146077

| | | | |
|---|---|---|---|
| Application Filing Date | 06/07/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | 10/14/2008 | Non-Overlapping USPTO Delays: | 220 |
| A Delays | 220 | PTO Manual Adjustment | 122 |
| B Delays | 0 | Applicant Delay (APPL) | 148 |
| C Delays | 0 | Total PTA (days) | 194 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 71 | 12/08/2011 | | P028 | Adjustment of PTA Calculation by PTO | 72 | | 0 |
| 62 | 10/14/2008 | 08/18/2008 | PTAC | Patent Issue Date Used in PTA Calculation | 57 | | 46 |
| 62.5 | 09/24/2008 | 06/07/2008 | PTA36M | PTA 36 Months | 0 | | 0 |
| 61 | 09/16/2008 | | EFDC | Export to Final Data Capture | | | 0 |
| 60 | 09/15/2008 | | D1935 | Dispatch to FDC | | | 0 |
| 59 | 09/15/2008 | | TCPB | Printer Rush- No mailing | | | 0 |
| 58 | 09/12/2008 | | MP025 | Mail-Record a Petition Decision of Granted for Patent Term Adjustment after Allowance | | | 0 |
| 57 | 09/12/2008 | | P025 | Record a Petition Decision of Granted for Patent Term Adjustment after Allowance | | | 0 |
| 57 | 09/12/2008 | | P025 | Record a Petition Decision of Granted for Patent Term Adjustment after Allowance | | | 0 |
| 56 | 08/30/2008 | | P028 | Adjustment of PTA Calculation by PTO | | 163 | 0 |
| 56 | 08/30/2008 | | P028 | Adjustment of PTA Calculation by PTO | | | 0 |
| 55 | 08/30/2008 | | P028 | Adjustment of PTA Calculation by PTO | | | 0 |
| 55 | 08/30/2008 | | P028 | Adjustment of PTA Calculation by PTO | 213 | | 0 |
| 53 | 07/21/2008 | | MM327-D | Mail PUB other miscellaneous communication to applicant | | | 0 |
| 52 | 07/18/2008 | | M327-D | PUB Other miscellaneous communication to applicant | | | 0 |
| 51 | 07/18/2008 | | N271 | Response to Amendment under Rule 312 | | | 0 |
| 49 | 05/28/2008 | | FIDC | Finished Initial Data Capture | | | 0 |
| 47 | 04/21/2008 | | PILS | Application Is Considered Ready for Issue | | | 0 |
| 48 | 04/18/2008 | | PET. | Petition Entered | | | 0 |
| 46 | 04/18/2008 | | N084 | Issue Fee Payment Verified | | | 0 |
| 45 | 04/18/2008 | | IFEE | Issue Fee Payment Received | | | 0 |
| 50 | 03/21/2008 | | A.NA | Amendment after Notice of Allowance (Rule 312) | | 120 | 0 |
| 44 | 02/26/2008 | | MM327-A | Mail Notice of drawing inconsistency with specification | | | 0 |
| 43 | 02/26/2008 | | M327-A | PUB Notice of drawing inconsistency with specification | | | 0 |
| 42 | 02/07/2008 | | CRFT | Sequence Forwarded to Pubs on Tape | | | 0 |
| 41 | 01/28/2008 | | EIDC | Export to Initial Data Capture | | | 0 |
| 40 | 01/23/2008 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 39 | 01/23/2008 | | IREV | Issue Revision Completed | | | 0 |
| 38 | 01/23/2008 | | DVER | Document Verification | | | 0 |
| 37 | 01/23/2008 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 36 | 01/23/2008 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 35 | 01/22/2008 | | CNTA | Allowability Notice | | | 0 |
| 31 | 01/02/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 30 | 12/20/2007 | 11/22/2007 | A.NE | Amendment after Final Rejection | | 28 | 28 |
| 29 | 12/20/2007 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 28 | 08/22/2007 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 27 | 08/20/2007 | | CTFR | Final Rejection | | | 0 |
| 24 | 06/11/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 26 | 06/06/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 25 | 06/06/2007 | 06/06/2007 | M844 | Information Disclosure Statement (IDS) Filed | | | 23 |
| 23 | 06/06/2007 | | A... | Response after Non-Final Action | | | 0 |
| 22 | 06/06/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 21 | 03/08/2007 | | MW/AC | Mail Notice of Withdrawn Action | | | 0 |
| 20 | 03/08/2007 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 19 | 03/05/2007 | | CTNF | Non-Final Rejection | | | 0 |
| 18 | 03/05/2007 | | W/AC | Withdrawing/Vacating Office Action Letter | | | 0 |
| 17 | 01/17/2007 | 08/07/2006 | MCTRS | Mail Restriction Requirement | 163 | | -1 |
| 16 | 01/08/2007 | | CTRS | Restriction/Election Requirement | | | 0 |
| 15 | 01/05/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 14 | 12/23/2005 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 13 | 12/23/2005 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 12.7 | 07/29/2005 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 12 | 07/29/2005 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |

| | | | | |
|---|---|---|---|---|
| 8 | 07/18/2005 | OIPE | Application Dispatched from OIPE | 0 |
| 7 | 07/18/2005 | COMP | Application Is Now Complete | 0 |
| 6 | 07/12/2005 | L128 | Cleared by L&R (LARS) | 0 |
| 5 | 06/20/2005 | L198 | Referred to Level 2 (LARS) by OIPE CSR | 0 |
| 4 | 06/19/2005 | CRFE | CRF Is Good Technically / Entered into Database | 0 |
| 3 | 06/15/2005 | SCAN | IFW Scan & PACR Auto Security Review | 0 |
| 11 | 06/07/2005 | RCAP | Reference capture on IDS | 0 |
| 10.7 | 06/07/2005 | M844 | Information Disclosure Statement (IDS) Filed | 0 |
| 10 | 06/07/2005 | WIDS | Information Disclosure Statement (IDS) Filed | 0 |
| 9 | 06/07/2005 | A.PE | Preliminary Amendment | 0 |
| 2 | 06/07/2005 | CRFL | CRF Disk Has Been Received by Preexam / Group / PCT | 0 |
| 1 | 06/07/2005 | IEXX | Initial Exam Team nn | 0 |

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MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

MAILED
MAY 20 2011
OFFICE OF PETITIONS

In re Application of :
Laitnen :
Application No. 11/146,154 : DECISION ON APPLICATION
Filed: June 7, 2005 : FOR PATENT TERM ADJUSTMENT
Attorney Docket No. **39700-800001US/NC** :
**40430US** :

This is in response to the "Application for Adjustment of Patent Term under 37 CFR 1.705(b)" filed May 4, 2011. Applicant requests that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from three hundred and forty-two (342) days to three hundred and fifty-seven (357) days.

The application for patent term adjustment is **GRANTED.**

The Office has updated the PALM and PAIR screens to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred and fifty-seven (357) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On February 7, 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 is 342 days. On May 4, 2011, applicant submitted the instant petition. Applicant maintains that the patent term adjustment indicated on the Determination of Patent Term Adjustment is incorrect and that the patent term adjustment at the time of the mailing of the Notice of Allowance should be 357 days. Applicant asserts that the Information Disclosure Statement filed April 15, 2010, contained a statement under 37 CFR 1.704(d), and is, therefore, no reduction to the patent term adjustment under 37 CFR 1.704(c)(8) is warranted for the filing thereof.

A review of the application history and of applicant's statement reveals that on December 9, 2009, a non-final Office action was mailed, to which applicant responded on March 31, 2010. On April 15, 2010, applicant filed an Information Disclosure Statement (IDS). A review of the IDS reveals that it contained the following statement:

> I hereby certify that each item of the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement [37 CFR 1.97(e)(1)]. Moreover, the item(s) of information contained in this information disclosure statement were first cited in the corresponding Chinese Action for the related Chinese Application No. 200680007421.0, which was communicated to Applicants' U.S. attorney on March 30, 2010. 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 under 37 CFR 1.704(d)…

*Excerpt taken from "Information Disclosure Statement", filed April 15, 2010, p. 1.*

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

> (c) 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:
>
> (8) 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 the supplemental reply or other such paper was filed.

The record does not support a conclusion that the Examiner expressly requested the filing of the IDS. However, further review of the Information Disclosure Statement filed April 15, 2010, revealed a statement that can be construed as conveying the meaning of the statement under 37 CFR 1.704(d).[1] Accordingly, pursuant to 37 CFR 1.704(c)(8), the period of reduction of 15 days will be removed.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is 357 days.

The $200.00 fee set forth under 37 CFR 1.18(e) is acknowledged.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

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

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[1] 37 CFR 1.704(d) provides that:

> (d) 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.

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

/Kenya A. McLaughlin/

Kenya A. McLaughlin
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*: 11146154 Search | Explanation of PTA Calculation | Explanation of PTE Calculation

## PTA Calculations for Application: 11146154

| | | | |
|---|---|---|---|
| Application Filing Date | 06/07/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 448 |
| A Delays | 448 | PTO Manual Adjustment | 15 |
| B Delays | 0 | Applicant Delay (APPL) | 106 |
| C Delays | 0 | Total PTA (days) | 357 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 88 | 05/19/2011 | | P028 | Adjustment of PTA Calculation by PTO | 15 | | 0 |
| 80 | 02/07/2011 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 79 | 02/04/2011 | | IREV | Issue Revision Completed | | | 0 |
| 78 | 02/04/2011 | | DVER | Document Verification | | | 0 |
| 77 | 02/04/2011 | | EX.A | Examiner's Amendment Communication | | | 0 |
| 76 | 02/04/2011 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 75 | 01/31/2011 | | CNTA | Allowability Notice | | | 0 |
| 74 | 11/29/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 71 | 11/29/2010 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 73 | 11/22/2010 | | AMPR | RCE- AF Processed | | | 0 |
| 72 | 11/22/2010 | 09/22/2010 | RCEX | Request for Continued Examination (RCE) | | 61 | 62 |
| 70 | 11/22/2010 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 69 | 11/22/2010 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 68 | 11/05/2010 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 67 | 11/04/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 66 | 10/14/2010 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 65 | 10/12/2010 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 64 | 09/17/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 63 | 09/16/2010 | | A.NE | Amendment after Final Rejection | | | 0 |
| 62 | 06/22/2010 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 61 | 06/20/2010 | | CTFR | Final Rejection | | | 0 |
| 57 | 04/26/2010 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 56 | 04/22/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 60 | 04/15/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 59 | 04/15/2010 | | RCAP | Reference capture on IDS | | | 0 |
| 58 | 04/15/2010 | 03/31/2010 | M844 | Information Disclosure Statement (IDS) Filed | | 15 | 53 |
| 55 | 04/15/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 54 | 04/14/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 53 | 03/31/2010 | 03/09/2010 | A... | Response after Non-Final Action | | 22 | 51 |
| 52 | 03/31/2010 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 51 | 12/09/2009 | 08/23/2009 | MCTNF | Mail Non-Final Rejection | 108 | | 41 |
| 50 | 12/07/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 49 | 10/30/2009 | | PA.. | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 48 | 10/23/2009 | | C.AD | Correspondence Address Change | | | 0 |
| 46 | 10/06/2009 | | MAPCR | Mail Appeals conf. Reopen Prosec. | | | 0 |
| 47 | 10/05/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 45 | 10/01/2009 | | APCR | Pre-Appeals Conference Decision - Reopen Prosecution | | | 0 |
| 44 | 04/23/2009 | | N/AP | Notice of Appeal Filed | | | 0 |
| 43 | 04/23/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 42 | 04/23/2009 | | AP.C | Request for Pre-Appeal Conference Filed | | | 0 |
| 41 | 04/23/2009 | 04/15/2009 | N/AP | Notice of Appeal Filed | | 8 | 39 |
| 40 | 04/23/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 39 | 01/15/2009 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 38 | 01/14/2009 | | CTFR | Final Rejection | | | 0 |
| 37 | 11/17/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 36 | 10/06/2008 | | A... | Response after Non-Final Action | | | 0 |
| 35 | 08/26/2008 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 34 | 07/10/2008 | 07/06/2008 | MCTNF | Mail Non-Final Rejection | 4 | | 25 |
| 33 | 07/09/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 26 | 03/19/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 24 | 03/19/2008 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 23 | 03/19/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 25 | 03/06/2008 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 22 | 03/06/2008 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 21 | 03/06/2008 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |

| | | | | | | |
|---|---|---|---|---|---|---|
| 20 | 01/11/2008 | | MCTFR | Mail Final Rejection (PTOL - 326) | | 0 |
| 19 | 01/07/2008 | | CTFR | Final Rejection | | 0 |
| 18 | 10/22/2007 | | FWDX | Date Forwarded to Examiner | | 0 |
| 17 | 10/09/2007 | | A... | Response after Non-Final Action | | 0 |
| 16 | 07/09/2007 | 08/07/2006 | MCTNF | Mail Non-Final Rejection | 336 | 0.5 |
| 15 | 06/25/2007 | | CTNF | Non-Final Rejection | | 0 |
| 14 | 08/29/2006 | | IDSC | Information Disclosure Statement considered | | 0 |
| 13 | 08/29/2006 | | RCAP | Reference capture on IDS | | 0 |
| 12.7 | 08/29/2006 | | M844 | Information Disclosure Statement (IDS) Filed | | 0 |
| 12 | 08/29/2006 | | WIDS | Information Disclosure Statement (IDS) Filed | | 0 |
| 11 | 08/22/2006 | | DOCK | Case Docketed to Examiner in GAU | | 0 |
| 10 | 03/22/2006 | | DOCK | Case Docketed to Examiner in GAU | | 0 |
| 9 | 01/30/2006 | | DOCK | Case Docketed to Examiner in GAU | | 0 |
| 8 | 08/31/2005 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | 0 |
| 7 | 08/31/2005 | | DOCK | Case Docketed to Examiner in GAU | | 0 |
| 5 | 07/08/2005 | | OIPE | Application Dispatched from OIPE | | 0 |
| 4 | 07/08/2005 | | COMP | Application Is Now Complete | | 0 |
| 6 | 06/27/2005 | | RQPR | Request for Foreign Priority (Priority Papers May Be Included) | | 0 |
| 3 | 06/21/2005 | | L194 | Cleared by OIPE CSR | | 0 |
| 2 | 06/16/2005 | | SCAN | IFW Scan & PACR Auto Security Review | | 0 |
| 1 | 06/07/2005 | | IEXX | Initial Exam Team nn | | 0 |
| 0.5 | 06/07/2005 | | EFILE | Filing date | | 0 |

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500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

MAILED

AUG 30 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | DECISION ON REQUEST |
| Joonsuk Kim | : | FOR RECONSIDERATION OF |
| Patent Number: 7,643,444 | : | PATENT TERM ADJUSTMENT |
| Issue Date: 01/05/2010 | : | and |
| Application No. 11/146394 | : | NOTICE OF INTENT TO ISSUE |
| Filing or 371(c) Date: 06/06/2005 | : | CERTIFICATE OF CORRECTION |
| Attorney Docket Number: 16548US02 | : | |

This is a decision on the petition filed on June 3, 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 fifty-seven (57) 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 thirty-four (34) days is **DISMISSED**.

Applicants request an additional one (1) day of patent term adjustment pursuant to 37 CFR 1.703(b), 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), June 7, 2008, and ending on the date a Request for Continued Examination ("RCE") was filed, July 23, 2008.

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 7, 2008 and ends on July 22, 2008, the day before the RCE was filed, and is 46 days. See, 35 U.S.C. 154(b)(1)(B)(i). As such, the patent term adjustment is 56 days, not 57 days.

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

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

/DLW/

Derek L. Woods/
Attorney
Office of Petitions

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PO BOX 37428
RALEIGH NC 27627

MAILED

SEP 08 2011

OFFICE OF PETITIONS

In re Application of
Michael Z. Sleva, et al.
Application No. 11/146,471
Filed: June 7, 2005
Attorney Docket No. 9023-21DV

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 19, 2011.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). The reasons set forth in the request, "Patent application assigned to new owner not represented by our firm", does not meet any of the conditions set forth in 37 CFR 10.40.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

There is an outstanding Office action mailed June 6, 2011 that requires a reply by applicant.

Telephone inquiries concerning this decision should be directed to undersigned at 571-272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

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

cc: MCG INTERNATIONAL INC.
C/O QUANTUM INNOVATIONS
1890 DEXWELL AVENUE
SUITE 201
HAMDEN, CT 06514

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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KILPATRICK TOWNSEND & STOCKTON LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

MAILED
APR 22 2011
OFFICE OF PETITIONS

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| In re Application of | : | |
| Gerardo V. Noriega et al | : | |
| Application No. 11/146,483 | : | DECISION ON PETITION |
| Filed: June 6, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 019635-000230US | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed March 28, 2011.

The request is **NOT APPROVED**.

A review of the file record indicates that Brad J. Loos does not have power of attorney in this patent application nor is there any statement or evidence of record of employment in or otherwise being engaged in the proceedings in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will continue to be directed to the above-listed address until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to Irvin Dingle at 571-272-3210.

Irvin Dingle
Petitions Examiner
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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**PROSKAUER ROSE LLP**
**ONE INTERNATIONAL PLACE**
**BOSTON MA 02110**

MAILED
JUN 23 2011
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| | | |
|---|---|---|
| In re Application of | : | |
| Kari-Pekka Wilska, et al. | : | |
| Application No. 11/146,507 | : | DECISION GRANTING PETITION |
| Filed: June 7, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 51020-012USC3 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, June 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 May 27, 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 Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 2617 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Terri Johnson/
Terri Johnson
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 | 11146522 |
| Filing Date | 07-Jun-2005 |
| First Named Inventor | Michael Tracey |
| Art Unit | 3766 |
| Examiner Name | LUTHER BEHRINGER |
| Attorney Docket Number | GYN5022USCIP1 |
| Title | SYSTEM AND METHOD FOR NERVE STIMULATION |

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 | /Cheryl F. Cohen/ |
| Name | Cheryl F. Cohen |
| Registration Number | 40361 |

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 10,2011

In re Application of :

Michael Tracey

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 11146522

Filed : 07-Jun-2005

Attorney Docket No : GYN5022USCIP1

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed May 10,2011 , 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 3766 for processing of the request for continuing examination under 37 CFR 1.114 .

Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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**KILPATRICK TOWNSEND & STOCKTON LLP**
**TWO EMBARCADERO CENTER**
**EIGHTH FLOOR**
**SAN FRANCISCO CA 94111-3834**

**MAILED**

FEB 25 2011

**OFFICE OF PETITIONS**

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| In re Application of | : | |
| Mark Abelson | : | |
| Application No. 11/146,652 | : | DECISION ON PETITION |
| Filed: June 07, 2005 | : | TO WITHDRAW |
| Attorney Docket No. **022092-000410US** | : | FROM RECORD |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 29, 2010.

The request is **APPROVED.**

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office 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 Kenneth E. Jenkins on behalf of all attorneys of record who are associated with customer No. 20350. All attorneys/agents associated with the Customer Number 20350 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

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

/Tredelle D. Jackson/
Paralegal Specialist
Office of Petitions

cc: **ISTA PHARMACEUTICALS**
**C/O JAMES CURRIE**
**15295 ALTON PARKWAY**
**IRVINE CA 92618**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : October 7, 2010

2010 11 23

TO SPE OF : ART UNIT 2863
SUBJECT : Request for Certificate of Correction for Appl. No/11/146672 /7321840

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:** _____

DREW A. DUNN
SUPERVISORY PATENT EXAMINER

2857

**SPE** **Art Unit**

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**WORKMAN NYDEGGER/MICROSOFT**
**1000 EAGLE GATE TOWER**
**60 EAST SOUTH TEMPLE**
**SALT LAKE CITY UT 84111**

MAILED

FEB 09 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| PARAMASIVAM, et al | : | |
| Application No. 11/146,714 | : | DECISION ON PETITION |
| Filed: June 7, 2005 | : | |
| Docket No. 13768.1273 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 6, 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, September 22, 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 December 23, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1620; and (3) and 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.

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

This application is being referred to Technology Center AU 2456 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
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**DITTHAVONG MORI & STEINER, P.C.**
**918 PRINCE STREET**
**ALEXANDRIA, VA 22314**

MAILED
MAR 15 2011
OFFICE OF PETITIONS

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| In re Application of | : | |
| Frank et al. | : | |
| Application No. 11/147,033 | : | DECISION ON PETITION |
| Filed: June 7, 2005 | : | |
| Attorney Docket No. P4229US03 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 8, 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 February 1, 2011, as required by the Notice of Allowance and Fee(s) Due mailed November 1, 2010. Accordingly, the application became abandoned on February 2, 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 $1510 and the publication fee of $300, (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) 272-6059.

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

A. Kelley

Alicia Kelley
Petitions Examiner
Office of Petitions

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Commissioner for Patents
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Alexandria, VA 22313-1450
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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA VA 22320-4850

**MAILED**

NOV 22 2010

**OFFICE OF PETITIONS**

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| In re Application of | : | |
| Shigeru Hirukawa | : | |
| Application No. 11/147,285 | : | DECISION GRANTING PETITION |
| Filed: June 8, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 124057 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 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 October 29, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2882 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 20 2010

OFFICE OF PETITIONS

**MUNCY, GEISSLER, OLDS & LOWE, PLLC**
**4000 LEGATO ROAD**
**SUITE 310**
**FAIRFAX, VA 22033**

| | | |
|---|---|---|
| In re Application: | : | |
| Zeyfang et al. | : | |
| Application No. 11/147,380 | : | NOTICE |
| Filed: June 8, 2005 | : | |
| Attorney Docket No. 3914-0114PUS1 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission filed on August 25, 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 application is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a 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 the undersigned at (571) 272-6059.

A. Kelley

Alicia Kelley
Petitions Examiner
Office of Petitions

cc: JAMES HELLWEGE
MUNCY, GEISSLER, OLDS & LOWE, PLLC
P O BOX 1364
FAIRFAX, VA 22038

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

MAILED
MAR 08 2011
OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Penhasi et al. | : | |
| Application No. 11/147,388 | : | DECISION ON PETITION |
| Filed: June 8, 2005 | : | |
| Attorney Docket No. 030231-0160 | : | |

This is a decision on the petition filed December 23, 2010, requesting under 37 CFR 1.182 that the acceptance of the terminal disclaimers filed November 19, 2009 be withdrawn.

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 1.182." Petitioners are advised that this is not a final agency decision.

Petitioners request that the terminal disclaimers, filed November 19, 2009, in response to the rejections based on obviousness-type double patenting made in the August 19, 2009 non-final Office action be withdrawn. Petitioners have not demonstrated that the circumstances of this application warrant the relief requested.

Inspection of the prosecution history of the instant application reveals that the terminal disclaimers were submitted to overcome rejections for obviousness-type double patenting over the several claims in U.S. Patent No. 5,840,332, U.S. Patent No. 6,632,451, U.S. Patent No. 6,231,888, and U.S. Patent No. 6,531,152. The first paragraph of page 13 of the remarks filed with amendment on November 19, 2009 clearly indicates applicants were intending to file the terminal disclaimers in order to overcome the obviousness-type double patenting rejections by the examiner.

It appears that petitioners are seeking to reopen the question of the propriety of the rejections made in the Office action of August 19, 2009. In essence, petitioners are attempting, by petition, to have the Office determine whether the double patenting rejections were proper. MPEP 1490 sets forth in pertinent part, "Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered."

It is the long-established policy of the Patent and Trademark Office to maintain the line of demarcation between petitionable and appealable subject matter. MPEP 1201. When the question of whether or not a given set of claims in one application or patent is distinct, or lies within the aegis of 35 U.S.C. 121, from another set of claims in another application or patent with respect to obviousness-type double patenting arises, that question relates to the merits of an invention, and the appropriate remedy for resolution of that issue ultimately lies by appeal as provided by statute. See e.g. In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). As noted by the court in In re Faust, 378 F.2d 966, 153 USPQ 813 (CCPA 1967) "the terminal disclaimer eliminates the necessity of considering what are most often exceedingly difficult questions. i.e., whether the subject matter of the appealed claims is obvious in view of the patent claims relied on as the basis for 'double patenting,' thus conserving judicial man hours both here and in the Patent Office." Further, it is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

Even assuming, *arguendo*, the relief requested should be considered on petition, petitioners are reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioners have failed to provide a reasonable, much less any, assurance that the public interest will, or can be, protected if the relief requested in this petition is given favorable consideration. In this regard, an applicant's use, and Office acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. See In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968). It is brought to petitioners' attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to Leggett v. Avery, 101 U.S. 246 (1879). While petitioners may now consider the previously filed disclaimers to be unnecessary, or unnecessarily limiting, petitioners are, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance(s) necessitating relief. Jentoft at 639 n. 6, 157 USPQ at 368 n. 6.

Petitioners had the opportunity to challenge the need for a terminal disclaimer, but instead freely chose to file a terminal disclaimer to avoid the rejection. Moreover, petitioners have provided no explanation as to why filing of the terminal disclaimers, as opposed to contesting the propriety of the rejection, was caused or contributed to by circumstances beyond petitioners' control. Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free dedication to the public contained in the previously filed terminal disclaimers by way of appeal, much less on petition. Cf. Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff'd. No. 84-1357 (Fed. Cir. June 14, 1985).

Petitioners may wish to take note of MPEP 1490 which states in part, "The filing of a continuation application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer."

The current Rule 182 fee is $400.00. Petitioners submitted only $130.00. Pursuant to petitioners' authorization, deposit account no. 19-0741 will be charged the $270.00 balance due.

The file is being forwarded to Technology Center 1793 for consideration of the RCE and amendment filed on December 23, 2010.

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

By internet: EFS-Web
www.uspto.gov/ebc/efs_help.html
(for help using EFS-Web call the
Patent Electronic Business Center
at (866) 217-9197)

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

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DICKSTEIN SHAPIRO LLP
1633 Broadway
NEW YORK NY 10019

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AUG 30 2011
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|---|---|---|
| In re Patent No. 7,474,883 | : | |
| Issue Date: January 6, 2009 | : | |
| Application No. 11/147,418 | : | DECISION ON PETITION |
| Filed: June 6, 2005 | : | |
| Attorney Docket No. I0046.0089 | : | |

This is a decision on the Request For Reconsideration, filed May 5, 2009, which is being treated as a Petition Under 37 CFR §3.81(b), to identify the correct assignee's residence (country). A completed Certificate of Correction Form (PTO/SB/44) was previously submitted.

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

Petitioner requests that the present Petition was submitted to correct the assignee's residence (country) 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 correct the assignee's residence (country) 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) previously submitted.

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. 7,474,883.

Cheryl Gibson Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

cc: DICKSTEIN SHAPIRO LLP
1177 Avenue of the Americas
New York, NY 10036-2714

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

BINGHAM MCCUTCHEN LLP
2020 K Street, N.W.
Intellectual Property Department
WASHINGTON DC 20006

MAILED
APR 13 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Brian MACLEAN et al. | : | |
| Application No. 11/147,522 | : | DECISION DISMISSING PETITIONS |
| Filed: June 8, 2005 | : | UNDER 37 CFR 1.78(a)(3) AND (a)(6) |
| Attorney Docket No. 7062012001 | : | |

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed February 10, 2011, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed nonprovisional and provisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED.**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;

**(2)** the surcharge set forth in § 1.17(t); and

**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The amendment is not acceptable as drafted since it improperly incorporates by reference the following prior-filed application: 11/122,712. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

> Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. See In re deSeversky, *supra*. *Note also* MPEP 201.06(c).

For the above-stated reasons, the petition is **DISMISSED**

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and a substitute amendment or an Application Data Sheet (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5) and (6)) to correct the above matters are required.

The petition fee of $1,410 required under 37 CFR 1.17(t) is being charged to petitioner's Deposit Account No. 50-4047 as authorized.

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

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

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

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to David Bucci at (571) 272-7099.

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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BINGHAM MCCUTCHEN LLP
2020 K Street, N.W.
Intellectual Property Department
WASHINGTON DC 20006

MAILED
AUG 29 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Brian MACLEAN et al. | : | |
| Application No. 11/147,522 | : | DECISION DISMISSING PETITIONS |
| Filed: June 8, 2005 | : | UNDER 37 CFR 1.78(a)(3) AND (a)(6) |
| Attorney Docket No. 7062012001 | : | |

This is a decision on the renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed July 22, 2011, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed nonprovisional and provisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED.**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;

**(2)** the surcharge set forth in § 1.17(t); and

**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The amendment filed July 22, 2011 claims priority to U.S. patent application No. 11/122,712 and U.S. provisional patent application No. 60/569,300. However, the examiner has indicated that the proposed amendment would not be entered. See the enclosed PTOL-303. Therefore, since the amendment does not prima facie place the application in condition for allowance, petitioner must now submit a request for continued examination (RCE) under the provisions of 37 CFR 1.114, or file a continuing application pursuant to the provisions of 37 CFR 1.53(b).

Any request for reconsideration of this decision must be accompanied by a cover letter entitled "Renewed Petition under 37 CFR 1.78(a)(3)" and must include the appropriate reply to continue prosecution of the instant application.

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

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

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

By fax: (571) 273-8300
ATTN: Office of Petitions

Any inquiries concerning this decision may be directed to David Bucci at (571) 272-7099. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

David Bucci
Petitions Examiner
Office of Petitions

Encl: Advisory Action Before the Filing of an Appeal Brief, PTOL-303

| Advisory Action Before the Filing of an Appeal Brief | Application No. 11/147,522 | Applicant(s) MACLEAN ET AL. | |
|---|---|---|---|
| | Examiner CATHERINE E. BURK | Art Unit 3735 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 22 July 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 Continuation Sheet*. (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: _____.

/Charles A. Marmor, II/
Supervisory Patent Examiner, Art Unit 3735

/C. E. B./
Examiner, Art Unit 3735

Continuation of 3. NOTE: Applicant has amended claim 3 to include the limitation "wherein the shaft comprises first and second consecutive curved sections on a single plane". This limitation was not included in the claims as previously filed and therefore would require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are contingent upon entry of the proposed amendment. Since the amendment has not been entered, applicant's arguments will not be addressed further at this time.

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SPRINKLE IP LAW GROUP / ZIMMER
1301 W. 25TH STREET
SUITE 408
AUSTIN, TX 78705

**MAILED**

MAR 14 2012

**OFFICE OF PETITIONS**

In re Application of
Brian Bergeron, et al.
Application No. 11/147,526
Filed: June 8, 2005
Attorney Docket No. 1292.1479103

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 25, 2012.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Sprinkle IP Law Group / Zimmer has been revoked by the assignee of the patent application on March 1, 2012. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to undersigned at 571-272-1642.

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

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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**SCHOX PLC**
**500 3rd Street, Suite 515**
**San Francisco CA 94107**

**MAILED**

SEP 26 2011

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Tom Faust, et al. | : | DECISION ON PETITION |
| Application No. 11/147,657 | : | TO WITHDRAW |
| Filed: June 8, 2005 | : | FROM RECORD |
| Attorney Docket No. REDW-P01 | : | |

This is a decision on the request to withdraw as attorney of record under 37 CFR § 1.36, filed August 29, 2011.

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: **REDWOOD RENEWABLES**
**6 ENDEAVOR DRIVE**
**CORTE MADERA, CA 94925**

UNITED STATES PATENT AND TRADEMARK OFFICE

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**SCHOX PLC**
**500 3rd Street, Suite 515**
**San Francisco, CA 94107**

MAILED
NOV 07 2011
OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Tom Faust | : | |
| Application No. 11/147,657 | : | DECISION ON PETITION |
| Filed: June 8, 2005 | : | TO WITHDRAW |
| Attorney Docket No. REDW-P01 | : | FROM RECORD |
| | : | |

This is a decision on renewed the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 30, 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. 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 Jeffrey Schox on behalf of all attorneys of record. All attorneys/agents have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Tom Faust at the address indicated below.

There is an outstanding Office action mailed August 18, 2011 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: **Tom Faust**
**6 Endeavor Drive**
**Corte Madera, CA 94925**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/147,657 | 06/08/2005 | Tom Faust | REDW-P01 |

**CONFIRMATION NO. 6546**

**POWER OF ATTORNEY NOTICE**

49142
SCHOX PLC
500 3rd Street, Suite 515
San Francisco, CA 94107

*OC000000050548830*

Date Mailed: 10/24/2011

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/30/2011.

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

/tsjohnson/

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

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

**JOHN BARGERO**
**P.O. BOX 471857**
**SAN FRANCISCO, CA 94123**

MAILED
MAR 26 2012
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Tom Faust, et al. | : | |
| Application No. 11/147,657 | : | DECISION ON PETITION |
| Filed: June 8, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 10/905723 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 29, 2012.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by John Bargero on behalf of all attorneys of record. All attorneys/agents have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Thomas Faust at the address indicated below.

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: **Thomas Faust**
**6 Endeavor Drive**
**Corte Madera, CA 94925**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/147,657 | 06/08/2005 | Tom Faust | 10/905723 |

**CONFIRMATION NO. 6546**

**POWER OF ATTORNEY NOTICE**

71997
John Bargero
P.O BOX 471857
SAN FRANCISCO, CA 94123

*OC000000053138744*

Date Mailed: 03/15/2012

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/29/2012.

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

/tsjohnson/

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

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MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO CA 94304-1018

MAILED
AUG 16 2010
OFFICE OF PETITIONS

In re Application of :
Adams, et al. :
Application No. 11/147,780 : ON APPLICATION FOR
Filed: June 7, 2005 : PATENT TERM ADJUSTMENT
Attorney Docket No. **146392006000** :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705" filed June 22, 2010, which is properly treated under 37 CFR 1.705(b). Applicants request that the determination of patent term adjustment be corrected from zero (0) days to four hundred and thirty (430) days. Applicants request this correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

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

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term 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].

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —
>
> (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

---

[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.

It is further noted that a Request for Continued Examination (RCE) was filed in this application on June 12, 2009.

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

To the extent that applicants 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 **granted, in part**.

The Office has updated the PALM and PAIR screens to reflect that the correct Patent Term Adjustment (PTA) determination at the time of mailing of the Notice of Allowance is twenty-five(25) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

Applicants assert the 35 day reduction to the patent term adjustment for the filing of a response on September 24, 2007, was improper. In summary, applicants state the response filed September 24, 2007, was expressly requested by the examiner and was therefore not a supplemental reply subject to a reduction of the patent term adjustment under 37 CFR 1.704(c)(8). Applicants are correct that the filing of the response on September 24, 2007, was not subject to a reduction to the patent term adjustment under 37 CFR 1.704(c)(8). However, the reduction is properly entered under 37 CFR 1.704(c)(7). The record reveals that a non- Office action was mailed February 20, 2007, to which applicants filed a response on August 20, 2007. On August 24, 2007, the Office mailed a Notice of Non-Compliant Amendment indicating that the response filed August 20, 2007, was not fully responsive to the Office action mailed February 20, 2007. Applicants filed an amendment on September 24, 2007. In this instance, the reduction to the patent term adjustment is calculated pursuant to 37 CFR 1.704(c)(7). It is noted that 37 CFR 1.704(c)(7) gives no consideration to whether the examiner requested the amendment to be filed.

37 CFR 1.704(c)(7) provides that:

> (c) 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 (§1.35(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 an ending on the date the reply or other paper correcting the omission was filed.

It is undisputed that the response filed August 20, 2007, contained an omission and that the response correcting the omission was not filed until September 24, 2007. Accordingly, pursuant to 37 CFR 1.704(c)(7), a period of reduction of thirty-five (35) days was entered as this period encompasses the period beginning on the day after the date the reply having an omission was filed, August 21, 2007, and ending on the date the reply correcting the omission was filed, September 24, 2007. The period of reduction of 35 days will not be removed, accordingly.

Applicants also argue that an additional patent term adjustment should be entered pursuant to 37 CFR 1.702(a)(2) and 37 CFR 1.703(a)(3). Specifically, applicants state that:

The Office mailed a Final Office Action on December 5, 2008. However, the Office withdrew the Final Office action and mailed a Supplemental Final Office action on March 13, 2009. The Supplemental Final Office Action replaces the Final Office action mailed on December 5, 2008, in its entirety. Office calculated 0 days of USPTO's delay. Applicants respectfully disagree with the USPTO's determination. Applicants calculate 75 days of USPTO's delay in accordance with 35 USC 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2) and 1.703(a)(2). As discussed below, this delay overlaps with the "B" delay.

*Excerpt taken from "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705" filed June 22, 2010,p. 3.*

Applicants' argument has been considered but is not persuasive. In light of the application history, it has been determined that no period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(2) is warranted. It is undisputed that the Office mailed an action under 35 U.S.C. 132 in the form of a final

Office action on December 5, 2008, within four months of the reply under 37 CFR 1.111 filed September 24, 2007. The subsequent mailing of another Office action under 35 U.S.C. 132 does not alter the date used in calculation of the period of adjustment. Pursuant to 35 U.S.C. 154(b)(1)(A)(ii), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after four months from the filing of the reply under 37 CFR 1.111 or appeal taken The fact that the Office later withdrew the non-final Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(2) on December 5, 2008. Further, the examiner does not have the authority to vacate, rescind, or withdraw an Office action. Unless vacated by the Technology Center Director, for purposes of calculating patent term adjustment, the action originally mailed by the examiner on December 5, 2008, will be used to calculate the amount of Office delay. Thus, it is correct for the Office to use the date of December 5, 2008, in calculating the period of adjustment, if any, due to the examination delay pursuant to 37 CFR 1.702(a)(2) and 37 CFR 1.703(a)(2). See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, no period of adjustment to the patent term pursuant to 37 CFR 1.702(a)(2) will be entered.

Applicants dispute the reduction to the patent term adjustment of 63 days for the filing of an Information Disclosure Statement (IDS) on March 1, 2010. Applicants maintain that the IDS contained a proper statement under 37 CFR 1.704(d) and is, therefore, not subject to a reduction to the patent term adjustment under 37 CFR 1.704(c)(8).

Applicants' argument has been considered but is well taken. A review of the application file history reveals that the reduction to the patent term adjustment of 63 days was entered pursuant to 37 CFR 1.704(c)(8) for the filing of an Information Disclosure Statement on March 1, 2010, 63 days after a response to a non-final Office action was filed on December 28, 2009. 37 CFR 1.704(c)(8) provides that:

> (c) 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:

(8) 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 the supplemental reply or other such paper was filed.

37 CFR 1.704(d) provides that:

(d) 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.

It is undisputed that the Information Disclosure Statement filed March 1, 2010, was filed 63 days after the response to the non-final Office action was filed on December 28, 2009. The record does not support a conclusion that the Examiner expressly requested the filing of the IDS. However, further review of the Information Disclosure Statement filed March 1, 2010, reveals the IDS did include the proper statement under § 1.704(d). Accordingly, the reduction to the patent term adjustment of 63 days is being removed.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is twenty-five (25) days (183 days of Office delay - 158 days of applicant delay).

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 in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

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) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM screen

PALM INTRANET

Day : Monday
Date: 8/9/2010
Time: 12:42:46

| PTA Calculations for Application: 11/147780 | | | |
|---|---|---|---|
| Application Filing Date: | 06/07/2005 | PTO Delay (PTO): | 183 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 221 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 25 |
| PTO Delay Adjustment: | 63 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 133 | 08/09/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 63 | | |
| 117 | 03/22/2010 | MAIL NOTICE OF ALLOWANCE | | | |
| 116 | 03/17/2010 | ISSUE REVISION COMPLETED | | | |
| 115 | 03/17/2010 | DOCUMENT VERIFICATION | | | |
| 114 | 03/17/2010 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 113 | 03/17/2010 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 112 | 03/15/2010 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 111 | 03/15/2010 | NOTICE OF ALLOWABILITY | | | |
| 110 | 03/11/2010 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 109 | 03/01/2010 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 63 | 98 |
| 108 | 03/01/2010 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 107 | 12/28/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 106 | 09/11/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 103 | 03/01/2010 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 102 | 12/28/2009 | REFERENCE CAPTURE ON IDS | | | |
| 101 | 12/28/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 100 | 09/11/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 99 | 01/07/2010 | DATE FORWARDED TO EXAMINER | | | |
| 98 | 12/28/2009 | RESPONSE AFTER NON-FINAL ACTION | | 31 | 94 |
| 97 | 12/28/2009 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 96 | 12/28/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 95 | 09/11/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 94 | 08/27/2009 | MAIL NON-FINAL REJECTION | | | |
| 93 | 08/27/2009 | NON-FINAL REJECTION | | | |
| 92 | 06/12/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 91 | 06/12/2009 | MISCELLANEOUS INCOMING LETTER | | | |
| 89 | 06/12/2009 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 88 | 06/12/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 84 |
| 87 | 06/15/2009 | DATE FORWARDED TO EXAMINER | | | |
| 86 | 06/12/2009 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 85 | 06/15/2009 | DATE FORWARDED TO EXAMINER | | | |
| 84 | 06/12/2009 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 83 | 06/15/2009 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 82 | 06/12/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 81 | 06/12/2009 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 80 | 06/04/2009 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 79 | 06/04/2009 | ADVISORY ACTION (PTOL-303) | | | |
| 78 | 05/13/2009 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 77 | 05/15/2009 | DATE FORWARDED TO EXAMINER | | | |
| 76 | 05/13/2009 | AMENDMENT AFTER FINAL REJECTION | | | |
| 75 | 04/13/2009 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 74 | 04/13/2009 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 73 | 03/13/2009 | MAIL SUPPLEMENTAL FINAL REJECTION | | | |
| 72 | 03/13/2009 | SUPPLEMENTAL FINAL REJECTION | | | |
| 69 | 12/05/2008 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 68 | 12/04/2008 | FINAL REJECTION | | | |
| 67 | 06/25/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 66 | 06/25/2008 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 65 | 10/02/2008 | DATE FORWARDED TO EXAMINER | | | |
| 64 | 08/28/2008 | RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES | | | |
| 63 | 08/28/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 59 | 08/22/2008 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |

| | | | | | |
|---|---|---|---|---|---|
| 58 | 08/19/2008 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 57 | 06/25/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 56 | 06/25/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 53 | 05/30/2008 | MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED) | 84 | | 47 |
| 52 | 05/27/2008 | CRF DISKETTE UNREADABLE / DID NOT COMPLY / REQUIRED BUT NOT SUBMITTED | | | |
| 48 | 03/12/2008 | DATE FORWARDED TO EXAMINER | | | |
| 47 | 11/07/2007 | RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES | | | |
| 46 | 11/28/2007 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 45 | 10/23/2007 | MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED) | | | |
| 44 | 10/22/2007 | CRF DISKETTE UNREADABLE / DID NOT COMPLY / REQUIRED BUT NOT SUBMITTED | | | |
| 43 | 10/02/2007 | DATE FORWARDED TO EXAMINER | | | |
| 42 | 09/24/2007 | RESPONSE AFTER NON-FINAL ACTION | | 35 | 36 |
| 41 | 09/17/2007 | CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE | | | |
| 39 | 08/24/2007 | MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT | | | |
| 38 | 08/20/2007 | SUBSTITUTE SPECIFICATION FILED | | | |
| 37 | 08/21/2007 | DATE FORWARDED TO EXAMINER | | | |
| 36.1 | 08/20/2007 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 36 | 08/20/2007 | RESPONSE AFTER NON-FINAL ACTION | | 92 | 34 |
| 35 | 08/20/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 34 | 02/20/2007 | MAIL NON-FINAL REJECTION | | | |
| 33 | 02/05/2007 | NON-FINAL REJECTION | | | |
| 32 | 11/23/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 31 | 04/21/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 30 | 07/13/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 29 | 12/28/2006 | DATE FORWARDED TO EXAMINER | | | |
| 28 | 12/14/2006 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 27 | 11/14/2006 | MAIL RESTRICTION REQUIREMENT | 99 | | -1 |
| 26 | 11/13/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 25 | 09/05/2006 | PRELIMINARY AMENDMENT | | | |
| 24 | 07/13/2006 | REFERENCE CAPTURE ON IDS | | | |
| 23.7 | 07/13/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 23 | 07/13/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 22 | 07/21/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 21 | 04/21/2006 | REFERENCE CAPTURE ON IDS | | | |
| 20.7 | 04/21/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 20 | 04/21/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 19 | 02/23/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 18 | 11/23/2005 | REFERENCE CAPTURE ON IDS | | | |
| 17.7 | 11/23/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 17 | 11/23/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 16 | 11/21/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 15 | 10/25/2005 | PRELIMINARY AMENDMENT | | | |
| 14 | 11/21/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 13 | 11/07/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 12 | 11/07/2005 | APPLICATION IS NOW COMPLETE | | | |
| 11 | 10/21/2005 | ADDITIONAL APPLICATION FILING FEES | | | |
| 10 | 06/07/2005 | CLAIM PRELIMINARY AMENDMENT | | | |
| 8 | 10/21/2005 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 7 | 07/22/2005 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 6 | 07/13/2005 | CLEARED BY L&R (LARS) | | | |
| 5 | 06/22/2005 | REFERRED TO LEVEL 2 (LARS) BY OIPE CSR | | | |
| 4 | 06/20/2005 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 3 | 06/18/2005 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 2 | 06/07/2005 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 1 | 06/07/2005 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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HOUSTON TX 77070

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application | : | DECISION ON APPLICATION |
| Solomon, et al. | : | FOR PATENT TERM ADJUSTMENT |
| Application No. 11/147,881 | : | AND NOTICE OF INTENT |
| Filed: June 8, 2005 | : | TO ISSUE |
| Patent No. 8,090,660 | : | CERTIFICATE OF CORRECTION |
| Issued: January 3, 2012 | : | |
| Docket No. 920-0147US/05.105.01 | : | |

This is a decision on the petition under 37 CFR 1.705(d), filed January 4, 2012. Patentees request that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one thousand nine hundred ninety-five (1995) days to one thousand nine hundred sixty-four (1964) days.

The application for patent term adjustment is **GRANTED**.

On January 3, 2012, the above patent issued with a patent term adjustment of one thousand nine hundred ninety-five (1995) days. The Office determined a patent term adjustment of 1995 days based on 701 days of "A" delay, 418 days of "B" delay, and 886 days of "C" delay, reduced by 10 days of Applicant delay.

Patentee points out that the Office should have calculated 31 days of overlapping delay between "A" delay and "B" delay. Applicants were assessed 701 days of "A" delay from August 9, 2006 to July 9, 2008. In addition, "B" delay was calculated from June 9, 2008 to January 3, 2012. "A" delay and "B" delay overlapped during the period from June 9, 2008 to July 9, 2008, or 31 days. Accordingly, the patent term adjustment should have

been reduced by these 31 days of overlap. The Office thanks Patentees for their good faith and candor in bringing this to the Office's attention.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **one thousand nine hundred sixty-four (1964) days** (701 days of "A" delay, plus 418 days of "B" delay, plus 886 days of "C" delay, reduced by 31 days of overlap between "A" and "B" delay and 10 days of applicant delay).

Receipt of the $200 fee for filing the instant application for patent term adjustment 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 **one thousand nine hundred sixty-four (1964)** days subject to any disclaimers.

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

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# DRAFT CERTIFICATE OF CORRECTION

PATENT : 8,090,660 B2

DATED : **January 3, 2012**

INVENTOR(S) : Solomon 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 1995 days.

Delete the phrase "by 1995 days" and insert – by 1964 days--

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20110808

**DATE** : August 08, 2011

**TO SPE OF** : ART UNIT 3695

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,555,456

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:**

/Thu Thao Havan/

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LUIS FIGARELLA
27 TODD ROAD
NASHUA NH 03064

| | | |
|---|---|---|
| In re Patent No. 7,241,384 | : | |
| Issue Date: July 10, 2007 | : | |
| Application No. 11/147,968 | : | DECISION ON PETITION |
| Filed: June 8, 2005 | : | UNDER 37 CFR 1.378(b) |
| Attorney Docket No. COLLAZO-0000 | : | |
| | : | |

This is a decision on the petition under 37 CFR 1.378(b), filed July 25, 2011, to accept an unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

The patent issued July 10, 2007. The first maintenance fee could have been paid from July 10, 2010, through January 10, 2011, or with a surcharge during the period from January 11, 2011 through July 10, 2011. Accordingly, the patent expired at midnight July 10, 2011, for failure to timely submit the first maintenance fee.

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

This petition lacks item (1) above.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 41(c)(1).

Petitioner states that the delay in payment of the 3 ½ year maintenance fee was unavoidable due to his lack of knowledge, statutes, rules, regulations and procedures of the United States Patent and Trademark Office at the time in question.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

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

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd dub nom.* That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. Id. As the patent holder at the time of expiration, it was incumbent on petitioner to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id.

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 Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 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 maintenance fee from patentee to the Office. See MPEP 2590.

However, the record fails to show that adequate steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of petitioner to schedule or pay the maintenance fee. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee.

Furthermore, the Letters Patent contains a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. Accordingly, a reasonably prudent patentee would have inquired to see if his/her patent was subject to maintenance fees.

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In essence, petitioner must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due to his financial condition until the petition was filed.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In

re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra. Put otherwise, the issues of petitioner's health and financial problems are immaterial in the absence of a showing that these, and not the lack of any steps in place to pay the fee, caused or contributed to the delay.

**ALTERNATIVE VENUE**

Petitioner should also note that since the maintenance fee was offered within 24 months of the date of expiration date of the patent, he has an alternate remedy under the unintentional provisions of 37 CFR 1.378(c) which does not require a showing of the delay in timely paying the maintenance fee in order to reinstate the patent. The $700 already submitted would be applied to the $1,640 fee owed under 37 CFR 1.378(c), leaving a balance due of $940.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f).** The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

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

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

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

By fax: (571) 273-8300
ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to April M. Wise at (571) 272-1642.

/dab/
David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LUIS FIGARELLA
27 TODD ROAD
NASHUA, NH 03064

MAILED
APR 03 2012
OFFICE OF PETITIONS

In re Patent No. 7,241,384 :
Issue Date: July 10, 2007 :
Application No. 11/147,968 : ON PETITION
Filed: June 8, 2005 :
Attorney Docket No. COLLAZO-0000 :

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

The petition is **GRANTED**.

This patent expired on July 10, 2011 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.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS MN 55402-2100

MAILED

NOV 21 2011

OFFICE OF PETITIONS

In re Patent No. 7,380,760 :
Issued: June 3, 2008 :
Application No.: 11/147,987 : NOTICE
Filed: June 7, 2005 :
Attorney Docket No. **3156.13US02** :

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

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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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**DLA PIPER LLP (US)**
**4365 EXECUTIVE DRIVE**
**SUITE 1100**
**SAN DIEGO CA 92121-2133**

**MAILED**
APR 16 2012
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| CARPENTER, et al | : | |
| Application No. 11/147,994 | : | DECISION ON PETITION |
| Filed: June 7, 2005 | : | TO WITHDRAW |
| Attorney Docket No. MEDIV2030-3 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 14, 2012 and March 29, 2012.

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 Lisa Haile on behalf of the attorneys of record associated with Customer No. 28213.

The attorneys of record associated with Customer No. 28213 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below until otherwise properly notified by the applicant.

Inquiries concerning this decision should be directed to the undersigned at (571) 272- 6735.

/Diane Goodwyn/
Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: MEDIVAS, LLC
P.O. BOX 33419
SAN DIEGO CA 92163

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/147,994 | 06/07/2005 | Kenneth W. Carpenter | MEDIV2030-3 |

**CONFIRMATION NO. 7168**

**POWER OF ATTORNEY NOTICE**

28213
DLA PIPER LLP (US)
4365 EXECUTIVE DRIVE
SUITE 1100
SAN DIEGO, CA 92121-2133

*OC000000053729618*

Date Mailed: 04/16/2012

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/14/2012.

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

/dcgoodwyn/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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**INTEGRAL DOCKET**
**304 INDIAN TRACE, #750**
**WESTON FL 33326**

**MAILED**

OCT 18 2011

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| AISENBREY | : | |
| Application No. 11/148,064 | : | DECISION ON PETITION |
| Filed: June 8, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 2200-0051-01 | : | 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 September 29, 2011.

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

A review of the file record indicates that the power of attorney to Douglas Schnabel, has been revoked by the assignee of the patent application on October 11, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

The correspondence address for future communications from the Office has been changed and the new correspondence address is the address copied below until otherwise properly notified by the applicant.

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

/Diane Goodwyn/
Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: REED SMITH LLP
2500 ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA, PA 19103

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/148,064 | 06/08/2005 | Thomas Aisenbrey | 2200-0051-01 |

**CONFIRMATION NO. 8199**

**POWER OF ATTORNEY NOTICE**

59874
Integral Docket
304 Indian Trace, #750
Weston, FL 33326

*OC000000050399702*

Date Mailed: 10/17/2011

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/11/2011.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

/dcgoodwyn/

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

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UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/148,064 | 06/08/2005 | Thomas Aisenbrey | 2200-0051-01 |

**CONFIRMATION NO. 8199**

**POA ACCEPTANCE LETTER**

7066
REED SMITH LLP
2500 ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA, PA 19103

*OC000000050399703*

Date Mailed: 10/17/2011

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/11/2011.

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.

/dcgoodwyn/

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

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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE., SUITE 2400
AUSTIN, TX 78701

**MAILED**

NOV 12 2010

**OFFICE OF PETITIONS**

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|---|---|---|
| In re Application of | : | |
| Allan D. Morrison | : | |
| Application No. 11/148,094 | : | DECISION ON PETITION |
| Filed: June 8, 2005 | : | TO WITHDRAW |
| Attorney Docket No. BSDR.P0008US | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed October 19, 2010.

The request is **APPROVED**.

A review of the file record indicates that Peter K. Zacharias: (1) does not have power of attorney in this patent application; and (2) has been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, Peter K. Zacharias has been withdrawn from the present application and may not prepare or submit papers under 37 C.F.R. § 1.34, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 C.F.R. § 1.32(b).

Telephone inquires concerning this decision should be directed to Irvin Dingle at 571-272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Peter K. Zacharias
One Logan Square
Philadelphia, PA 19103

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United States Patent and Trademark Office
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**SCHWEGMAN, LUNDBERG & WOESSNER, P.A.**
**P.O. BOX 2938**
**MINNEAPOLIS, MN 55402**

**MAILED**

DEC 20 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Sean KERR, et al | : | |
| Application No. 11/148,193 | : | DECISION ON PETITION |
| Filed: June 9, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 2579.030US1 | : | 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 23, 2010.

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

A review of the file record indicates that the power of attorney to David C. Peterson and the attorneys associated with Customer No. 21186, has been revoked by the assignee of the patent application on September 1, 2010. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

Telephone inquires concerning this decision should be directed to undersigned at 571-272- 6735.

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

cc: SYNTHES USA, LLC
1302 WRIGHTS LANE EAST
WEST CHESTER, PA 19380

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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MCDERMOTT WILL & EMERY LLP
600 13TH STREET, NW
WASHINGTON DC 20005-3096

MAILED
JUL 26 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. RE41245 | : | |
| Issue Date: April 20, 2010 | : | |
| Application No. 11/148,452 | : | ON PETITION |
| Filed: June 9, 2005 | : | |
| Attorney Docket No. 067161-0266 | : | |

This is a decision on the petition filed July 28, 2010, under 37 CFR 3.81(b)[1] to correct the assignee's name on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **granted.**

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3210. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

This application is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Irvin Dingle
Petitions Examiner
Office of Petitions

[1] See Official Gazette of June 22, 2004

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** 20101104

**DATE** : November 4, 2010

**TO SPE OF** : ART UNIT 2625

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 11/148678 Patent No.: 7,808,664

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**

**Magdalene Talley**

**Certificates of Correction Branch**

**(571)272-0XXX**

**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** /Twyler Haskins/ **Art Unit** 2625

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/26/10

TO SPE OF : ART UNIT 3764

SUBJECT : Request for Certificate of Correction for Appl. No.: 11148744 Patent No.: 7788823

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:** Okay to enter. /F.C.M./

_____ **SPE**

3764 **Art Unit**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Sandra Lee Lipkin
A Law Corporation
P.O. Box 3518
Ventura CA 93006-3518

MAILED
APR 04 2012
OFFICE OF PETITIONS

In re Patent No. 7,942,139 :
Issue Date: May 17, 2011 :
Application No. 11/148,780 : DECISION ON PETITION
Filed: June 8, 2005 :
Attorney Docket No. 500-001 :

This is a decision on the Request For Certificate Of Correction, which is being treated as a Petition Under 37 CFR §3.81(b), filed August 1, 2011, to accept the omission of 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 accept the omission of assignee's name and residence on the previously submitted PTOL-85B and such error was Applicant. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to accept the omission of 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), was submitted. However, the requisite $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), is required. Therefore, since the petition was accompanied deposit account authorization, the fee has been charged. 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.

Also, petitioner request corrections to be made in Claims 1 and 9, as well as in the Specification. Therefore, these corrections will be handled directly in the Certificate of Correction Branch.

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. 7,942,139.

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

**MICHAEL L. LEETZOW, P.A.**
**2393 CREST RIDGE CT**
**SANFORD FL 32771**

**MAILED**

AUG 04 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Piper Lumsden | : | |
| Application No. 11/148,797 | : | DECISION ON PETITION |
| Filed: June 9, 2005 | : | |
| Attorney Docket No. 20052018.01 | : | |

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 fee on or before April 9, 2009, as required by the Notice of Allowance and Fee(s) Due mailed January 9, 2009. Accordingly, the date of abandonment of this application is April 10, 2009. A Notice of Abandonment was mailed April 27, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $755.00; (2) the petition fee of $810.00; and (3) a proper statement of unintentional delay.

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

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

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

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
www.uspto.gov

**DATE:** February 14, 2012
**TO:** Certificates of Correction Branch
**FROM:** Philip Tucker
SPE, Art Unit 1745
**SUBJECT:** REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 8,101,244 as specified on the attached Certificate.

_/Philip C Tucker/_____
Philip Tucker, SPE
Art Unit 1745

# UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE

Patent No. 8,101,244
Patented: January 24, 2012

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:

Allan J. Clarke, David George Doughty, Frederick H. Fiesser, David Tainsh, Dwight Walker and David Wagner

/Philip C Tucker/_____
Philip Tucker
Supervisory Patent Examiner
Art Unit 1745

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. 7183158
Issue Date: February 27,2007
Application No. 11148851
Filed: June 8,2005
Attorney Docket No. JCLA13282

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

This is a decision on the electronic petition, filed April 5,2012 ,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 April 5,2012 . 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) |
|---|---|---|---|---|
| 7,183,158 | 2007-02-27 | 11/148,851 | 2005-06-08 | LKSP0150USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-05 |
| Name | Winston Hsu | Registration Number | 41526 |

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
WWW.USPTO.GOV

Paper No.

FOLEY HOAG, LLP (w/HUV HMV)
PATENT GROUP
155 SEAPORT BLVD.
BOSTON MA 02210-2600

MAILED

SEP 08 2010

OFFICE OF PETITIONS

In re Application of :
Verdine et al. :
Application No. 11/148,976 :
Patent No.: 7,786,072 :
Filed: June 9, 2005 :
Issued: August 31, 2010 :
Attorney Docket No.: HUV-034.02 :
Title: STABILIZED COMPOUNDS :
HAVING SECONDARY STRUCTURE :
MOTIFS :

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 April 30, 2010. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 C.F.R. § 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

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

Petitioner has identified the particular type of 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 $755 will be charged to Deposit Account no. 06-1448 in due course.

Your fee deficiency submission pursuant to 37 C.F.R. § 1.28(c) is hereby accepted. The petition is **GRANTED** accordingly.

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

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[1]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 02/07/11

**TO SPE OF** : ART UNIT 1776

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 11149019 Patent No.: 7753977

**CofC mailroom date:** 01/19/11

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**
**You can fax the Directors/SPE response to 571-270-9990**

**Certificates of Correction Branch**

*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:** OK TO ENTER

DUANE SMITH
SUPERVISORY PATENT EXAMINER

2-8-11

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 10 2010

OFFICE OF PETITIONS

**DILWORTH & BARRESE, LLP**
**1000 WOODBURY ROAD**
**SUITE 405**
**WOODBURY, NY 11797**

| | | |
|---|---|---|
| In re Application of | : | |
| Barrese et al. | : | |
| Application No. 11/149,127 | : | DECISION ON PETITION |
| Filed: June 9, 2005 | : | |
| Attorney Docket No. 298-296 | : | |

This is a decision on the petition, filed August 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 timely file a proper reply to the non-final Office action mailed January 20, 20010, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed August 3, 2010.

Petitioner asserts that a timely reply was filed on June 21, 2010, which included the following papers: a two (2) month extension of time and fee of $490, an Amendment and an Information Disclosure Statement.

A review of the file record indicates that a response including a two (2) month extension of time was received by the Office on June 21, 2010, which was the next business day of the end of the period for reply and therefore rendering the reply timely.

In view of the above, the holding of abandonment for failure to timely file a reply to the Office action of January 20, 2010, is hereby withdrawn and the application restored to pending status.

This application is being referred to Technology Center AU 3644 for appropriate action in the normal course of business on the reply filed June 21, 2010.

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

/Carl Friedman/
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
www.uspto.gov

**HEWLETT-PACKARD COMPANY**
**INTELLECTUAL PROPERTY ADMINISTRATION**
**3404 E. HARMONY ROAD**
**MAIL STOP 35**
**FORT COLLINS CO 80528**

**MAILED**

FEB 11 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Suermondt et al. | : | |
| Application No. 11/149,509 | : | ON PETITION |
| Filed: June 10, 2005 | : | |
| Attorney Docket No. 200404246-1 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed January 6, 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 the Issue Fee Transmittal with payment of the issue and publication fees, (2) the petition fee of $1620.00, and (3) a proper statement of unintentional delay.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

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

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

Liana Walsh
Petitions Examiner
Office of Petitions

cc: TROP PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

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

Z. Peter Sawicki
Westman, Champlin & Kelly, P.A
Suite 1400
900 Second Avenue South
Minneapolis MN 55402-3244

MAILED

SEP 13 2010

OFFICE OF PETITIONS

In re Application of
Gregory S. Kenton et al.
Application No. 11/149,569
Filed: June 10, 2005
Attorney Docket No. K92.12-0004

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 6, 2010, 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 November 18, 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 February 19, 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(s) (3).

The statement of delay is not acceptable. In this regard, petitioner's attention is directed to 37 CFR 1.33(b), which states.

> (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:
> (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
> (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
> (3) An assignee as provided for under §3.71(b) of this chapter; or
> (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment (or other paper) or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment (or other paper) is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

Therefore, as the petition is not signed by all the inventors and the record herein fails to disclose that petitioner herein (Gregory Kenton) was ever given a power of attorney to act on behalf of inventor Anthony J. Mertes, or that he is an assignee of the entire interest and has complied with the provisions of 37 CFR 3.73(b), the petition is considered to not contain a proper statement of unintentional delay.

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 571-272-4584

JoAnne Burke
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Z. Peter Sawicki
Westman, Champlin & Kelly, P.A
Suite 1400
900 Second Avenue South
Minneapolis MN 55402-3244

**MAILED**
DEC 14 2010
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Gregory S. Kenton et al. | : | |
| Application No. 11/149,569 | : | ON PETITION |
| Filed: June 10, 2005 | : | |
| Attorney Docket No. **K92.12-0004** | : | |

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed November 5, 2010, to revive the above-identified application.

The petition is hereby **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed November 18, 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 February 19, 2009.

An applicant cannot Request Continued Examination (RCE) of an application until after prosecution in the application is closed. See 37 CFR 1.114(a). Prosecution in an application is closed if the application is under appeal, or the last Office action is a final action (37 CFR 1.113), a notice of allowance (37 CFR 1.311), or an action that otherwise closes prosecution in the application (e.g., an Office action under Ex parte Quayle, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935)). *See 37 CFR 1.114(a).* Therefore, since the RCE has been prematurely filed it is deemed to be improper response and will not be entered. However, as the reply captioned as "RESPONSE" included therewith will be considered as the response to the non-final Office action of November 18, 2008.

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/arguments, (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 on August 6, 2010 was subsequent to the maximum extendable period for reply is unnecessary and will be credited to petitioner's deposit account. Similarly the RCE fees totaling $810 that were submitted on August 6, 2010, and November 5, 2010, will be credited to the petition credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4584 .

This application is being referred to Technology Center AU 3764 for appropriate action by the Examiner in the normal course of business.

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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ALLERGAN INC
2525 DUPONT DRIVE T2-7H
IRVINE CA 92612-1599

MAILED
DEC 17 2010
OFFICE OF PETITIONS

In re Application of :
Orilla, et al. :
Application No. 11/149,581 : ON PETITION
Filed: June 9, 2005 :
Attorney Docket No. 17778 (OCU) :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed November 16, 2010.

The petition is **GRANTED**.

This application was held abandoned for failure to timely file a response to the Notice of Non-Compliant Appeal Brief, mailed February 22, 2010. This Office action set an extendable period for reply of one (1) month. The Office mailed a Notice of Abandonment on September 28, 2010, stating that no reply had been received.

Petitioner contends that he did timely file a reply. In support, petitioner has included a copy of a USPTO Electronic Acknowledgment Receipt, dated June 22, 2010 and itemizing an Appeal Brief. In addition, a review of Office records reveals that the Office received the fee for a three month extension of time on June 22, 2010.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the Office of all items listed thereon on the date stamped thereon by the Office. See MPEP 503.

In view thereof, **THE HOLDING OF ABANDONMENT IS WITHDRAWN.**

The application is being forwarded to Group Art Unit 3736 for consideration of the Appeal Brief filed June 22, 2010 (copy re-supplied on petition dated November 16, 2010).

Telephone inquiries regarding 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**ENTELOS, INC.**
**C/O LAW OFFICES OF KAREN E. FLICK**
**P.O. BOX 515**
**EL GRANADA CA 94018-0515**

**MAILED**

OCT 22 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Georges Natsoulis | : | DECISION ON PETITION |
| Application No. 11/149,612 | : | TO WITHDRAW |
| Filed: June 10, 2005 | : | FROM RECORD |
| Attorney Docket No. ENTL-053.US1 | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 5, 2010.

The request is **NOT APPROVED**.

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

The request was signed by Karen E. Flick on behalf of all attorneys of record, but does not include a Customer Number. Accordingly, since the practitioners were appointed by a Customer Number, the Request must reflect withdrawal of practitioners associated with the same Customer Number.

Further, the Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> ***An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.***

According to a review of current USPTO records petitioner has not recognized the current recorded assignee concerning the above-identified application or the first listed inventor. NIH Office of General Counsel is not the current assignee of the above-identified application. Further, as there is currently no Statement under 37 CFR 3.73(b) of record in the instant application for the current assignee, the Office cannot change the correspondence address to the address on the Request to Withdraw. As such, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Currently, there is an outstanding Office action mailed June 23, 2010 that requires a reply.

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

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

Decision Date : January 10, 2012

In re Application of :

Jason Lacombe

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 11149652

Filed : 10-Jun-2005

Attorney Docket No : SVL920050048US1

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed January 10, 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 2454 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 |
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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 | 11149652 |
| Filing Date | 10-Jun-2005 |
| First Named Inventor | Jason Lacombe |
| Art Unit | 2454 |
| Examiner Name | JAMES BARON |
| Attorney Docket Number | SVL920050048US1 |
| Title | APPARATUS, SYSTEM, AND METHOD FOR FACILITATING COMMUNICATION BETWEEN AN ENTERPRISE INFORMATION SYSTEM AND A CLIENT |

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 | /Scott D. Thorpe/ |
| Name | Scott D. Thorpe |
| Registration Number | 54491 |

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OFFICE OF PETITIONS

**TIMOTHY G. ENDRES**
**21801 PEEPSOCK CIRCLE**
**HOUGHTON MI 49931**

| | | |
|---|---|---|
| In re Application of | : | |
| Timothy Gerard ENDRES, et al | : | |
| Application No. 11/149,759 | : | ON PETITION |
| Filed: March 9, 2005 | : | |
| Attorney Docket No. | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 19, 2010, 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, May 27, 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 August 28, 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(s) (3).

With respect to item (3): The statement of unintentional delay cannot be accepted because the statement signed by Applicant Mark H. Schwartz does not include the signature of Applicant Timothy G. Endres and the statement signed by Applicant Timothy G. Endres does not include the signature of Applicant Mark H. Schwartz. A review of the record does not indicate that either applicant was ever given power of attorney to act on behalf of the other applicant or that either is an assignee of the entire interest and has complied with the provisions of 37 CFR 3.73(b). Accordingly, the petition is considered to not contain a proper statement of

unintentional delay under 37 CFR 1.137(b), since the statements do not include the signature of both applicants.

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.

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

cc: MARK H. SCHWARTZ
4089 ABERDEEN COURT
ORCHARD LAKE, MI 48323

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OFFICE OF PETITIONS

**TIMOTHY G. ENDRES**
**21801 PEEPSOCK CIRCLE**
**HOUGHTON MI 49931**

| | | |
|---|---|---|
| In re Application of | : | |
| Timothy Gerard ENDRES. et al | : | |
| Application No. 11/149,759 | : | DECISION ON PETITION |
| Filed: June 9, 2005 | : | |
| Attorney Docket No. | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 15, 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, May 27, 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 August 28, 2009.

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

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 August 19, 2010, was subsequent to the maximum extendable period for reply, petitioner may request a refund of this fee by writing to the following address: Mail Stop 16, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

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

All other inquiries should be directed to the Technology Center at (571) 272-3600.

This application is being referred to Technology Center AU 3691 for appropriate action by the Examiner in the normal course of business.

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

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KILPATRICK TOWNSEND &
STOCKTON LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

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|---|---|
| In re Patent No. 7,630,851 | : DECISION ON |
| Wilcox, et al. | : REQUEST FOR RECONSIDERATION |
| Application No. 11/149,980 | : of PATENT TERM ADJUSTMENT |
| Issue Date: December 8, 2009 | : |
| Filed: June 10, 2005 | : |
| Attorney Docket No. 025867-000100US | : |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(d)", filed May 12, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected from one thousand one hundred thirty-five (1135) days to one thousand fifty-four (1054) days.

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

On December 8, 2009, the instant application matured into U.S. Patent No. 7,630,851 with a patent term adjustment of one thousand one hundred thirty-five (1135) days.

A review of Office records reveals that the patent term adjustment was correctly calculated as 1135 days. The Office determined a patent term adjustment of 1135 days based upon 690 days of "A" delay, plus 546 days of "B" delay, minus 81 days of applicant delay and 20 days of overlap between "A" and "B" delay. See 35 USC 154(b)(1)(B)(iii).

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

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

Anthony Knight
Director
Office of Petitions

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BARRY W. CHAPIN, ESQ.
CHAPIN INTELLECTUAL PROPERTY LAW, LLC
WESTBOROUGH OFFICE PARK
1700 WEST PARK DRIVE, SUITE 280
WESTBOROUGH MA 01581

In re Patent No. 7,406,626 :
Issue Date: July 29, 2008 :
Application No. 11/150,020 : NOTICE
Filed: June 10, 2005 :
Attorney Docket No. EMP04-96 :

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

Commissioner for Patents
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Alexandria, VA 22313-1450
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Hoffman, Wasson & Gitler, P.C.
Crystal Center 2 -Suite 522
2461 South Clark Street
Arlington VA 22202

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OFFICE OF PETITIONS

In re Application of
Comunale
Application No. 11/150,223
Filed: June 13, 2005
Atty. Dkt. No.: 05-0323

: DECISION ON PETITION

This decision is in response to the petition under 37 CFR 1.137(b), filed February 14, 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 August 17, 2007 for failure to timely reply to the non-final Office action mailed May 16, 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 December 18, 2007.

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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Hoffman, Wasson & Gitler, P.C.
Crystal Center 2 -Suite 522
2461 South Clark Street
Arlington VA 22202

MAILED
JUL 28 2011
OFFICE OF PETITIONS

In re Application of
Comunale
Application No. 11/150,223
Filed: June 13, 2005
Atty. Dkt. No.: 05-0323

: DECISION ON PETITION

This decision is in response to the renewed petition under 37 CFR 1.137(b), filed July 13, 2011.

The petition is **GRANTED**.

This application became abandoned August 17, 2007 for failure to timely reply to the non-final Office action mailed May 16, 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 December 18, 2007.

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 provisions set forth above.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, practitioner's signature appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If practitioner desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to practitioner, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

This application is being forwarded to Group Art Unit 2612 for further processing.

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

CC: Morris I. Pollack
19 Eberhardt Road
East Hanover, NJ 07936

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No.

F5 Networks, Inc.
c/o Frommer Lawrence & Haug LLP.
745 Fifth Avenue
NEW YORK NY 10151

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SEP 27 2010
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|---|---|
| In re Application of<br>Mukerji et al.<br>Application No. 11/150,361<br>Filed: June 9, 2005<br>Atty Docket No. 1361008-2026.1/10.121C1<br>Title: COALESCING ACKNOWLEDGEMENT RESPONSES TO IMPROVE NETWORK COMMUNICATIONS | DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT |

This is in response to the "REQEUST FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed September 7, 2010, which is being treated as a petition pursuant to 37 C.F.R. § 1.705(b). Applicant submits that the correct patent term adjustment to be indicated on the patent is nine hundred and fifteen (915) days, not five hundred and sixty-eight (568) 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.

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 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 he 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]

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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 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 regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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| In re Patent No. 7,333,270 | : | |
| Issue Date: February 19, 2008 | : | |
| Application No. 11/150,377 | : | NOTICE |
| Filed: June 10, 2005 | : | |
| Attorney Docket No. 292132-00011 | : | |

This is a notice regarding your request, August 19, 2011, for acceptance of a fee deficiency submission under 37 CFR 1.28.

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

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

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

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

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

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Krajec Patent Offices, LLC / Sandwave IP, LLC
1635 Foxtrail Drive, Suite 321
Loveland CO 80538

MAILED
MAR 26 2012
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Donald M. Bishop | : | |
| Application No. 11/150384 | : | |
| Filing or 371(c) Date: 06/11/2005 | : | DECISION ON |
| Attorney Docket Number: MEDI04US02 | : | PETITION |

This is a decision in response to the Petition to Revive Under 37 C.F.R. Section 1.137(b), filed February 12, 2012.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed June 21, 2011. The Office action set a shortened statutory reply period of three (3) months, and provided for extensions of time under 37 CFR 1.136(a). No reply having been received, the application became abandoned September 22, 2011. A Notice of Abandonment was mailed February 1, 2012.

Applicant files the present petition and includes an Amendment in response to the Office action. The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that the petition includes (1) the reply; (2) the petition fee; and (3) the required statement of unintentional delay. Accordingly, the reply is accepted as having been unintentionally delayed.

The application is being referred to Technology Center Art Unit 2467 for processing of the Amendment filed with the petition, in the normal course of business.

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

/DLW/

Derek L. Woods
Attorney
Office of Petitions

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CARGILL, INCORPORATED
P.O. Box 5624
MINNEAPOLIS MN 55440-5624

**MAILED**

MAR 28 2011

**OFFICE OF PETITIONS**

In re Application :
Brackenridge, et al. :
Application No. 11/150,593 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: June 10, 2005 :
Dkt. No.: CGL04/0107US :

This is in response to the application for patent term adjustment under 37 CFR 1.705(b), filed February 24, 2011.

Applicant submits that the correct patent term adjustment to be indicated on the patent is 830 days, not 733 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 application is entitled to an additional patent term adjustment of 97 days in accordance with 35 USC 154(b)(1)(A)(ii) in connection with the mailing of the Notice of Allowance mailed November 24, 2010.

The application for patent term adjustment is DISMISSED.

The application is not entitled to additional patent term adjustment in connection with the mailing of the Notice of Allowance on November 24, 2010 because the Notice of Allowance was mailed within four months of the date upon which the appeal brief was filed.

In accordance with 37 CFR 1.702(a)(2), 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 respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken.

In addition, 37 CFR 1.703(a)(4) states that the period of adjustment under 37 CFR 1.702 is the number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 41.37 of this title was filed and ending on the date of mailing of any of an examiner's answer under § 41.39 of this title, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

In this instance, a Notice of Appeal was filed April 19, 2010. An appeal brief was filed August 19, 2010. Thereafter, the Notice of Allowance was mailed within four months on November 24, 2010. Accordingly, the application is not entitled to adjustment pursuant to 37 CFR 1.702(a)(2) and 1.703(a)(4).

In view thereof, no adjustment to the patent term set forth in the Notice of Allowance will be made.

Receipt is hereby acknowledged of the required patent term adjustment application fee under 37 CFR 1.705(b) of $200.00. See, 37 CFR 1.18(e).

The application file 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) 272-3205.

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

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**VOLPE AND KOENIG, P.C.**
**UNITED PLAZA**
**30 SOUTH 17TH STREET**
**PHILADELPHIA, PA 19103**

MAILED
JUL 26 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **Martin J. ROTTER** | : | |
| Application No. 11/150,647 | : | DECISION ON PETITION |
| Filed: June 10, 2005 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. **ROT-PT042.3** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 17, 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 March 19, 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 June 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 a Request for Continued Examination (RCE) and fee of $405, 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 Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 3749for 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.

Ramesh Kishnamurthy

Ramesh Kishnamurthy
Petitions Examiner
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/150,666 | 06/10/2005 | James E. Selis | 1142-003 | 4191 |

25215 7590 08/13/2010
DOBRUSIN & THENNISCH PC
29 W LAWRENCE ST
SUITE 210
PONTIAC, MI 48342

| EXAMINER |
|---|
| TYSON, MELANIE RUANO |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3773 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/13/2010 | 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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DOBRUSIN & THENNISCH PC
29 W LAWRENCE ST
SUITE 210
PONTIAC MI 48342

| | |
|---|---|
| In re Application of: | |
| SELIS, JAMES E. | |
| Serial No. 11/150,666 | |
| Filed: June 10, 2005 | DECISION ON PETITION |
| Docket: 1142-003 | UNDER 37 CFR § 1.181 |
| Title: BIOPSY DEVICES AND METHODS | |

This is a decision on the petition filed July 29, 2010 under 37 CFR 1.181 requesting withdrawal of the finality of the last Office action mailed June 15, 2010.

The petition is **Granted.**

In finding petitioner's points of argument persuasive and after consulting with the examiner, the requested relief is granted. As such, the finality of the Office action issued on June 15, 2010 is premature and thus the finality of the action is hereby withdrawn. The Office action mailed on June 15, 2010 will be designated as non-final Office action. The period to respond to the last Office action of June 15, 2010 remains unchanged. Since the finality is being withdrawn, any amendment responding to the Office action dated June 15, 2010 will be treated as a 37 CFR § 1.111 amendment.

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3773 awaiting the applicant's response to the outstanding Office action of June 15, 2010. Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION GRANTED.

Angela D. Sykes

Angela D. Sykes, Director
Technology Center 3700

**Doc Code: PET.PTA.RCAL**
**Document Description: Request for Recalculation in view of Wyeth**

PTO/SB/131 (01-10)
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: 1103-006-010C-000000 | Patent Number: 7,668,068 B2 |
| Filing Date (or 371(b) or (f) Date): June 9, 2005 | Issue Date: February 23, 2010 |
| First Named Inventor: Bran Ferren | |
| Title: ROTATION RESPONSIVE DISK ACTIVATION AND DEACTIVATION MECHANISMS | |

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 /Eleanor V. Goodall/ | Date August 17, 2010 |
| Name (Print/Typed) Eleanor V. Goodall | Registration Number 35,162 |

***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.*

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Searete LLC
Suite 110
1756-114th Ave. S.E.
Bellevue, WA 98004

Mail Date: 08/26/2010

| | | |
|---|---|---|
| **Applicant** | : Bran Ferren | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7668068 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/150,823 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/09/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1216** 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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BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

**MAILED**

SEP 14 2010

**OFFICE OF PETITIONS**

In re Application of
Barrie Hart, et al.
Application No. 11/150,836
Filed: June 10, 2005
Attorney Docket No. ARSI-055CON

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 5, 2010.

The request is **NOT APPROVED**.

The Office will not decide request to withdraw from representation as practitioner of record which are filed after the application has gone abandoned. Sections 2540 and 2542 of the Manuel of Patent Procedures (MPEP explain that a practitioner does not have to request permission to withdraw as practitioner of record under 37 CFR 1.36 in order to change the address in a patented filed and to directed notices, receipts and other communications relating to maintenance fees. These requests will be placed in the application but will not be treated on their merits. The above mentioned sections of the MPEP recommend the designation of a fee address or submission of a change in correspondence address in the patented file for directing correspondence relating to maintenance fee payments and other correspondences after issuance. See Form PTO/SB/47, entitled, *"Fee Address" Indication Form* and Form PTO/SB/123, entitled, *Change of Correspondence Address, Patent*

Accordingly, the request to withdraw from record cannot be approved the application has gone abandoned. Further the request cannot be approved because the request does not include an acceptable current correspondence address for future communications from the Office.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to undersigned at 571-272-1642.

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: —

DATE : 3/23/2011

TO SPE OF : ART UNIT 2885

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/150843 Patent No.: 7845821 B2

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**

**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:** _____

JONG-SUK (JAMES) LEE
SUPERVISORY PATENT EXAMINER

**SPE** — 2885 **Art Unit**

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AUG 02 2010

OFFICE OF PETITIONS

Robert D. Buyan, Stout, Uxa,
Buyan & Mullins,
LLP/Acclarent, Inc.
4 Venture
Suite 300
Irvine CA 92618

| | | |
|---|---|---|
| In re Application of | : | |
| Chang et al. | : | |
| Application No. 11/150,847 | : | |
| Filed: June 10, 2005 | : | ON APPLICATION FOR |
| Attorney Docket No. ACLRT-038B | : | PATENT TERM ADJUSTMENT |
| Title: DEVICES, SYSTEMS AND | : | |
| METHODS USEABLE FOR TREATING | : | |
| SINUSITIS | : | |

This is in response to the "APPLICATION FOR (RECALCULATED) PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. §1.705" filed March 18, 2010. This request is properly treated under 37 CFR 1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is one thousand nine hundred twenty-seven (1,927) days, not one thousand forty-five (1,045) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

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

The $200.00 petition fee set forth in 37 CFR 1.18(e) has been assessed to deposit account no. 50-0878. 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].

---

[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

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

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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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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/150,872 | 06/10/2005 | Zheng Jason Geng | 40398-0015 | 3426 |

20480 7590 08/04/2010
STEVEN L. NICHOLS
Van Cott, Bagley, Cornwall & McCarthy
36 South State Street
SUITE 1900
SALT LAKE CITY, UT 84111

| EXAMINER |
|---|
| STREGE, JOHN B |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2624 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/04/2010 | PAPER |

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

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

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MAIL

AUG 04 2010

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

STEVEN L. NICHOLS
Van Cott, Bagley, Cornwall & McCarthy
36 South State Street
Suite 1900
Salt Lake City UT 84111

In re Application of
Geng, Zheng Jason *et al.*
Serial No.: 11/150,872
Filed: June 10, 2005
For: **METHODS AND SYSTEMS FOR A THREE DIMENSIONAL FACIAL RECOGNITION SYSTEM**

DECISION ON PETITION
*ACCEPTANCE OF COLOR DRAWINGS*

This is a decision on the petition under 37 CFR §1.84(a)(2) filed September 10, 2008, requesting the acceptance of color drawings.

The petition requests that the color drawings identified in Figures 1, 3-5, 7-10, 13A, 13B , 14-17, 18A, 18B, 18C & 18D 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 file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."*

The petition is **GRANTED**.

Doris To
Quality Assurance Specialist
Technology Center 2600
Communications

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Commissioner for Patents
United States Patent and Trademark Office
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Paper No.

Cislo & Thomas LLP
1333 2nd Street
Suite #500
Santa Monica CA 90401-4110

MAILED
MAY 17 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Morgan et al. | : | |
| Application No. 11/150,909 | : | DECISION ON PETITION |
| Filed: June 13, 2005 | : | PURSUANT TO |
| Attorney Docket No.: 08-21944 | : | 37 C.F.R. § 1.137(B) |
| Title: COMBINATION DEHYDRATOR, DRY RETURN AIR AND CONDENSED WATER GENERATOR/DISPENSER | : | |

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(b), filed January 26, 2011, 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 reply in a timely manner to the non-final Office action, mailed June 11, 2010, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 12, 2010. A notice of abandonment was mailed on May 9, 2011, subsequent to the filing of this petition.

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

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in 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, Petitioner has submitted an amendment, the petition fee, and the proper statement of unintentional delay.

As such, the first three requirements 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.[1]

Petitioner has also submitted a five-month extension of time. An extension of time under 37 C.F.R. § 1.136 must be filed prior to the expiration of the maximum extendable period for reply.[2] Accordingly, since the $1175 extension of time submitted with the petition on January 26, 2011 was filed subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to Deposit Account number 03-2030 in due course.

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's support staff will notify the Examiner of this decision, so that the amendment that was received on January 26, 2011 can be processed in due course.

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 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.**

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1 See Rule 1.137(d).
2 See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[3] All other inquiries concerning this application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/150,975 | 06/13/2005 | Ram W. Sabnis | CTCT-036/US | 5715 |

38824 7590 09/02/2010
FULBRIGHT & JAWORSKI L.L.P.
Attn: MN IP Docket
600 Congress Avenue
Suite 2400
Austin, TX 78701

| EXAMINER |
|---|
| ASDJODI, MOHAMMAD REZA |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1796 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 09/02/2010 | 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

Mailed: 9/2/10

Re application of:
Ram W. Sabnis et al
Serial No.: 11/150,975
Filed: June 13, 2005
For: COMPOSITION AND METHOD FOR PRODUCING COLORED BUBBLES

DECISION ON PETITION

This is a decision on the PETITION UNDER 37 C.F.R. 1.84(a)(2) TO ACCEPT COLOR DRAWINGS filed June 13, 2005. The petition includes (1) the fee as required by 37 CFR 1.17(h), (2) three sets of the color photographs, (3) an amendment to the specification which includes the language set forth in 37 CFR 1.84(a)(2)(iii), and (4) an explanation stating why color photographs are necessary.

A review of the application record indicates that all of the requirements for acceptance of color photographs have been met.

The Petition is **GRANTED**.

Roy King
Supervisory Patent Examiner
Group Art Unit 1793

FULBRIGHT & JAWORSKI L.L.P
Attn: MN IP Docket
600 Congress Avenue
Suit 2400
Austin, TX 78701

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) |
|---|---|---|---|---|
| 7215790 | 2007-05-08 | 11151083 | 2005-06-13 | P03999US21 |

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 D. Harty/ | Date (YYYY-MM-DD) | 2011-07-14 |
| Name | Jeffrey D. Harty | Registration Number | 40639 |

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. 7215790
Issue Date: May 8,2007
Application No. 11151083
Filed: June 13,2005
Attorney Docket No. P03999US21

:

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

:

This is a decision on the electronic petition, filed July 14,2011 ,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 July 14,2011 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

MAILED
FEB 15 2011
OFFICE OF PETITIONS

In re Application of
Ashwin Sampath et al.
Application No. 11/151,104
Filed: June 13, 2005
Attorney Docket No. **TI-38921**

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 5, 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, March 30, 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 July 1, 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.

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 JoAnne Burke at (571) 272-4584.

This application is being referred to Technology Center AU 2611 for appropriate action by the Examiner in the normal course of business on the reply received.

JoAnne Burke
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

MAILED

DEC 02 2010

OFFICE OF PETITIONS

In re Application of :
Shore, et al. :
Application No. 11/151,135 : ON APPLICATION FOR
Filed: June 13, 2005 : PATENT TERM ADJUSTMENT
Atty Docket No. 16492US02 :

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 C.F.R. § 1.705), filed September 30, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is one thousand two hundred fifty-three (1253) days, not six hundred eighty (680) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

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

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). 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 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].

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).

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[1] 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.

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
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
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OFFICE OF PETITIONS

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

| | | |
|---|---|---|
| In re Patent of Shore et al. | : | DECISION ON REQUEST |
| Patent No. 7,864,681 | : | FOR RECONSIDERATION OF |
| Issued: January 4, 2011 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/151,135 | : | and |
| Filed: June 13, 2005 | : | NOTICE OF INTENT TO ISSUE |
| Atty Docket No. 16492US02 | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on March 1, 2011, which is being treated as a petition under 37 C.F.R. § 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 thirty-three (1233) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The patent term adjustment is corrected to indicate that the term of the above-identified patent is extended or adjusted by **one thousand one hundred ninety-four (1194)** days.

Patentees dispute the period of B delay. 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 607 days, which is the number of days beginning on June 14, 2008, the day after the date three years after the filing date, and ending on February 10, 2010, the day before the date the RCE was filed. A period of 10 overlapping days is subtracted from the maximum B delay period.

In addition, 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 period consumed by appellate review begins on September 24, 2009, the date of filing of the notice of appeal and ends on November 24, 2009, which is the date of the subsequent mailing of an Office action (not a panel review) and is 62 days. Thus, the B delay period is 535 days (607-10-62) days.

Patentees dispute the length of the 97 day period of Applicant delay associated with the submission of a Rule 312 amendment on September 30, 2010, after the mailing of a notice of allowance on July 23, 2010.

However, the reduction should be 21 days, not 20 days as calculated by applicants.

> 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;

A notice of allowance was mailed on September 30, 2010. Pursuant to 37 CFR 1.704(c)(10), the Office should have entered a period of reduction of 21 days, counting the number of days in the period beginning on September 30, 2010, the Rule 312 amendment was filed, and ending on and including October 20, 2010, the date the Office mailed correspondence addressing the September 30, 2010 Rule 312 amendment. Accordingly, the period of reduction of 97 days is being removed and a period of reduction of 21 days will be entered in connection with the filing of a Rule 312 amendment on September 30, 2010.

In view of the above, the patent term adjustment is being increased to 1194 (680 days of A delay + 535 days of B delay - 21 days of Applicant delay) 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.

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.

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 one hundred ninety-four (1194)** 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 : 7,864,681 B2

DATED : **January 4, 2011** **DRAFT**

INVENTOR(S) : Shore 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 1128 days

Delete the phrase "by 1128 days" and insert – by 1194 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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POTOMAC PATENT GROUP PLLC
P. O. BOX 270
FREDERICKSBURG VA 22404

**MAILED**

NOV 02 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| John Rhoades | : | |
| Application No. 11/151,271 | : | NOTICE |
| Filed: June 14, 2005 | : | |
| Attorney Docket No. 0120-025D1 | : | |

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 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

**PVF – RAMBUS, INC.**
**C/O PARK, VAUGHAN, FLEMING & DOWLER LLP**
**2820 FIFTH STREET**
**DAVIS CA 95618-7759**

MAILED
JAN 05 2012
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| John Rhoades | : | |
| Application No. 11/151,271 | : | DECISION GRANTING PETITION |
| Filed: June 14, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. R-RA0935.P1D1.US | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 4, 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 on December 12, 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) 272-3208.

This application is being referred to Technology Center AU 2158 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.*

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 11/13/11

TO SPE OF : ART UNIT 2617

SUBJECT : Request for Certificate of Correction for Appl. No.: 11151497 Patent No.: 7904113

CofC mailroom date: 11/01/11

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 to claim 2 and 6 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:** The request for Certificate of Correction filed 11/1/2011 is approved

George Eng

GEORGE ENG
SUPERVISORY PATENT EXAMINER

2617

**SPE** **Art Unit**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 6/30/11

**TO SPE OF** : ART UNIT 1761

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 11151563 Patent No.: 7651990

**CofC mailroom date:** 06/20/11

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**
[redacted]

**Note:** _____

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.

| | |
|---|---|
| **xApproved** | **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

/Harold Y. Pyon/ SPE
1761

SPE Art Unit

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Alexandria, VA 22313-1450
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500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

MAILED
DEC 03 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,746,846 | : | |
| Boora et al. | : | DECISION ON REQUEST FOR |
| Issue Date: June 29, 2010 | : | RECONSIDERATION OF |
| Application No. 11/151,614 | : | PATENT TERM ADJUSTMENT AND |
| Filed: June 13, 2005 | : | NOTICE OF INTENT TO ISSUE |
| Atty Docket No. 16491US02 | : | CERTIFICATE OF CORRECTION |

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 August 30, 2010. Patentee requests that the patent term adjustment for the above-identified patent be set at one thousand three hundred ninety-seven (1397) days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **one thousand three hundred eighty-five (1385) days**.

Patentee asserts that the period of reduction under 37 CFR 1.704(c)(10) for filing an amendment under § 1.312 on May 7, 2010, should be 6 days instead of 7 days.

Pursuant to 37 CFR 1.704:

> (c) 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 adjustment set forth in § 1.703 shall be reduced by the lesser of:
> >
> > > (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
> > >
> > > (ii) Four months

The period under 37 CFR 1.704(c)(10) is counted beginning on the date the amendment under § 1.312 was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 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.

In this instance, the period of reduction under 37 CFR 1.704(c)(10) of 7 days for filing the amendment under § 1.312 on May 7, 2010, is correct. The record reveals that the Office took action in response to the filing of amendment under § 1.312 on May 13, 2010. Accordingly, the period of adjustment of the term of the patent was properly reduced by 7 days (not 6 days), counting the period beginning on the date the amendment under § 1.312 was filed, May 7, 2010, and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312, May 13, 2010.

Next, patentee disputes the B delay period. Specifically, patentee asserts:

> The USPTO calculation of the patent term adjustment under the three-year deadline for issuing a patent after its filing date was 711 days. The Applicant disagrees with this determination because the patent term adjustment on this ground should instead be 746 days, minus 13 days consumed by an appeal, for a net adjustment of 733 days.
>
> Specifically, the enclosed modified version of the USPTO Patent Term Adjustment calculation on PAIR shows that:
>
> - the actual filing date of the application was June 13, 2005;
> - the third anniversary of the actual filing date was June 13, 2008;
> - the patent issued on June 29, 2010; and
> - the patent issue date stated in the last point was 746 days after the third anniversary of the actual filing date, which is the appropriate patent term adjustment.
>
> The patent term adjustment under the three-year rule was reduced by an appeal taking place before the first Request for Continued Examination (if any) was filed.

- review by the Board or a Federal court began on the date the Notice of Appeal was filed, i.e. January 12, 2010.
- the time consumed by review by the Board or a Federal court, before the first Request for Continued Examination (if any) was filed, ended on the earliest of (1) a Board of Patent Appeals and Interferences decision, a Federal court decision, or a Board remand, or (2) the date prosecution was reopened, or (3) the date of filing of the first Request for Continued Examination, i.e. January 25, 2010, after an interval of 13 days.

- The patent term adjustment under the three-year rule of 746 days, reduced by appeal time of 13 days, is thus 733 days.

*Petition pp. 2-3.*

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)).

The Office agrees with patentee that the over three year period is 746 days. However, patentee incorrectly calculated the period consumed by appellate review. 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).

Pursuant to 37 CFR 1.703:

> (b) 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:
>
> (4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the

> Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or 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, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

Initially, the Office notes that a decision by a pre-appeal brief conference panel to withdraw the rejections of any or all of the claims on appeal is not a decision by a panel of the Board of Patent Appeals and Interferences nor an action under 35 U.S.C. 132. See Pre-Appeal Brief Conference Pilot Program, 1296 OG 67 (July 12, 2005).

In this instance, the period consumed by appellate review is 36 days, beginning on the date on which the notice of appeal to the Board of Patent Appeals and Interferences was filed, January 12, 2010, and ending on the date of the mailing of the notice of allowance, February 16, 2010. See 37 CFR 1.703(b)(4). Thus, the B delay is 710 days (not 711 days as originally shown on PAIR, nor 733 days as suggested by patentee). Accordingly, the period of reduction of 711 days pursuant to 37 CFR 1.702(b) will be removed and a period of reduction of 710 days will be entered in its place.

Lastly, the Office has concluded that there is no period of overlap between A delay and B delay. In view thereof, the patent term adjustment indicated in the patent should be **1385 days**. (682 days of A delay + 710 days of B delay - 0 days of overlap - 7 days of applicant delay).

The $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **1385 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

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,746,846 B2

DATED : Jun. 29, 2010

INVENTOR(S) : Boora 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 (1386) days.

Delete the phrase "by 1386 days" and insert – by 1385 days--

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Louis J. Wille
Bristol-Myers Squibb Company
Patent Department
PO Box 4000
Princeton, NJ 08542-4000

| | |
|---|---|
| In re Patent No. 7,453,002 | : |
| Hangeland et al. | : DECISION UPON REMAND AND |
| Issue Date: November 18, 2008 | : RECONSIDERATION OF |
| Application No. 11/151,667 | : PATENT TERM ADJUSTMENT |
| Filed: June 13, 2005 | : AND NOTICE OF INTENT |
| Attorney Docket No. 10179 NP | : TO ISSUE CERTIFICATE OF |
| Title: Five-Membered | : CORRECTION |
| Heterocycles Useful as Serine | : |
| Protease Inhibitors | |

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 four hundred forty-seven (447) 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 four hundred thirty-two (447) 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 : 7,453,002 B2

DATED : **November 18, 2008** **DRAFT**

INVENTOR(S) : Hangeland 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 289 days

Delete the phrase "by 289 days" and insert – by 447 days--

Day : Wednesday

PALM INTRANET

Date: 8/18/2010
Time: 12:09:05

| PTA Calculations for Application: 11/151667 | | | |
|---|---|---|---|
| Application Filing Date: | 06/13/2005 | PTO Delay (PTO): | 302 |
| Issue Date of Patent: | 11/18/2008 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 13 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 447 |
| PTO Delay Adjustment: | 158 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 89 | 08/18/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 158 | | |
| 80 | 11/18/2008 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 79 | 10/09/2008 | EXPORT TO FINAL DATA CAPTURE | | | |
| 78 | 10/08/2008 | FINISHED INITIAL DATA CAPTURE | | | |
| 77 | 10/08/2008 | DISPATCH TO FDC | | | |
| 76 | 09/29/2008 | TC RETURN TO PUBS | | | |
| 74 | 09/11/2008 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 73 | 09/10/2008 | ISSUE FEE PAYMENT VERIFIED | | | |
| 72 | 09/10/2008 | ISSUE FEE PAYMENT RECEIVED | | | |
| 66 | 08/11/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 65 | 08/05/2008 | ISSUE REVISION COMPLETED | | | |
| 64 | 08/05/2008 | DOCUMENT VERIFICATION | | | |
| 63 | 08/05/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 62 | 08/04/2008 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 61 | 07/24/2008 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 60 | 08/04/2008 | NOTICE OF ALLOWABILITY | | | |
| 59 | 04/24/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 58 | 05/30/2008 | DATE FORWARDED TO EXAMINER | | | |
| 57 | 05/07/2008 | SUPPLEMENTAL RESPONSE | | 13 | 53 |
| 56 | 04/24/2008 | REFERENCE CAPTURE ON IDS | | | |
| 55 | 04/24/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 54 | 05/30/2008 | DATE FORWARDED TO EXAMINER | | | |

| | | | | | |
|---|---|---|---|---|---|
| 53 | 04/24/2008 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 52 | 04/24/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 51 | 04/18/2008 | ELECTRONIC REVIEW | | | |
| 50 | 04/17/2008 | EMAIL NOTIFICATION | | | |
| 49 | 04/17/2008 | MAIL NON-FINAL REJECTION | | | |
| 48 | 04/14/2008 | NON-FINAL REJECTION | | | |
| 47 | 03/18/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 46 | 03/18/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 44 |
| 45 | 04/02/2008 | DATE FORWARDED TO EXAMINER | | | |
| 44 | 03/18/2008 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 43 | 04/02/2008 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 42 | 03/18/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 41 | 03/18/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 40 | 03/10/2008 | EMAIL NOTIFICATION | | | |
| 39 | 03/10/2008 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 38 | 02/27/2008 | ADVISORY ACTION (PTOL-303) | | | |
| 37 | 02/26/2008 | DATE FORWARDED TO EXAMINER | | | |
| 36 | 02/11/2008 | AMENDMENT AFTER FINAL REJECTION | | | |
| 35 | 12/19/2007 | ELECTRONIC REVIEW | | | |
| 34 | 12/18/2007 | EMAIL NOTIFICATION | | | |
| 33 | 12/18/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 32 | 12/13/2007 | FINAL REJECTION | | | |
| 31 | 10/10/2007 | DATE FORWARDED TO EXAMINER | | | |
| 30 | 10/04/2007 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 29 | 09/21/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 28 | 09/21/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 27 | 09/08/2007 | ELECTRONIC REVIEW | | | |
| 26 | 09/07/2007 | EMAIL NOTIFICATION | | | |
| 25 | 09/07/2007 | MAIL NON-FINAL REJECTION | | | |
| 24 | 08/31/2007 | NON-FINAL REJECTION | | | |
| 23 | 09/21/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 22 | 11/29/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 21 | 01/30/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 20 | 06/23/2007 | DATE FORWARDED TO EXAMINER | | | |
| 19 | 06/19/2007 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 18 | 06/11/2007 | MAIL RESTRICTION REQUIREMENT | 302 | | -1 |
| 17 | 06/07/2007 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 16.7 | 01/30/2007 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 16 | 01/30/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 15.7 | 11/29/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 15 | 11/29/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 14.7 | 09/21/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 14 | 09/21/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 13 | 04/07/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 12 | 04/07/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 11 | 09/26/2005 | REFERENCE CAPTURE ON IDS | | | |
| 9 | 08/17/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 8 | 08/17/2005 | APPLICATION IS NOW COMPLETE | | | |
| 7 | 08/04/2005 | ADDITIONAL APPLICATION FILING FEES | | | |
| 6 | 08/04/2005 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 5 | 07/19/2005 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 4 | 07/14/2005 | CLEARED BY L&R (LARS) | | | |
| 3 | 06/22/2005 | REFERRED TO LEVEL 2 (LARS) BY OIPE CSR | | | |
| 2 | 06/19/2005 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 06/13/2005 | 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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JAN 10 2011

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Dennis Gross
The Hill Firm
Suite 1201
666 Dundee Rd
Northbrook, IL 60062

| | | |
|---|---|---|
| In re Patent of Erdogan et al. | : | |
| Patent No. 7,119,960 | : | |
| Issue Date: October 10, 2006 | : | Letter |
| Application No. 11/151,728 | : | |
| Filing Date: June 13, 2005 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28(c) filed September 8, 2010.

The deficiency payment of $555 is hereby accepted.

The change of status to large entity has been entered and made of record.

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. Although this decision is being mailed to the address given on the petition, the Office will mail all future correspondence solely to the current address of record absent receipt of appropriate instructions to the contrary.

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

**Doc Code: PET.PTA.RCAL**
**Document Description: Request for Recalculation in view of Wyeth**

PTO/SB/131 (01-10)
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: 006454.00020 | Patent Number: 7,657,951 |
| Filing Date (or 371(b) or (f) Date): June 14, 2005 | Issue Date: February 9, 2010 |
| First Named Inventor: Kevin L. Tally | |
| Title: Support and Transfer Apparatus for Transport of an Incapacitated Individual | |

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 Jon O. Nelson | Date 8/6/2010 |
| Name (Print/Typed) Jon O. Nelson | Registration Number 24566 |

***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.*

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BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606

Mail Date: 08/13/2010

| | | |
|---|---|---|
| **Applicant** | : Kevin L. Tally | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7657951 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/151,760 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/14/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CARR & FERRELL LLP
120 CONSTITUTION DRIVE
MENLO PARK, CA 94025

**MAILED**

JAN 25 2011

**OFFICE OF PETITIONS**

In re Application of
Ashar Aziz
Application No. 11/151,812
Filed: June 13, 2005
Attorney Docket No. PA2722US

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed December 10, 2010, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on June 13, 2006. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen-month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of April 28, 2011 accompanies this decision on petition.

Telephone inquiries concerning this decision should be directed to April M. Wise at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred back to Technology Center Art Unit 2436 for examination in due course.

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/151,812 | 06/13/2005 | Ashar Aziz | PA2722US |

**CONFIRMATION NO. 4901**

22830
CARR & FERRELL LLP
120 CONSTITUTION DRIVE
MENLO PARK, CA 94025

**NONPUBLICATION RESCISSION LETTER**

*OC000000045519411*

Date Mailed: 01/18/2011

## Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 04/28/2011.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"[1] then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (571) 272-3282.

[1] Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".

/amwise/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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Lauson & Tarver LLP
880 Apollo Street
SUITE 301
El Segundo CA 90245

MAILED
DEC 07 2010
OFFICE OF PETITIONS

In re Application of
Baxter
Application No. 11/151,882
Filed: June 13, 2005
Atty. Dkt. No.: 09-18023

: DECISION ON PETITION

This decision is in response to the petition under 37 CFR 1.137(b), filed November 17, 2010. .

The petition is **GRANTED**.

The application became abandoned October 31, 2009 for failure to timely submit a proper reply to the non-final Office action mailed July 30, 2009. The non-final Office action set a three month shortened statutory period of time for reply. No petition for extension of time under 37 CFR 1.136(a) was timely filed. Notice of Abandonment was mailed February 17, 2010.

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 2185 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

Paper No.: _____

DATE : 12/15/10

TO SPE OF : ART UNIT 1635

SUBJECT : Request for Certificate of Correction for Appl. No.: 11151893 Patent No.: 7592322

CofC mailroom date: 12/02/10

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.

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

**Comments:** The proposed amendment is clearly supported by the specification at e.g. paragraphs 54 and 55, and corrects an inadvertent error in which the identities of the sense and antisense strands of an siRNA were reversed.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

/Heather Calamita/ SPE (acting) AU 1635

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

Date: 07/26/11

Patent No. : 7592322 B2
Ser. No. : 11/151,893
Inventor(s) : **Barik**
Issued : **September 22, 2009**
Title : RNAi modulation of RSV, PIV and other respiratory viruses and uses thereof
Docket No. : **26421-13911US**

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.17(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.

Lamonte M. Newsome

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(571) 272-3421 or (703) 305-8309

**ALNYLAM/FENWICK**
**SILICON VALLEY CENTER**
**801 CALIFORNIA STREET**
**MOUNTAIN VIEW CA 94041**

LMN

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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ALNYLAM/FENWICK
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW CA 94041

**MAILED**

NOV 07 2011

**OFFICE OF PETITIONS**

In re Patent No. 7,592,322 :
Issue Date: September 22, 2009 :
Application No. 11/151,893 : ON PETITION
Filed: June 14, 2005 :
Attorney Docket No **26421-13911US** :

This is a decision on the petition filed October 25, 2011, 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 "South Alabama Medical Science Foundation, Mobile, AL (US)" 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 3.81(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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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Paper No.
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Foley & Lardner LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON WI 53701-1497

| | | |
|---|---|---|
| In re Application of | : | |
| Victor Kley | : | |
| Application No. 11/151,899 | : | ON APPLICATION FOR |
| Filed: June 13, 2005 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 098888-5030 | : | |

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 February 3, 2012. Applicant submits that the correct patent term adjustment to be indicated on the patent is two thousand and twenty-eight (2028) 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 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[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). The fee is required and will not be refunded.

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).

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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 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.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.:** _____

**DATE** : 08/31/10

**TO SPE OF** : ART UNIT 2874

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 11151900 Patent No.: 7284916

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (C of C)**
**Randolph Square 9D40-D**
**Palm Location 7580**

You can fax the Directors SPE response to 571-270-9990

*Lamonte Newsome*
**Certificates of Correction Branch**
**703-756-1574**

**Thank You For Your Assistance**

---

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

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

**Comments:** The changes do not introduce new matter or change the scope of the claims.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

/UYEN-CHAU N. LE/ 2874

Formatted: French (France)

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
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DEC 13 2011

| | | |
|---|---|---|
| In re Application of | : | |
| Luis Jordan | : | SUA SPONTE DECISION |
| Serial No. 11/151,906 | : | TO WITHDRAW THE |
| Filed: 06/14/2005 | : | HOLDING OF ABANDONMENT |
| For: MODULAR SPACECRAFT DESIGN ARCHITECTURE | | |

A sua sponte review of the the above-noted application file has been conducted. As a result it has been determined that certain errors on the part of the Office have occurred. In particular it has been determined that the holding of abandonment on September 12, 2011 was premature. The purpose of the communication is to correct this error and clarify the record.

A review of the file history indicates that the examiner held the application abandoned for applicant's inclusion of new claims and combinations of claims in reply to the action by the BPAI mailed on March 18, 2011.

Accordingly, the holding of abandonment is hereby **VACATED.**

Any questions regarding this decision should be directed to Supervisory Patent Examiner Timothy Collins at (571)272-6886

Kathy Matecki

Kathy Matecki, Director
Technology Center 3600

Robert McDermott, Esq.
1824 Federal Farm Rd.
Montross, VA 22520

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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CARR & FERRELL LLP
120 CONSTITUTION DRIVE
MENLO PARK CA 94025

MAILED

FEB 14 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Aziz | : | |
| Application No. 11/152,286 | : | DECISION ON PETITION |
| Filed: June 13, 2005 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. PA2723US | : | |

This is a decision on the petition, filed December 10, 2010, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on June 13, 2006. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen-month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing which sets forth the projected publication date of April 21, 2011 accompanies this decision on petition.

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

This application is being referred to Technology Center Art Unit 2435 for consideration of the IDS, filed November 11, 2010, and the amendment, filed November 30, 2010

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

ATTACHMENT: Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing - printed 1/14/11

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

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/152,286 | 06/13/2005 | Ashar Aziz | PA2723US |

**CONFIRMATION NO. 6191**

22830
CARR & FERRELL LLP
120 CONSTITUTION DRIVE
MENLO PARK, CA 94025

**NONPUBLICATION RESCISSION LETTER**

*OC000000045481990*

Date Mailed: 01/14/2011

## Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 04/21/2011.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"[1] then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (571) 272-3282.

[1] Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".

/swbrantley/

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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|---|---|---|---|
| 11/152,286 | 06/13/2005 | Ashar Aziz | PA2723US |

**CONFIRMATION NO. 6191**

22830
CARR & FERRELL LLP
120 CONSTITUTION DRIVE
MENLO PARK, CA 94025

*OC000000045481990*

## Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 04/21/2011.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"[1] then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (571) 272-3282.

[1] Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".

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

WELLS ST. JOHN P.S.
601 W. FIRST AVENUE, SUITE 1300
SPOKANE, WA 99201

**MAILED**

**NOV 22 2010**

**OFFICE OF PETITIONS**

In re Patent No. 7,270,020 :
Issue Date: September 18, 2007 :
Application No. 11/152,395 : NOTICE
Filed: June 13, 2005 :
Attorney Docket No. GR61-029

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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ALLEN, DYER, DOPPELT,
MILBRATH & GILCHRIST P.A.
1401 CITRUS CENTER
255 SOUTH ORANGE AVENUE
P.O. BOX 3791
ORLANDO FL 32802-3791

**MAILED**

JAN 10 2011

OFFICE OF PETITIONS

In re Patent No. RE40520 :
Issue Date: 23 September, 2008 :
Application No. 11/152,835 : DECISION ON PETITION
Filed: 15 June, 2005 :
Attorney Docket No. 83145 :

This is a decision on the petition filed on 21 July, 2010, requesting a statement by the Office of a date of expiration, submitted pursuant to 37 C.F.R §1.182.

**NOTE:**

The address on the petition is other than that of record.

There is no indication that Petitioner herein was empowered to prosecute the instant application.If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted.

A courtesy copy of this decision will be mailed to Petitioner.

However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

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

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 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).

In re Patent No. RE40520
Application No. 11/152,835

The petition pursuant to 37 C.F.R §1.182 is **DISMISSED**.

## BACKGROUND

Petitioner avers that the instant patent is a reissue of Patent No. 5,826,259, which issued on 20 October, 1998, following prosecution that commenced on filing on 27 May, 1997.

Petitioner wishes that the Office advise him as to expiration date of the reissue patent.

The Office does not provide advisory opinions.

As one registered to practice before the Office, Petitioner is aware that:

- The patent term, as to utility applications and patents issuing therefrom, is determined from the filing date (35 U.S.C. §154, *see*: MPEP §2701); and
- The due date of maintenance fees in a reissue is determined from the issue date of the underlying patent (35 U.S.C. §41(b), §251, *see*: MPEP §1415.01).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

## CONCLUSION

Accordingly the petition submitted pursuant to 37 C.F.R §1.182 is **DISMISSED**.

The file is released to IFW Files Repository.

[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).

In re Patent No. RE40520
Application No. 11/152,835

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

CC
EDWARD C. KWOK
HAYNES AND BOONE LLP
2333 GATEWAY PLACE/STE. 400
SAN JOSE, CA 95110

[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 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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**GEORGE R. SCHULTZ**
**SCHULTZ & ASSOCIATES, P.C.**
**ONE LINCOLN CENTRE**
**5400 LBJ FREEWAY, SUITE 1200**
**DALLAS TX 75240**

**MAILED**

FEB 28 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| CLARKE | : | |
| Application No. 11/152,990 | : | DECISION ON PETITION |
| Filed: June 14, 2005 | : | |
| Attorney Docket No. 44601.0212 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 3, 2011, 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 November 5, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed August 5, 2010, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on November 6, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $755 and publication fee of $300; (2) the petition fee of $810; and (3) the required statement of unintentional delay.

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.

/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
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**COATS & BENNETT/SONY ERICSSON**
**1400 CRESCENT GREEN, SUITE 300**
**CARY, NC 27518**

MAILED
MAR 21 2011
OFFICE OF PETITIONS

In re Application of
**Gregory A. DUNKO**
Application No. 11/153,211
Filed: June 15, 2005
Attorney Docket No. **2002-141/PU05 0061US**

DECISION GRANTING PETITION UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 18, 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 22, 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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**Wong, Cabello, Lutch, Rutherford & Brucculeri, LLP**
**20333 SH 249 6th Floor**
**Houston, TX 77070**

MAILED
JUN 20 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Theodore Russell Ernst | : | |
| Application No. 11/153,303 | : | DECISION ON PETITION |
| Filed: June 15, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 03-016-US (149-0169US) | : | 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 16, 2011.

The request is **moot because a revocation of power of attorney has been filed.**

A review of the file record indicates that the power of attorney to Wong, Cabello, Lutch, Rutherford & Brucculeri, LLP, has been revoked by the assignee of the patent application on June 2, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

A Notice of Allowance was mailed on June 9, 2011.

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: Brake, Hughes, Bellermann, LLP
c/o CPA Global
P.O. Box 52050
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/153,303 | 06/15/2005 | Theodore Russell Ernst | 149-0169US / 03-016-US |

**CONFIRMATION NO. 9900**

**POWER OF ATTORNEY NOTICE**

29855
WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI, L.L.P.
20333 SH 249 6th Floor
HOUSTON, TX 77070

*OC000000048151316*

Date Mailed: 06/13/2011

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/02/2011.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

/mnguyen/

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

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**North Star Intellectual Property Law, PC**
**P.O. Box 34688**
**Washington DC 20043**

MAILED

SEP 07 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Seok-Jung Kim et al. | : | |
| Application No. 11/153,322 | : | DECISION ON PETITION |
| Filed: June 16, 2005 | : | |
| Attorney Docket No. 1101.0197 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 16, 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 4, 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 March 5, 2010. A Notice of Abandonment was mailed on June 21, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a RCE (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.

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.

This application is being referred to Technology Center AU 2627 for appropriate action by the Examiner in the normal course of business on the RCE received July 16, 2010.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Rachael Lea Leventhal
NSIP Law
1156 15th Street, Suite 603
Washington, DC 20005

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**NIEFELD IP LAW, PC**
**4813-B EISENHOWER AVENUE**
**ALEXANDRIA, VA. 22304**

MAILED
MAY 31 2011
OFFICE OF PETITIONS

In re Application of :
Roy SIMRELL : ON PETITION
Application No. 11/153,377 :
Filed: June 16, 2005 :
Attorney Docket No. PIP171SIMRU-US

This is a decision on the renewed petition under 37 CFR § 1.181, filed April 22, 2010, requesting supervisory review of the decision dated April 20, 2010 by the Group Director of Technology Center 3600 (Group Director), and inter alia, expungement of the Notice of Noncompliant Amendment mailed November 3, 2008.

The petition to set aside the Group Director's decision dated April 22, 2010, or to instruct the Technology Center personal take other specific action with respect to this application, is **DENIED**.

## BACKGROUND

On June 16, 2005, applicant filed an application having 33 claims. Claims 1-6 properly had no status identifier; claims 7-33 were listed as "Original".

In response to an Office action, on July 17, 2008, applicant listed claims 1, 3, 4, 6, 7-11, 24, 26, 30, 31, and 33 as "Currently Amended". Claims 2, 5, 12-19, 21-23, 25, 27-29, 31 and 32 were listed as "Previously Presented". Claims 20 and 32 were listed as "Cancelled".

On November 3, 2008, a Notice of Non-Compliant Amendment was mailed.

On November 25, 2008, applicant filed a response.

On December 19, 2008, applicant filed a petition under 37 CFR § 1.181.

On April 29, 2009, a decision by the Technology Center Director denying the petition of December 19, 2008 was mailed.

On June 4, 2009, a petition under 37 CFR § 1.181, requesting review of the Technology Center Director's decision of April 29, 2009 was filed.

On April 7, 2010, a decision dismissing the petition filed June 4, 2009, as moot was mailed.

On April 16, 2010, a petition under 37 CFR § 1.181, requesting reconsideration of the decision on April 7, 2010 was filed.

On April 20, 2010, a corrected decision dismissing the petitions filed April 7, 2010 and April 16, 2010 was mailed.

On April 22, 2010, a petition under 37 CFR § 1.181, requesting review of the petition decision of April 20, 2010 was filed.

## STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § 2(B)(2) provides in part that:

The Office... may establish regulations, not inconsistent with law, which —
(A) shall govern the conduct of proceedings in the Office.

37 CFR § 1.59(b) provides that:

§ 1.59 Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

37 CFR § 1.121(c) provides that:

Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

In addition, the status of each claim included in the claim listing must be described by one of the following seven defined identifiers in parentheses after the claim number:

> (Original): Claim filed with the application.
> (Currently amended): Claim being amended in the current amendment document.
> (Canceled): Claim deleted from the application.
> (Withdrawn): Claim still in the application, but in a non-elected status.
> (Previously presented): Claim added or amended in an earlier amendment document.
> (New): Claim being added in the current amendment document.
> (Not entered): Claim presented in a previous amendment document but which has either not been entered or the status of entry is unknown to applicant when a subsequent amendment to the claims is filed. (Underlining added).

See Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 38,611, 38,616 (June 30, 2003).

The status identifier "previously presented" must be used in those circumstances where: (1) A claim has been previously presented as "new" in a prior amendment document and entry of the claim is certain; and (2) a claim has been previously presented as "currently amended" in a prior amendment document.

## OPINION

A review of the record indicates that on July 17, 2008, the applicant filed an amendment that listed the claim status identifier "(Previously Presented)" to refer to the status of claims that were present at the time of filing the instant application. Applicant's originally filed claims presented 33 claims. Claims 7-33 contained the status identifier "Original".

On November 3, 2008, the United States Patent and Trademark Office (USPTO) mailed a Notice of Non-Compliant Amendment requiring that claims presented in an amendment

that contained unamended claims, which were present at the time of filing, have the status identifier "(Original)". In response, petitioner filed an amendment on November 25, 2008, correcting the status identifiers "(Previously Presented)" to "(Original)". On December 19, 2008, applicant submitted a petition to accept, enter, and act on the amendment as meeting the requirements of 37 CFR § 1.121 and 37 CFR § 1.4. Additionally petitioner requested expungement of the requirement to submit a revised amendment and a recording to the file that the application would not lose patent term based upon 37 CFR § 1.704(c)(7). On March 9, 2009, the examiner, being satisfied that the claims were now in proper form, issued an office action on the amended claims. A petition filed December 19, 2008, was denied by the Technology Center Director. Applicant on June 4, 2009, requested review under 37 CFR § 1.181. On April 7, 2010, a decision dismissing the petition as moot was mailed. Applicant responded with a request for reconsideration on April 16, 2010. The request for reconsideration was granted on April 20, 2010, to the extent that a review was made of the petitions of April 7, 2010 and April 20, 2010. The petitions were dismissed. On April 22, 2010, a third petition under 37 CFR § 1.181 requesting supervisory review was filed.

A review of the Notice of Non-Compliant Letter dated November 25, 2008 correctly indicates that the amendment filed July 17, 2008 contained original claims that were identified as "Previously Presented". In an amendment, original claims must be identified by the status identifiers "Original Claim" or "Originally filed Claim". See Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. at 38,616. With respect to the status identifier "previously presented":

> The status identifier "previously presented" must be used where; (1) A claim has been previously presented as "new" in a prior amendment document and entry of the claim is certain: and (2) a claim has been previously presented as "currently amended" in a prior amendment document.

See id. at 38,617

Furthermore, the status identifier "Previously presented" is to indicate "claims added" or "amended". See id. at 38,616. By definition, a claim that is originally filed is neither a "claim added" or "amended" and thus the status identifier "Previously presented" is inappropriate for use with original claims.

Here applicant chose to file original claims 8-33 with the status identifier "Original". However claims 1-6 were also original claims. Since claims 12-19, 21-23, 25, 27-29, 31 and 33 have not been amended, they should retain their initial status as "Original". Claims not present at the time of filing or that are present as a preliminary amendment after filing of the application, and/or subsequently presented, merit the status "Previously presented" or as acceptable alternatives "Previously amended". "Previously added", "Previously submitted" or "Previously presented claim". To permit the applicant to have claims that have not been amended to go from "Original" to "Previously presented" would not be accurate, and clear as to identification of the originally filed claims. The use of appropriate

identifiers in the image file environment are designed to inform any user (examiner, technical support staff, applicant, practitioners, etc.) of the current status of each and every claim in the application. Labeling a claim as "original" serves the desired purpose by providing a focus on what unamended claim was filed with the application. Labeling a claim as "previously presented" serves the desired purpose by providing a focus on what claim was presented in a previous amendment and has not now been amended in the current amendment.

35 U.S.C. § 2(b)(2) authorizes the USPTO to prescribe regulations for the conduct of proceedings in the USPTO, and does not provide that applicants may determine what procedures are best suited to their needs and then insist that the USPTO follow those procedures during the examination of their applications. There are a large number of applications pending before the USPTO: more than 500,000 applications were filed in fiscal year 2010, and more than 1,150,000 applications are pending before the USPTO. See United States Patent and Trademark Office Performance and Accountability Report Fiscal Year 2010 at 126-27 (2010). The USPTO needs applicants to submit their applications and amendments to their applications in accordance with the prescribed regulations to be able to process applications in an orderly manner. An applicant's failure to submit his or her application and amendments to the applications in accordance with the prescribed regulations will hinder the USPTO's ability to process and examine the application. Here the status identifiers of originally filed claims presented in the amendment filed July 17, 2008 were not accurate and clear. Therefore the Notice of Non-Compliant Amendment was proper.

Applicant has requested the Office to expunge the requirement to submit a revised amendment so that it is clear on the record that the requirement was improper, and so that the requirement cannot detrimentally affect patent term adjustment. As the Notice of Non-Compliant Amendment mailed November 3, 2008 was not mailed in error, there is no basis for its expungement. As discussed previously, an applicant's failure to submit his or her application and amendments to the applications in accordance with the prescribed regulations will hinder the USPTO's ability to process and examine the application. Thus, there is no basis for relieving petitioners from any patent term adjustment flowing from their failure to submit an amendment in compliance with the regulations. Cf. 35 U.S.C. § 154(b)(2)(c)(i) (patent term adjustment "shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application").

## DECISION

The record shows no error on the part of the Technology Center Director. The Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in regard to refusing to accept the status identifiers and expunge information from the application file. For the reasons set forth above, the Technology Center Director's decision to refuse to expunge information from the application file is not shown to be in error. The petition is granted to the extent that the decision of the Technology Center Director, dated April 29, 2009, has been reviewed, but is **denied** as to the request that the aforementioned decision be overturned.

This decision is final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP § 1002.02.

This application is being referred to Technology Center Art Unit 3629 for appropriate action in the normal course of business.

Telephone inquiries concerning this decision should be directed to Thurman K. Page at 571-272-0602.

Robert W. Bahr
Acting Associate Commissioner
For Patent Examination Policy

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**F. CHAU & ASSOCIATES, LLC**
**130 WOODBURY ROAD**
**WOODBURY NY 11797**

**MAILED**

**DEC 09 2011**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,360,833 | : | |
| Issued: April 22, 2008 | : | |
| Application No. 11/153,431 | : | NOTICE |
| Filed: June 16, 2005 | : | |
| Attorney Docket No. VIT-028 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed November 1, 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 inquiries 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

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

Fujitsu Patent Center
Fujitsu Management Services of America, Inc.
2318 Mill Road, Suite 1010
Alexandria VA 22314

MAILED
JUN 21 2011
OFFICE OF PETITIONS

In re Application of
Hashimoto
Application No 11/153,440
Filed: June 16, 2005
Attorney Docket No. 04-50936

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 16, 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 October 27, 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 extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is January 28, 2011. A Notice of Abandonment was mailed on June 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 a Request for Continued Examination (RCE) and fee of $810.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $1620.00; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 2816 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.

Charlema Grant

Charlema Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**KING & SPALDING**
**1185 AVENUE OF THE AMERICAS**
**NEW YORK NY 10036-4003**

**MAILED**

DEC 29 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Maurice Michael Salter | : | |
| Application No. 11/153,481 | : | DECISION ON PETITION |
| Filed: June 16, 2005 | : | |
| Attorney Docket No. 77151.0009 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 18, 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, May 14, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 15, 2008. A Notice of Abandonment was mailed on November 28, 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 RCE (Request for Continued Examination, with the required fee of $405, (2) the petition fee of $810, and (3) a proper statement of unintentional delay. Accordingly, the RCE 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.

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.

This application is being referred to Technology Center AU 3695 for appropriate action by the Examiner in the normal course of business on the RCE received November 18, 2010.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Eric Sophir
1700 Pennsylvania Avenue
Suite 200
Washington, DC 20006

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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**CHARLES G. CALL**
**361 WILD COFFEE LN**
**MARCO ISLAND FL 34145-1849**

MAILED
OCT 14 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kunzler et al. | : | |
| Application No. 11/153,601 | : | ON PETITION |
| Filed: June 15, 2005 | : | |
| Attorney Docket No. F-21 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed September 13, 2010, to revive the above-identified application.

The petition is **GRANTED**.

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

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

This matter is being referred to Technology Center AU 3618 for further examination on the merits.

Liana Walsh
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. |
|---|---|---|---|---|
| 11/153,728 | 06/15/2005 | Petra Gisela Rigassi-Dietrich | PC/4-34314P1 | 9667 |

1095 7590 05/13/2011
NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 101/2
EAST HANOVER, NJ 07936-1080

| EXAMINER |
|---|
| VU, JAKE MINH |

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

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/13/2011 | 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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Alexandria, VA 22313-1450
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NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 101/2
EAST HANOVER NJ 07936-1080

| | |
|---|---|
| In re Application of: | |
| Rigassi-Dietrich et al. | : |
| Serial No.: 11/153,728 | : |
| Filed: June 15, 2005 | : PETITION DECISION |
| Attorney Docket No.: **PC/4-34314P1** | : |
| | : |

This is in response to the Petition filed by applicants under 37 CFR § 1.181 on April 19, 2011, requesting to withdraw the Notice of Improper Request for Continued Examination (RCE) on March 7, 2011.

BACKGROUND

Most recently, a Notice of Improper Request for Continued Examination (RCE) was mailed on March 7, 2011.

In response thereto, applicants filed a Petition under 37 CFR § 1.181 requesting that the Notice of Improper Request for Continued Examination (RCE) be withdrawn.

DECISION

The petition is **GRANTED** for the reasons set forth in the petition.

The Notice of Improper Request for Continued Examination (RCE) mailed March 7, 2011 is hereby vacated as it was improper. The abandonment will be withdrawn and the RCE processed.

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

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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PAUL D. YASGER
ABBOTT LABORATORIES
100 ABBOTT PARK ROAD
DEPT. 377/AP6A
ABBOTT PARK, IL 60064-6008

**MAILED**

AUG 11 2010

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Jianguo Ji, et al. :
Application No. 11/153,762 :
Filed: June 15, 2005 :
Attorney Docket No. 7268USP1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 13, 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 November 20, 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). A three (3) month extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is May 21, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1620; 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 1625 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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : ~~8/4/11~~ 8/1/11

TO SPE OF : ART UNIT: 2463

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/153,767 Patent No. 7,859,986

CofC mailroom date 7/26/11

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

*Ernest C. White, LIE*

**Certificates of Correction Branch**

**703-756-1814** _____

**Thank You For Your Assistance**

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

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

**Comments:** Certificate of Correction filed 07/26/2011 okay to enter.

/Derrick W. Ferris/ — SPE

2463 — Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
MAY 23 2011
OFFICE OF PETITIONS

In re Application of

Friedman, et al.

Application No. 11/153,784

Filed: June 15, 2005

Attorney Docket No. **026880-00168**

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed May 4, 2011.

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

This application was held abandoned on July 3, 2010, after it was believed that no response was received to the final Office action mailed April 2, 2010, which set a three month period for reply from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). A review of the application file record reveals that a Notice of Appeal and fee were received on October 4, 2010. Notwithstanding, a Notice of Abandonment was mailed on March 31, 2011, indicating that no reply had been received.

Petitioner states that a Notice of Appeal and fee were filed on October 4, 2010, with an extension of time within the third month. Petitioner further notes that the Notice of Appeal and fee were timely because October 2, 2010, was a Saturday and October 3, 2010, was a Sunday. Petitioner also notes that an appeal brief and fee are of record as of May 4, 2011. Petitioner argument is well-taken, excepting the fact that the appeal brief was accompanied by a request for an extension of time within the fourth month, but an extension of time within the fifth month is necessary in order for the appeal brief to be considered timely. It is noted that the Notice of Appeal and fee was filed October 4, 2010. Pursuant to 37 CFR 41.37, applicant is given two months from the date the Notice of Appeal is filed in which to file an appeal brief and fee. It is noted that extensions of the time to file the appeal brief are available, pursuant to 37 CFR 1.136, up to five additional months after the expiry of the two months provided by 37 CFR 41.37. See MPEP 1205.01. The appeal brief and fee were not filed until May 4, 2011, which is five months after the expiry of the two month period provided by 37 CFR 41.37. Thus, an extension of time within the fifth month under 37 CFR 1.136 is required. Petitioner has authorized a deposit account to be charged for any fee defeciencies. Accordingly, deposit account 01-2300 will be charged an additional $620.00 for the extension of time within the fifth month given that $1,730.00 has already been received for the extension of time within the fourth month.

Based on the aforementioned, it appears that the application was improperly held abandoned as a bona fide response was received prior to expiration of the statutory period for reply to the final Office action and appeal brief and fee were filed prior to the expiration of the period for filing the submission as per 37 CFR 41.37. The holding of abandonment is withdrawn, accordingly.

The application file is being directed to Technology Center, GAU 2178 for further processing.

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

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**PULSE-LINK, INC**
**2270 CAMINO VIDA ROBIE, SUITE E**
**CARLSBAD, CA 92008**

MAILED

JUL 19 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **Roberto AIELLO**, et *al.* | : | |
| Application No. 11/153,839 | : | DECISION ON PETITION |
| Filed: June 14, 2005 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. **00225** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 3, 2011 and re-submitted February 15, 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, February 27, 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 May 28, 2009.

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

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 2476 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

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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**MARGARET ANDERSON**
**106 E. 6TH STREET, SUITE 900**
**AUSTIN TX 78701**

MAILED
MAR 15 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jung et al. | : | DECISION ON PETITION |
| Application No. 11/153,868 | : | TO WITHDRAW |
| Filed: June 14, 2005 | : | FROM RECORD |
| Attorney Docket No. QQ1-0124US | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 26, 2011.

The request is **NOT APPROVED**.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

***An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.***

According to a review of current USPTO records petitioner has not requested the address be changed to a properly recorded assignee or the first listed inventor. The Customer Number 55922 is neither the first named inventor nor the assignee who properly became of record under 37 CFR 3.71 As such, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

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.

Currently, there is an outstanding Office action mailed January 25, 2011 that requires a reply.

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

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: LEE & HAYES, PLLC
601 W RIVERSIDE
SUITE 1400
SPOKANE, WA 99201

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

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

MAILED
APR 26 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Mark S. Hollinrake et al. | : | |
| Patent No. 7,913,931 | : | |
| Issued: March 29, 2011 | : | NOTICE |
| Application No. 11/153,971 | : | |
| Filed: June 16, 2005 | : | |
| Attorney Docket No. **232035** | : | |

This is a notice regarding your request filed March 29, 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/
JoAnne Burke
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CAREY, RODRIGUEZ, GREENBERG & O"KEEFE, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 2022
BOCA RATON FL 33487

MAILED
MAR 12 2012
OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Stoner | : DECISION ON PETITION |
| Application No. 11/153,975 | : |
| Filed: June 16, 2005 | : |
| Atty. Dkt. No: LOT920050052US1 (7321-102 | : |

The above-identified application has been referred to the Office of Petitions for consideration of the petition to reset time under 37 CFR 1.181, filed January 31, 2012.

The application became abandoned November 23, 2011 for failure to timely submit a proper reply to the Decision by the Board of Patent Appeals and Interferences mailed September 22, 2011. The Decision set a two month statutory period of time for reply. Notice of Abandonment was mailed December 27, 2011.

Petitioners request withdrawal of the holding of abandonment of the instant application on the basis of non-receipt of the Decision.

The showing required to establish non-receipt 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 non-received Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the non-received Office action must be submitted as documentary proof of non-receipt 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. See, MPEP 711.03(c).

The instant petition and supporting documents have been carefully review but are not found in compliance with procedures to establish non-receipt of an Office communication set forth at MPEP 711.03(c).

Exhibits A through G do not appear to contain a master docket report showing all replies docketed for a date two months from the mail date of the non-received Board Decision. Exhibit G appears to be a list of response *filed* between September 22, 2011 to November 22, 2011. If no such master docket exists, the practitioner should so state upon renewed petition.

Accordingly, the petition under 37 CFR 1.181 to withdraw the holding of abandonment is hereby 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 1.181." This is not a final agency decision.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Attorney Advisor
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/20/12

TO SPE OF : ART UNIT: 2164

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/153,980 Patent No. 8,046,375

CofC mailroom date 11/15/11

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

*Ernest C. White, LIE*

**Certificates of Correction Branch**

**703-756-1814** _____

**Thank You For Your Assistance**

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

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

**Comments:** Approved. Does not change the scope of the invention/claims.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

/Charles Rones/____ 2164___

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

In re Patent No. 7180444
Issue Date: February 20,2007
Application No. 11154005
Filed: June 16,2005
Attorney Docket No. DP-313231

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

This is a decision on the electronic petition, filed November 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 November 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.

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) |
|---|---|---|---|---|
| 7180444 | 2007-02-20 | 11154005 | 2005-06-16 | 10020861-1000 |

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 | /Tarek N. Fahmi/ | Date (YYYY-MM-DD) | 2011-11-09 |
| Name | Tarek N. Fahmi | Registration Number | 41402 |

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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Commissioner for Patents
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P.O. Box 1450
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500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

**MAILED**

NOV 04 2010

**OFFICE OF PETITIONS**

In re Application
Douglas Chin
Application No. 11/154,032
Filed: June 16, 2005
Attorney Docket No. 15833US02

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

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 October 19, 2010. Applicant requests that the determination of patent term adjustment be corrected from 1112 to 1593 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 9

**CHRISTIE, PARKER & HALE, LLP**
**P.O. BOX 7068**
**PASADENA CA 91109-7068**

**MAILED**
DEC 01 2010
**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : |
| Hyung-Gon Noh | : |
| Application No. 11/154,059 | : DECISION DISMISSING |
| Filed: June 15, 2005 | : PETITION UNDER |
| Attorney Docket No. 54701/P849 | : 37 CFR 1.313(c)(2) |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 29, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **DISMISSED AS MOOT.**

Unfortunately, the petition was not referred to the appropriate deciding official for decision until the date of issuance of this application into a patent. Petitioner's attention is directed to 37 CFR 1.313(d), which states:

> A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials **before the date of issue.** (Emphasis added)

In this case, the petition was not received in the Office of Petitions for consideration until November 30, 2010, the date upon which the above-identified application issued as U.S. Patent No. 7,842,422. Since the case has now issued, the petition to withdraw from issue cannot be granted.

Petitioner is also encouraged to note MPEP § 1308.

The request for continued examination (RCE) filed concurrently with the petition is improper in view of the issuance of this application into a patent and will not be processed. Accordingly, the $810 filing fee and the $130 petition fee submitted are unnecessary. Petitioner may request a refund of

the above fees by writing to the Office of Finance Refund Section.

The Information Disclosure Statement has been made of record in the file of the above-identified application without further consideration. *See* 37 CFR 1.97(i).

Telephone inquiries 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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SHOOK, HARDY & BACON L.L.P.
(Cerner Corporation)
Intellectual Property Department
2555 GRAND BOULEVARD
KANSAS CITY MO 64108-2613

MAILED

JUN 17 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | DECISION REFUSING STATUS |
| Grasso et al. | : | UNDER 37 CFR 1.47(a) |
| Application No. 11/154,154 | : | |
| Filed: June 16, 2005 | : | |
| For: SYSTEM AND METHOD IN A | : | |
| COMPUTERIZED ENVIRONMENT FOR | : | |
| CHARTING PEDIATRIC GROWTH | : | |

This is in response to the "Petition under 37 CFR 1.47(a) To Make Application on Behalf of An Inventor Who Cannot Be Reached", filed June 6, 2011.[1]

The petition is dismissed as inappropriate.

In response to the final Office action mailed December 6, 2010, petitioner has submitted a petition under 37 CFR 1.47. The Office action required a new oath or declaration because the declaration submitted on September 16, 2005 was defective because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be "material to patentability" as defined in 37 CFR 1.56.

A review of the September 16, 2005 declaration shows that the executed declaration does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be "material to patentability". However, pursuant 1327 O.G. 112 (February 12, 2008), for pending applications, the Office sua sponte waived the express language requirement of 37 CFR 1.63(b)(3) where the oath or declaration was filed prior to June 1, 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that oaths or declarations containing the "material to examination" or "in accordance with §1.56(a)" language or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56.

Since the declaration was filed prior to June 1, 2008 and contains the statement material to examination, a supplemental declaration under this basis not required.

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[1]Once an application has received a properly executed oath or declaration and such has been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

The $200.00 petition fee will be refunded.

This application is being referred to art unit 3626 for appropriate action by the Examiner in the normal course of business on the reply received

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

Charlema Grant
Attorney
Office of Petitions

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Alexandria, VA 22313-1450
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OCT 19 2010

OFFICE OF PETITIONS

**DILLON & YUDELL LLP**
**8911 N. CAPITAL OF TEXAS HWY.,**
**SUITE 2110**
**AUSTIN TX 78759**

| | | |
|---|---|---|
| In re Application of | : | |
| Arun Kumar et al. | : | |
| Application No. 11/154,162 | : | DECISION ON PETITION |
| Filed: June 16, 2005 | : | |
| Attorney Docket No. **AUS920050111US1** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 25, 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, February 18, 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 May 19, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1620, and (3) a proper statement of unintentional delay. Accordingly, the reply to the non-final Office action of February 18, 2009 is accepted as having been unintentionally delayed.

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

date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

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

This application is being referred to Technology Center AU 2163 for appropriate action on the concurrently filed amendment.

Ramesh Krishnamurthy

Ramesh Krishnamurthy
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. |
|---|---|---|---|---|
| 11/154,208 | 06/16/2005 | Mary Therese Jernigan | 375861US103 | 1734 |

22850 7590 06/23/2011
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| EXAMINER |
|---|
| MESH, GENNADIY |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1763 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 06/23/2011 | 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

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

wk

Mailed: 6/23/11

| | | |
|---|---|---|
| In re application of | : | |
| Jernigan et al. | : | DECISION ON |
| Serial No. 11/154,208 | : | PETITION |
| Filed: June 16, 2005 | : | |

For: **HIGH INTRINSIC VISCOSITY MELT PHASE POLYESTER POLYMERS WITH ACCEPTABLE ACETALDEHYDE GENERATION RATES**

This is a response to Applicants Petition filed on April 26, 2011 under 37 C.F.R. 1.181 requesting the withdrawal of the Request for Information under 37 C.F.R. 1.105 that was mailed on February 1, 2011.

Applicants filed two Information Disclosure Statements on November 9, 2010 and on September 17, 2010 which combined cite 355 US Patent documents and 571 Foreign Patent documents and Non-Patent documents. 13 Information Disclosure Statements were previously filed by the Applicants and considered by the Examiner.

Applicant asserts that the Request for Information of February 1, 2010 is not proper for requiring submission of opinion evidence and that the Request for Information of February 1, 2010 asks for information already of record. Applicant notes that the references cited on the September 17 and November 9, 2010 IDS's were cited by Applicant or by the PTO in cases identified as related to the present case or in cases related to cases identified as related to the present case.

The Examiner in the Rule 105 request specifically required Applicants to point out which references cited on the IDS were relevant to the claimed subject matter of a :method for production of solid polyester particles by melt phase polycondensation in presence of antimony catalyst and phosphorous compound as catalyst deactivator, wherein polymer does not contain organic acetaldehyde scavengers. The Examiner also noted that many of the documents cited do not appear to be relevant to the scope of the claims in the Application. The Examiner cited four examples.

The applicable rule (37 C.F.R. 1.105) permits the Examiner to request only information and/or facts, not opinion. Applicants assert that the Examiner has already acknowledged which references Applicants have identified as relevant because of the statement "the following information is required to consider the art suggested by the Applicant as relevant to this examination in the IDS filed on November 9, 2010 and IDS filed on September 17, 2010".

The Examiner's request was not for general relevancy but for which references cited on the IDS were relevant to the claimed subject matter of a :method for production of solid polyester particles by melt phase polycondensation in presence of antimony catalyst and phosphorous compound as catalyst deactivator, wherein polymer does not contain organic acetaldehyde scavengers.

**DECISION**

The Petition is **GRANTED-IN-PART**.

Applicants are requested to comply with the Requirement for Information under 37 C.F.R. 1.105 by factual inquiry by pointing out which references cited on September 17, 2010 and November 9, 2010 they are ***aware of*** that:

(a) Describe method for production of solid polyester particles by melt phase polycondensation in presence of antimony catalyst and phosphorous compound as catalyst deactivator, wherein polymer does not contain organic acetaldehyde scavengers.

The authority for the Office to make such requirements arises from the statutory requirements of examination pursuant to 35 U.S.C. 131 and 132. An examiner or other Office employee may make a requirement for information reasonably necessary to the examination or treatment of a matter in accordance with the policies and practices set forth by the Director(s) of the Technology Center or other administrative unit to which that examiner or other Office employee reports. See *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1283, 73 USPQ2d 1409, 1414 (Fed. Cir. 2005).

The terms "factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant. The purpose of 37 CFR 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information.

Serial Number: 11/154,208

Applicants are given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this decision notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

/Yvonne Eyler/
Director, Technology Center 1700

Yvonne L. Eyler, Director
Technology Center 1700
Chemical and Materials Engineering

Stefan U. Koschmieder, Ph.D.
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

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KILPATRICK STOCKTON LLP
1001 WEST FOURTH STREET
WINSTON-SALEM NC 27101

MAILED
AUG 27 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,574,975 | : | DECISION ON REQUEST |
| Kline | : | FOR |
| Issue Date: August 18, 2009 | : | RECONSIDERATION OF |
| Application No. 11/154,302 | : | PATENT TERM ADJUSTMENT |
| Filed: June 16, 2005 | : | and |
| Atty Docket No. **AMI001** | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on October 19, 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 and sixty-three (663) 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-two (662) days is **GRANTED to the extent indicated herein.**[1]

Patentee maintains that the period of reduction to the patent term adjustment under 37 CFR 1.704(c)(8) for the filing of an Information Disclosure Statement on June 20, 2008, is 39 days,

[1] The period of overlap between the "A" delay and the "B" delay is 128 days. It is noted that, in this case where no Request for Continued Examination was filed, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, from the filing date of the application to the issue date of the patent. It is further noted that "A" delays and "B" delays overlap only if such delays occur on the same calendar day. A review of the record reveals that the relevant periods of "A" delay began September 12, 2008, and ended October 30, 2008, 2008 (48 days) and the second period began May 30, 2009, and ended August 18, 2009 (80 days). The relevant period of "B" delay began June 16, 2008, and ended August 18, 2009. There 128 days of "A" delay and "B" delay that occur on the same calendar days. Thus, the period of overlap between the "A" delay and the "B" delay is 128 days.

not 19 days as was entered by the Office. Patentee's argument is well taken. The period of reduction to the patent term adjustment under 37 CFR 1.704(c)(8) for the filing of the Information Disclosure Statement on June 20, 2008, is 39 days with said period beginning May 13, 2008, and ending June 20, 2008. The period of reduction of 19 days is being removed and a period of reduction of 39 days is being entered.

It is further noted that patentee argues that the period of reduction for the filing of an amendment under 37 CFR 1.312 on January 30, 2009, after the mailing of a notice of allowance is 38 days, not 39 days as was entered by the Office. Patentee's argument is not well taken. 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 39 days with said period beginning January 30, 2009, and ending March 9, 2009.

In view thereof, the patent term adjustment is 662 days (884 days of Office delay - 128 days of overlap - 94 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.

It is noted that the petition decision mailed July 7, 2009, indicated that no additional fees would be due provided the renewed petition argued mainly over three-year delay arguments. Accordingly, the fee set forth in 37 CFR 1.18(e) is not 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 **six hundred, sixty-two (662)** 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 : 7,574,975 B2

DATED : Aug. 18, 2009

INVENTOR(S) : Kline

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 (382) days

Delete the phrase "by 382 days" and insert – by 662 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

August 15, 2011

Patent No. : 7,432,650 B2
Appl. No. : 11/154,409
Inventor(s) : Koji Murayama, et al.
Issued : October 7, 2008
Title : **EL DISPLAY AND PRODUCTION METHOD THEREOF**
Docket No. : **KUSUMOTO 240-KFM**

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

All petitions for correction of Assignees' names under rule 3.81(b) should:

(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); (unless fee (currently $100) was previously paid for consideration of request for certificate of correction)

(C) include the processing fee set forth in 37 CFR 1.17(i).

The petition 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
(Hours of operation are 8:30 a.m. to midnight, Eastern Standard Time, Monday through Friday)

By fax: (571) 273-8300
ATTN: Office of Petitions

**Antonio Johnson**
For Mary F. Diggs
Decisions & Certificates
of Correction Branch
(571)272-0483

ECKERT SEAMANS CHERIN & MELLOTT, LLC
U.S. STEEL TOWER
600 GRANT STREET
PITTSBURGH PA 15219-2788

UNITED STATES PATENT AND TRADEMARK OFFICE

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ECKERT SEAMANS
CHERIN & MELLOTT, LLC
U.S. STEEL TOWER
600 GRANT STREET
PITTSBURGH PA 15219-2788

**MAILED**

JAN 17 2012

**OFFICE OF PETITIONS**

In re Patent No. 7,432,650 :
Issue Date: 7 October, 2005 :
Application No. 11/154,409 : ON PETITION
Filed: 16 June, 2005 :
Attorney Docket No. KUSUMOTO 240-KFM :

This is a decision on the petition filed on 30 August, 2011, pursuant to 37 C.F.R. §1.183 and §3.81(b) to correct, *inter alia*, the name of the assignee on the front page of the above-identified patent by way of a certificate of correction under 37 C.F.R. §1.323.

**NOTE:**

It appears that the instant application issued on 7 October, 2008, however, the assignment as to Kyocera was not received by the Office for recordation until 11 July, 2011.

It also is noted that Petitioner failed to submit the recordation data (Reel/Frame) with the petition.

The petition is **DISMISSED**.

ANALYSIS

Congress has authorized the issuance of patents in the name(s) of the assignee(s):

> **35 U.S.C. §152 Issue of patent to assignee.**
> Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title. (Emphasis supplied.)

The regulations at 37 C.F.R. §3.81 that set forth the applicable procedure:

> **§ 3.81 Issue of patent to assignee.**
>
> ***
>
> (b) *After payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance along with the processing fee set forth in § 1.17(I) of this chapter is submitted after the date of payment of the issue fee, but prior to issuance of the patent, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to §3.28, or a statement under §3.73(b).
> (c) *Partial assignees.*
>
> ***
>
> > (2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees. (Emphasis supplied.)

The commentary at MPEP §1481.01 provides that:

> ***
>
> 1481.01 Correction of Assignees' Names [R-3]
>
> ***
>
> Any request for the issuance of an application in the name of the assignee submitted after the date of payment of the issue fee *** must:
>
> > (A) state that the assignment was submitted for recordation as set forth in 37 C.F.R. §3.11 before issuance of the patent;
> > (B) include a request for a certificate of correction under 37 C.F.R. §1.323 along with the fee set forth in 37 C.F.R. §1.20(a); and
> > (C) include the processing fee set forth in 37 C.F.R. §1.17(i).
> > See 37 C.F.R. §3.81(b).

Petitioner has submitted a form for correction, but appears that Petitioner has not satisfied the requirement that the recordation predate issue.

Patent No. 7,432,650
Application No. 11/154,409

## CONCLUSION

Accordingly, the petition is **dismissed**.

The file is released to IFW Files Repository.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[1]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

---

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No.

MUNCK CARTER/NSC
P.O. DRAWER 800889
DALLAS TX 75380

**MAILED**

**DEC 03 2010**

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Patent No. 7764115 | : DECISION ON REQUEST |
| Adam Nicholas Fish | : FOR |
| Issue Date: 07/27/2010 | : RECONSIDERATION OF |
| Application No. 11/154436 | : PATENT TERM ADJUSTMENT |
| Filing or 371(c) Date: 06/16/2005 | : and |
| Atty Docket No. | : NOTICE OF INTENT TO ISSUE |
| P06260 | : CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on September 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 two (302) 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 two (302) days is **GRANTED**.

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

The application is being forwarded to the Certificates of 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 two (302)** 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 : 7,764,115 B1

DATED : **Jul. 27, 2010** **DRAFT**

INVENTOR(S) : Fish

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 57 days.

Delete the phrase "by 57 days" and insert – by 302 days--

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Alexandria, VA 22313-1450
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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

MAILED
MAR 16 2012
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of McComsey et al. | : | |
| Patent No. 8,084,490 | : | |
| Issued: December 27, 2011 | : | DECISION ON |
| Application No. 11/154,443 | : | REQUEST FOR RECONSIDERATION |
| Filed: June 16, 2005 | : | OF |
| Atty Docket No. PRD2233USNP | : | PATENT TERM ADJUSTMENT |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDE 37 C.F.R. §1.705(d) AFTER PATENT ISSUANCE," filed February 24, 2012. Patentees request that the revised patent term adjustment indicated on the patent be corrected from seven hundred sixty-four (764) days to seven hundred sixty-five (765) days.

The petition 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 seven hundred sixty-six (766) days.

On December 27, 2011, the above-identified application matured into U.S. Patent No. 8,084,490 with a revised patent term adjustment of 764 days. On February 24, 2012, patentees timely filed the instant petition.

Patentees argue that the patent term adjustment indicated in the patent is incorrect and should be recalculated. Patentees argue a 2 day reduction for payment of the issue fee on Monday, November 14, 2011, in response to the Notice of Allowance and Fee(s) Due, mailed August 12, 2011 is not warranted. Patentees assert they are potentially entitled to 2 additional days, reduced by the overlap with the Amendment under Rule 312, filed November 14, 2011, to at least 1 additional day. Petition p.2

Patentees dispute the period of reduction of 2 days, pursuant to 37 CFR 1.704(b), for Applicant delay in filing the issue fee on

November 14, 2011, a Monday, in response to the Notice of Allowance and Fee(s) Due, mailed August 12, 2011.

Patentees argue the Office miscalculated a reduction based on an asserted misinterpretation of 35 U.S.C. 154(b)(2)(C)(ii). Patentees argue a three month date (37 CFR 1.704(b)) should be calculated from the first business day after a weekend. This reduction has been reconsidered, and it is determined that entry of a reduction for this reply timely filed pursuant to 35 U.S.C. §21(b) is not warranted. Accordingly, the period of reduction of 2 days is being removed.

As for the Amendment under Rule 312, filed November 14, 2011: Since no reduction is in order in connection with the filing of the issue fee on November 14, 2011, there is no overlap with the 10 day reduction associated with the filing of a Rule 312 amendment on November 14, 2011.

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;

Pursuant to 37 CFR 1.704(c)(10), the Office properly entered a period of reduction of 10 days, counting the number of days in the period beginning on November 14, 2011, the date the Rule 312 amendment was filed, and ending on and including November 23, 2011, the date the Response to Rule 312 Communication was mailed. Accordingly no change will be made in connection with the 10 day reduction associated with the filing of a Rule 312 amendment on November 14, 2011.

In light thereof, the correct patent term adjustment is 766 days, which is 588 days of delay under 35 U.S.C. 154(b)(1)(A)

plus 287 days of delay under 35 U.S.C. 154(b)(1)(B) reduced by 109 (6 + 92 + 1 + 10) 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 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 **seven hundred sixty-six (766) 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 : 8,084,490 B2

DATED : **December 27, 2011** **DRAFT**

INVENTOR(S) : McComsey 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 764 days

Delete the phrase "by 764 days" and insert – by 766 days--

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE, WA 98104

**MAILED**

SEP 22 2010

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Reissue Application of | : |
| Kenneth J. Onion | : |
| Application No. 11/154,998 | : DECISION ON PETITION |
| Filed: June 15, 2005 | : UNDER 37 CFR 1.78(a)(3) |
| Original Patent No. 6,591,504 | : |
| Issue Date: July 15, 2003 | : |
| Attorney Docket No. 530055.402R1 | : |

This is a decision in response to the renewed petition, filed July 12, 2010, requesting acceptance of an unintentionally delayed claim under 35 U.S.C. 120 and 119(e) for the benefit of priority to the prior-filed applications set forth in the concurrently filed amendment. The petition is being treated under the provisions of 37 CFR 1.78(a) (3).

The petition is **GRANTED**.

A review of the file record of U.S. Patent No. 6,591,504 fails to disclose that a claim for the benefit of priority to the above-noted, prior-filed applications was made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) nor does it include a proper reference to the prior-filed application as required by 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i).

The instant application was filed June 15, 2005. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3), along with a reissue application, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed nonprovisional application after issuance of the original application into a patent. A petition under 37 CFR 1.78(a)(6) for an unintentionally delayed claim under 35 U.S.C. 119(e) is not required with a reissue application. *See* MPEP 1402.

A corrected Filing Receipt, which includes the priority claim to the prior filed nonprovisional and provisional applications, accompanies this decision on petition.

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

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 3724 for consideration by the examiner of applicant's entitlement to claim benefit of priority to the prior-filed applications.

Sherry D. Brinkley

Sherry D. Brinkley
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
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| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 11/154,998 | 06/15/2005 | 3724 | 2530 | 530055.402R1 | 13 | 8 |

**CONFIRMATION NO. 1953**

**CORRECTED FILING RECEIPT**

500
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE, WA 98104

*OC000000043452224*

Date Mailed: 09/10/2010

Receipt is acknowledged of this reissue 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)**

Kenneth J. Onion, Kaneohe, HI;

**Assignment For Published Patent Application**

KAI U.S.A., Ltd., dba Kershaw Knives, Tualatin, OR

**Power of Attorney:** The patent practitioners associated with Customer Number 00500

**Domestic Priority data as claimed by applicant**

This application is a REI of 09/904,194 07/12/2001 PAT 6,591,504
which is a CIP of 29/143,656 06/18/2001 PAT D,474,669
and is a CIP of 09/750,235 03/05/2001 PAT 6,427,334
which claims benefit of 60/173,233 12/28/1999
and said 09/904,194 07/12/2001
is a CIP of 09/591,183 06/08/2000 PAT 6,378,214
which claims benefit of 60/138,318 06/09/1999
and is a CIP of 09/483,075 01/14/2000 PAT 6,338,431
which claims benefit of 60/130,401 04/19/1999
and said 09/904,194 07/12/2001
is a CIP of 09/483,075 01/14/2000 PAT 6,338,431
which claims benefit of 60/130,401 04/19/1999

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 08/15/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/154,998**

**Projected Publication Date:** None, application is not eligible for pre-grant publication

**Non-Publication Request:** No

**Early Publication Request:** No
**Title**

Folding knife with safety lock

**Preliminary Class**

030

## 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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SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 S.W. FIFTH AVE.
PORTLAND, OR 97204

Mail Date: 10/21/2010

| | | |
|---|---|---|
| **Applicant** | : Kapil Sood | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7647508 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/155,148 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/16/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1078** 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.

**Doc Code: PET.PTA.RCAL**
**Document Description: Request for Recalculation in view of Wyeth**

PTO/SB/131 (01-10)
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: 040647 | Patent Number: 7,664,517 |
| Filing Date (or 371(b) or (f) Date): 06-16-2005 | Issue Date: 2-16-2010 |
| First Named Inventor: ARULMOZHI KASI ANANTHANARAYANAN | |
| Title: WIRELESS COMMUNICATION SYSTEM UTILIZING A PERSISTENCE VALUE FOR GROUP COMMUNICATION REQUESTS TO REDUCE LATENCY | |

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 | Date 08-02-2010 |
| Name (Print/Typed) Raphael Freiwirth | Registration Number 52918 |

***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.*

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

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

Mail Date: 08/20/2010

| | | |
|---|---|---|
| **Applicant** | : Arulmozhi Kasi Ananthanarayanan | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7664517 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/155,256 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/16/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **578** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/155,262 | 06/16/2005 | Philip James Bromley | 3800006.00002 / 5702 | 5339 |

77202 7590 10/21/2010
K&L Gates LLP
3580 Carmel Mountain Road
Suite 200
San Diego, CA 92130

| EXAMINER |
|---|
| MERCIER, MELISSA S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1615 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/21/2010 | 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

OCT 21 2010

K&L Gates LLP
3580 Carmel Mountain Road
Suite 200
San Diego CA 92130

| | |
|---|---|
| In re Application of: | : |
| Bromley et al. | : |
| Serial No.: 11/155,262 | : PETITION DECISION |
| Filed: June 16, 2005 | : |
| Attorney Docket No.: **3800006.00002 / 5702** | : |

This is in response to the petition under 37 CFR § 1.181, filed September 29, 2010, requesting correction of Information Disclosure Statement Classification.

BACKGROUND

Petitioner requests "correction of the classification in PAIR of the Information Disclosure Statements submitted on December 08, 2009 and July 16, 2010, in connection with the above-referenced application and consideration by the Examiner of the documents and information contained therein, respectfully is requested."

DECISION

The petition is **GRANTED.**

The documents submitted on December 08, 2009 and July 16, 2010 will be corrected to reflect "IDS" in PAIR and will be considered by the examiner.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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 22 2010
OFFICE OF PETITIONS

HARNESS, DICKEY & PIERCE P.L.C.
5445 CORPORATE DRIVE
SUITE 200
TROY, MI 48098

| | | |
|---|---|---|
| In re Application of | : | |
| Jorge Vicente Blasco Claret | : | |
| Application No. 11/155,316 | : | DECISION ON PETITION |
| Filed: June 17, 2005 | : | |
| Attorney Docket No. MP3751 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 22, 2010, to revive the above-identified application.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 15, 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 16, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment with drawings, (2) the petition fee of $1620, and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

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.

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 3611 for appropriate action by the Examiner in the normal course of business on the reply received November 22, 2010.

April M. Wise
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: ——

DATE : 2/3/2011

TO SPE OF : ART UNIT 3764

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/155328 Patent No.: 7766792B2

CofC mailroom date: 1/27/2011

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.

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

**Comments:** /SC/

LOAN H. THANH
SUPERVISORY PATENT EXAMINER

SPE

3764
Art Unit

PATENT
Docket No. 13915.48

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| In re application of | | ) |
| | William T. Dalebout et al | ) |
| Serial No.: | 11/155,328 | ) |
| Filed: | June 16, 2005 | ) Art Unit |
| | | ) 3764 |
| Conf. No.: | 2550 | ) |
| For: | BREAKAWAY OR FOLDING ELLIPTICAL EXERCISE MACHINE | ) |
| Examiner: | Stephen R. Crow | ) |
| Patent No.: | 7,766,797 B2 | ) |
| Issue Date: | August 3, 2010 | ) |

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

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

Dear Commissioner:

In accordance with the provisions of 37 C.F.R. § 1.323, which implements 35 U.S.C. § 255, the Director is respectfully requested to issue a Certificate of Correction to correct mistakes in the above-identified patent. The enclosed Patent Office Form PTO/SB/44 reflects the desired corrections.

Payment in the amount of $100.00, as set forth in 37 C.F.R. § 1.20(a) is submitted herewith to cover the costs for issuance of the requested Certificate of Correction. The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In

addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to Deposit Account No. 23-3178.

Dated this 27th day of January, 2011.

Respectfully submitted,

**/Colby C. Nuttall, Reg. No. 58,146/**

COLBY C. NUTTALL
Attorney for Applicant
Registration No.: 58,146
Customer No. 022913

WORKMAN NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
Phone: 801-533-9800
Fax: 801-328-1707

Transmitted: REQUEST FOR A CERTIFICATE OF CORRECTION UNDER 37 C.F.R. § 1.323
PTO Form PTO/SB/44

PTO/SB/44 (09-07)
Approved for use through 08/31/2010. 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)

OK TO ENTER SRC

# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION



PATENT NO. : 7,766,797 B2

APPLICATION NO. : 11/155,328

ISSUE DATE : Aug. 3, 2010

INVENTOR(S) : Dalebout et al.

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

Face
Item 56, References Cited, insert the reference --D336,141 8/1994 Husted et al.--
Item 56, Referenced Cited, insert the reference --2008/0162823 A1 8/2008 Dalebout et al.--

Column 1
Line 66, remove [on the]

Column 4
Line 55, after "art" insert --to--

Column 7
Line 24, change "rear portion **64**" to --rear portion **66**--
Line 26, change "front portion **66**" to --front portion **64**--
Line 33, change "rear portion **64**" to --rear portion **66**--
Line 36, change "rear portion **64**" to --rear portion **66**--
Lines 36-37, change "rear portion **64**" to --rear portion **66**--
Line 37, change "front portion **66**" to --front portion **64**--

Column 11
Line 9, change "axes-of" to --axes of--
Lines 22-23, change "first and second struts **184** and **206**" to --first and second struts **194** and **206**--

Column 12
Line 21, change "know" to --known--

Column 15
Line 33, change "drive assembly **312**" to --drive assembly **412**--

MAILING ADDRESS OF SENDER (Please do not use customer number)

**COLBY C. NUTTALL, WORKMAN NYDEGGER**
**1000 Eagle Gate Tower**
**60 East South Temple**
**Salt Lake City, Utah 84111**

This collection of information is required by 37 CFT 1.322, 1.323, and 1.324. 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 1.14. This collection is estimated to take 1.0 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. **SEND** TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

PTO/SB/44 (09-07)
Approved for use through 08/31/2010. 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)

OK TO ENTER SRC

# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION



PATENT NO. : 7,766,797 B2

APPLICATION NO. : 11/155,328

ISSUE DATE : Aug. 3, 2010

INVENTOR(S) : Dalebout et al.

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

Column 16
Lines 3-4, change "foot supports **14** and **22**" to --foot supports **14** and **44**--
Line 5, change "foot supports **14** and **18**" to --foot supports **14** and **44**--
Line 58, after "based" insert --on--

Column 17
Line 51, change "half circle" to --half-circle--

Column 20
Line 10, change "portions" to --portion--

MAILING ADDRESS OF SENDER (Please do not use customer number)

**COLBY C. NUTTALL, WORKMAN NYDEGGER**
**1000 Eagle Gate Tower**
**60 East South Temple**
**Salt Lake City, Utah 84111**

This collection of information is required by 37 CFT 1.322, 1.323, and 1.324. 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 1.14. This collection is estimated to take 1.0 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. **SEND** TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/28/09

TO SPE OF : ART UNIT 2624 Bella Matthew (Spe)

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/155391 Patent No.: 7460718

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:** _____

/Matthew Bella/ 2624

**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

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE, SUITE 2000
PHILADELPHIA PA 19103-6996

MAILED

AUG 30 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Roth, et al. | : | |
| Application No. 11/155,450 | : | DECISION |
| Filed/Deposited: 17 June, 2005 | : | |
| Attorney Docket No. 54480-5011CI1 | : | |

This is a decision on the petition filed on 29 June, 2010, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

**NOTE:**

Petitioner has submitted a request and fee for extension of time following the expiration of the statutory period, which Petitioner—as one registered to practice before the Office—knows is not proper.

The fee is being refunded via credit card.

Should Petitioner later find that the fee was not refunded, Petitioner should file a request with the Office of Finance and include therewith a copy of this decision.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

## BACKGROUND

The record reflects as follows:

Applicant failed to reply timely and properly to the final Office action mailed on 3 November, 2009, with reply due absent extension of time on or before 3 February, 2010.

The application went abandoned by operation of law after midnight 3 February, 2010.

The Office mailed a Notice of Abandonment on 14 May, 2010.

On 29 June, 2010, Petitioner/Counsel filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b), averring unintentional delay, with reply in the form of a request for continued examination and fee and submission pursuant to 37 C.F.R. §1.114 in the form of an amendment, and made the statement of unintentional delay.

*As noted above, Petitioner has submitted a request and fee for extension of time following the expiration of the statutory period, which Petitioner—as one registered to practice before the Office—knows is not proper. The fee is being refunded via credit card. Should Petitioner later find that the fee was not refunded, Petitioner should file a request with the Office of Finance and include therewith a copy of this decision.*

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

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

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

---

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

[2] 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[3]))

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements under the rule have been satisfied.

## CONCLUSION

Accordingly, the petition pursuant to 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to the Technology Center/AU 1612 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 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.

---

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[3] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

[4] The regulations at 37 C.F.R. §1.2 provide:
**§1.2 Business to be transacted in writing.**
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of 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

Charles Holley
PO Box 29
105 Lassen Lane
Milford PA 18337

MAILED
DEC 28 2010
OFFICE OF PETITIONS

In re Application of :
Charles Holley : DECISION ON PETITION
Application No. 11/155,460 :
Filed: 06/18/2005 :
Attorney Docket No. SPEC-TRAC :

This is a decision on the petition under 37 CFR 1.137(b), filed July 20, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed July 2, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 3, 2008. A Notice of Abandonment was mailed on February 18, 2010.

The Examiner determined that the amendment submitted on July 20, 2010, places the application in condition for allowance. Thus, the petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the required reply, (2) the petition fee, and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 2887 for appropriate action.

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

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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

**THE PROCTER & GAMBLE COMPANY**
**GLOBAL LEGAL DEPARTMENT - IP**
**SYCAMORE BUILDING – 4TH FLOOR**
**299 EAST SIXTH STREET**
**CINCINNATI, OH 45202**

**MAILED**

AUG 27 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **John Joseph CURRO**, et *al.* | : | |
| Application No. 11/155,805 | : | DECISION ON PETITION |
| Filed: June 17, 2005 | : | UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No. **9680M** | : | |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed February 27, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed with the petition.

The petition is **GRANTED**.

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.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this***

***application is entitled to the benefit of the prior-filed 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 the application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Monica A. Graves at (571) 272-7253. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 1786 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed applications.

Thurman K. Page
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 |
|---|---|---|---|---|---|---|
| 11/155,805 | 06/17/2005 | 1786 | 1486 | 9680M | 20 | 4 |

**CONFIRMATION NO. 5758**

**CORRECTED FILING RECEIPT**

*OC000000043203554*

27752
THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI, OH 45202

Date Mailed: 08/24/2010

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)**

John Joseph Curro, Cincinnati, OH;
Eric Bryan Bond, Maineville, OH;
John Lee Hammons, Hamilton, OH;
Jody Lynn Hoying, Maineville, OH;
Susan Nicole Lloyd, Erlanger, KY;
Robert Haines Turner, Cincinnati, OH;
Terrill Alan Young, Cincinnati, OH;

**Power of Attorney:** The patent practitioners associated with Customer Number 27752

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/581,679 06/21/2004
and is a CIP of 10/737,306 12/16/2003 PAT 7,553,532
which is a CIP of 10/435,996 05/12/2003 ABN
which is a CIP of 10/324,661 12/20/2002 ABN
This application 11/155,805
is a CIP of 10/737,430 12/16/2003 PAT 7,410,683
which is a CIP of 10/610,299 06/30/2003 ABN

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 07/14/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/155,805**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**Title**

Looped nonwoven web

**Preliminary Class**

428

## 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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LANDO & ANASTASI, LLP
W2023
ONE MAIN STREET
SUITE 1100
CAMBRIDGE MA 02142

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OCT 25 2010
OFFICE OF PETITIONS

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| In re Patent of Tchistiakova et al. : | |
| Patent No. 7,501,121 : | DECISION ON REQUEST |
| Application No. 11/155,843 : | FOR RECONSIDERATION OF |
| Issue Date: March 10, 2009 : | PATENT TERM ADJUSTMENT |
| Filed: June 17, 2005 : | UNDER 37 CFR 1.705(d) |
| Attorney Docket No. W2023-700430/ : | |
| AM101762 | |

This is a decision on the "PETITION TO SUSPEND THE RULES UNDER 37 C.F.R. § 1.183" and the "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181," both filed March 19, 2010. The petitions will be collectively treated as a petition under 37 CFR 1.183 to waive the two month time limit for filing a petition under 37 CFR 1.705(d). Patentees request that the patent term adjustment determination for the above-identified patent be changed from two hundred seventy-one (271) days to five hundred thirty-seven (537) days. Patentees request this correction on the basis that the Office took in excess of three years to issue this patent and 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 reconsideration under 37 CFR 1.183 is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DENIED** with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of 271 days. This decision may be viewed as a final agency action within the meaning of 5 U.S.C 704 and for purposes of seeking judicial review. *See* MPEP § 1002.02(b).

Your petition for reconsideration of the USPTO's PTA determination for U.S. Patent No. 7,501,121 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. The statutory judicial-review provisions of 35 U.S.C. sec. 154(b)(4) 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. 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 petition was filed beyond 180 days of the patent grant.

The Office acknowledges that patentees previously submitted the $200 fee set forth in § 1.18(e) on application for patent term adjustment filed May 8, 2009. The $400.00 Rule 183 petition fee was submitted on March 19, 2010. No additional fees are required.

The petition requesting suspension of the time limit for consideration of an application for patent term adjustment is denied.

Telephone inquiries specific to this matter should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.

Anthony Knight
Director
Office of Petitions

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15975 ALTON PARKWAY
IRVINE, CA 92618-3731

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AUG 05 2010

OFFICE OF PETITIONS

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| In re Application of | : | |
| Tomoaki Yamanaka | : | |
| Application No. 11/155,869 | : | DECISION ON PETITION |
| Filed: June 16, 2005 | : | |
| Attorney Docket No. 10009271US01 | : | |

This is a decision on the petition filed April 9, 2010, which is being treated as a petition under 1.181 (no fee) requesting withdrawal of the holding of abandonment.

The petition is **DISMISSED.**

The application became abandoned for failure s to timely pay the issue and publication fees on or before March 22, 2010, as required by the Notice of Allowance and Fee(s) Due (Notice), mailed December 22, 2009, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on March 23, 2010.

Petitioner asserts that the issue and publication fees were not paid in response to the December 22, 2009 Notice as he was under the impression that he had additional time to respond because of the Supplemental Notice of Allowability mailed February 22, 2010.

A review of the written record indicates that the application was allowed and the Notice of Allowance and Fee(s) Due was mailed December 22, 2009. On February 22, 2010 a Supplemental Notice of Allowability was mailed. This supplemental Notice acknowledged the information disclosure statement filed January 12, 2010. While the supplemental Notice mentioned that the "applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements, it in no way extended the Notice of Allowance and Issue Fee(s) Due. The time for paying the issue and publication fee was not extendable.

In view of the above, the petition to withdraw the holding of abandonment cannot be granted at the present time.

**ALTERNATIVE VENUE**

Petitioner may wish to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application.

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).

Any further petition to revive 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." 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

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

Telephone inquiries concerning this decision should be directed to April M. Wise at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Office of Data Management at their hotline 571-272-4200.

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 28 2010

OFFICE OF PETITIONS

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| In re Application of | : | |
| Tomoaki Yamanaka | : | |
| Application No. 11/155,869 | : | DECISION ON PETITION |
| Filed: June 16, 2005 | : | |
| Attorney Docket No. 10009271US01 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 24, 2010, to revive the above-identified application.

This application became abandoned for failure to timely pay the issue and publication fees on or before March 22, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed December 22, 2009. Accordingly, the date of abandonment of this application is March 23, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1510 and the publication fee of $300, (2) the petition fee of $1620; and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning this application should be directed to the Office of Data Management at their hotline 571-272-4200.

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

April M. Wise
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FISH & RICHARDSON PC
PO BOX 1022
MINNEAPOLIS MN 55440-1022

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JUN 28 2011
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| In re Patent No. 7,903,099 | : DECISION ON |
| Baluja | : REQUEST FOR RECONSIDERATION |
| Application No. 11/155,881 | : of PATENT TERM ADJUSTMENT |
| Issue Date: March 8, 2011 | : |
| Filed: June 20, 2005 | : |
| Attorney Docket No. 16113-0657001 | : |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)", filed May 5, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected from one thousand three hundred eighteen (1318) days to one thousand four hundred fifty-three (1453) days.

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

On March 8, 2011, the instant application matured into U.S. Patent No. 7,903,099 with a patent term adjustment of one thousand three hundred eighteen (1318) days. The Office determined a patent term adjustment of 1318 days based upon 1058 days of Office delay pursuant to 37 CFR 1.703(a)(1) and 695 days of Office delay pursuant to 37 CFR 1.703(b), reduced by 28 days of Applicant delay under 37 CFR 1.704(b) and 19 days of Applicant delay under 37 CFR 1.704(c)(10).

Patentee argues that even though he filed an RCE on May 17, 2010, he should be awarded 37 CFR 1.703(b) "over three year" delay from the time the Office mailed a Notice of Allowance on October 25, 2010 until the issue date of the patent. In other words, Patentee argues that no continued examination took place during this time period, and the Office should be accorded 135 additional days of delay pursuant to 37 CFR 1.703(b). Patentee's argument has been considered, but is not persuasive.

## RELEVANT STATUTE AND REGULATIONS

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

> (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
>
> (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), 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.

The implementing regulation, 37 CFR 1.702(b) provides that:

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);
> (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
> (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
> (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
> (5) Any delay in the processing of the application by the Office that was requested by the applicant.

## OPINION

Patentee's arguments have been considered, but not found persuasive. The Office calculated the period of "B delay" pursuant to 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.702(b)(1) as 695 days based on the application having been filed under 35 U.S.C. 111(a) on June 20, 2005 and a request for continued examination under 132(b) having been filed on May 17, 2010. In other words, the 135 day period beginning on the date of mailing of the notice of allowance on

October 25, 2010 to the date of issuance of the patent was considered time consumed by continued examination of an application under 35 U.S.C. 132(b) and was not included in the "B delay."

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.

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.

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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.

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), 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.

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.

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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.

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 procedures3 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).

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[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.

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 May 17, 2010, and the patent issued by virtue of that request on March 8, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on May 17, 2010 and ending on March 8, 2011 is not included in calculating Office delay.

## CONCLUSION

In view thereof, it is concluded that the patent term adjustment of 1318 days indicated on the patent is correct.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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| In re Patent No. 7,903,099 | : DECISION ON |
| Baluja | : REQUEST FOR RECONSIDERATION |
| Application No. 11/155,881 | : of PATENT TERM ADJUSTMENT |
| Issue Date: March 8, 2011 | : |
| Filed: June 20, 2005 | : |
| Attorney Docket No. 16113-0657001 | : |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)", filed August 29, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected from one thousand three hundred eighteen (1318) days to one thousand four hundred fifty-three (1453) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **DENIED.** This decision is a final agency action within the meaning of 5 U.S.C. §704 for purposes of seeking judicial review. *See* MPEP 1002.02.

On March 8, 2011, the instant application matured into U.S. Patent No. 7,903,099 with a patent term adjustment of one thousand three hundred eighteen (1318) days. The Office determined a patent term adjustment of 1318 days based upon 1058 days of Office delay pursuant to 37 CFR 1.703(a)(1) and 695 days of Office delay pursuant to 37 CFR 1.703(b), reduced by 28 days of Applicant delay under 37 CFR 1.704(b) and 19 days of Applicant delay under 37 CFR 1.704(c)(10).

Patentee argues that even though he filed an RCE on May 17, 2010, he should be awarded 37 CFR 1.703(b) "over three year" delay from the time the Office mailed a Notice of Allowance on October 25, 2010 until the issue date of the patent. In other words, Patentee argues that no continued examination took place during this time period, and the Office should be accorded 135 additional days of delay pursuant to 37 CFR 1.703(b). Patentee's argument has been considered, but is not persuasive.

## RELEVANT STATUTE AND REGULATIONS

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(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), 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.

The implementing regulation, 37 CFR 1.702(b) provides that:

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);
(2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
(4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
(5) Any delay in the processing of the application by the Office that was requested by the applicant.

## OPINION

Patentee's arguments have been considered, but not found persuasive. The Office calculated the period of "B delay" pursuant to 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.702(b)(1) as 695 days

based on the application having been filed under 35 U.S.C. 111(a) on June 20, 2005 and a request for continued examination under 132(b) having been filed on May 17, 2010. In other words, the 135 day period beginning on the date of mailing of the notice of allowance on October 25, 2010 to the date of issuance of the patent was considered time consumed by continued examination of an application under 35 U.S.C. 132(b) and was not included in the "B delay."

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.

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

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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.

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), 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.

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

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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.

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 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 May 17, 2010, and the patent issued by virtue of that request on March 8, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on May 17, 2010 and ending on March 8, 2011 is not included in calculating Office delay.

## CONCLUSION

The prior decision has been reconsidered. However, for the reasons stated above, it is concluded that the patent term adjustment of 1318 days indicated on the patent is correct.

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

Anthony Knight
Director
Office of Petitions

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[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.

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| In re Patent No. 7,903,099 | : | |
| Baluja | : | FINAL AGENCY DECISION |
| Application No. 11/155,881 | : | ON REQUEST TO INVOKE THE |
| Issue Date: March 8, 2011 | : | SUPERVISORY AUTHORITY |
| Filed: June 20, 2005 | : | OF THE DIRECTOR |
| Attorney Docket No. 16113-0657001 | : | |

This is a decision on the petition captioned "PETITION UNDER 37 C.F.R. § 181(a)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR", filed Monday, November 14, 2011, requesting that the Director review the Final Agency Decision on Request for Reconsideration of Decision on Application for Patent Term Adjustment ("Decision") mailed by the Office of Petitions on September 13, 2011.

The Decision maintains that the above-identified patent is entitled to one thousand three hundred eighteen (1318) days of patent term adjustment ("PTA"). Patentee requests that the Director review the decision and modify the PTA calculation to one thousand four hundred fifty-three (1453) days.

The decision of the Director of the Office of Petitions has been reviewed. However, because no error has been found in the decision, the petition under 37 CFR §1.181 is **DENIED**.

The patent term adjustment remains 1318 days, as indicated in the final agency action of September 13, 2011.

Andrew Hirshfeld
Associate Commissioner for Patent Examination Policy

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 10/03/11

**TO SPE OF** : ART UNIT 1624

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 11155965 Patent No.: 7579479

**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**
**You can fax the Directors/SPE response to 571-273-3421**

**Note:** **Should the changes to claim 5 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:** _____

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

1624

**SPE** **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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Paper No.

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

**MAILED**

MAR 02 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Zur et al. | : | |
| Application No. 11/155,966 | : | ON APPLICATION FOR |
| Filed: Jun. 17, 2005 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. | : | |
| 16366US03 | : | |

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 on December 21, 2010, which is treated as an application for patent term adjustment under 37 CFR 1.705(b). Applicants submit that the patent term adjustment to be indicated on the patent should be increased from 984 days to 1692 days. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue the patent.

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). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

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

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, 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). No additional fees are required.

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.

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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.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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

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

In re Application of :
Stemmer, et al. :DECISION ON APPLICATION
Application No.: 11/155,989 :FOR ADJUSTMENT
Filed: June 17, 2005 :PATENT TERM ADJUTSMENT
Attorney Docket No. **A-1218-US-CIP2** :

This is in response to the "Notice of Possible PTO Error in the Determination of Patent Term Adjustment and Request for Clarification of Calculation", filed April 9, 2010, which will be treated as a petition under 37 CFR 1.705(b). Applicants request that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

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

The Office has updated the PALM and PAIR screens to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred and forty-nine (349) days. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

The application history has been reviewed and it has been determined that applicant should have been assessed a delay under 37 CFR 1.704(b)[1] for filing a reply in excess of the three

[1] 37 CFR 1.704(b) states:

> 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,

month period from the August 15, 2005, mailing date of the Notice to File Missing Parts of Non-Provisional Application. On August 15, 2005, a Notice to File Missing Parts of Non-Provisional Application was mailed. On December 5, 2005, applicants filed a response to the Notice to File Missing Parts of Non-Provisional Application. Thus, applicant failed to engage in reasonable efforts to conclude processing or examination of this application. Accordingly, the period of adjustment set forth in § 1.703 should have been reduced under 37 CFR 1.704(b) by 20 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the Notice to File Missing Parts of Non-Provisional Application, November 16, 2005, and ending on the date the reply was filed, December 5, 2005. A period of reduction of 20 days will be entered.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is three hundred and forty-nine (349) days (369 days of Office delay - 20 days of applicant delay).

Deposit account 06-0916 will be charged $200.00 for the fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

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

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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.

Telephone inquiries regarding this specific 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 REVISED PALM screen

PALM INTRANET

Day : Thursday
Date: 8/12/2010
Time: 23:42:09

| PTA Calculations for Application: 11/155989 | | | |
|---|---|---|---|
| Application Filing Date: | 06/17/2005 | PTO Delay (PTO): | 369 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 0 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 349 |
| PTO Delay Adjustment: | -20 | | |

File Contents History

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 107 | 08/12/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 20 | |
| 97 | 01/11/2010 | MAIL NOTICE OF ALLOWANCE | | | |
| 96 | 01/08/2010 | ISSUE REVISION COMPLETED | | | |
| 95 | 01/08/2010 | DOCUMENT VERIFICATION | | | |
| 94 | 01/08/2010 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 93 | 01/08/2010 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 92 | 01/08/2010 | NOTICE OF ALLOWABILITY | | | |
| 90 | 11/02/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 89 | 12/09/2009 | FINISHED INITIAL DATA CAPTURE | | | |
| 87 | 11/02/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 86 | 11/04/2009 | DATE FORWARDED TO EXAMINER | | | |
| 85 | 11/02/2009 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 84 | 11/04/2009 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 83 | 11/02/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 82 | 11/02/2009 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 81 | 08/07/2009 | MISCELLANEOUS INCOMING LETTER | | | |
| 80 | 09/02/2009 | WORKFLOW - DRAWINGS FINISHED | | | |
| 79 | 09/09/2009 | WORKFLOW - QUERY REQUEST - FINISH | | | |
| 78 | 09/02/2009 | TC RETURN TO PUBS | | | |
| 77 | 08/31/2009 | SEQUENCE FORWARDED TO PUBS ON TAPE | | | |
| 76 | 08/27/2009 | WORKFLOW - QUERY REQUEST - BEGIN | | | |
| 75 | 08/17/2009 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 74 | 08/13/2009 | MAIL EXAMINER'S AMENDMENT | | | |
| 73 | 08/13/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 72 | 08/12/2009 | ISSUE REVISION COMPLETED | | | |
| 71 | 08/12/2009 | DOCUMENT VERIFICATION | | | |
| 70 | 08/12/2009 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 69 | 08/12/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 68 | 08/12/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 67 | 08/12/2009 | NOTICE OF ALLOWABILITY | | | |
| 63 | 06/03/2009 | DATE FORWARDED TO EXAMINER | | | |
| 62 | 05/04/2009 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 59 | 02/04/2009 | MAIL NON-FINAL REJECTION | | | |
| 58 | 02/02/2009 | NON-FINAL REJECTION | | | |
| 55 | 11/11/2008 | DATE FORWARDED TO EXAMINER | | | |
| 54 | 10/07/2008 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 53 | 07/07/2008 | MAIL NON-FINAL REJECTION | | | |
| 52 | 07/03/2008 | NON-FINAL REJECTION | | | |
| 50 | 04/26/2008 | DATE FORWARDED TO EXAMINER | | | |
| 49 | 03/27/2008 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 48 | 02/26/2008 | MAIL RESTRICTION REQUIREMENT | | | |
| 47 | 02/19/2008 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 36 | 05/11/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 33 | 12/13/2007 | DATE FORWARDED TO EXAMINER | | | |
| 32 | 11/21/2007 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 31 | 11/21/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 30 | 11/02/2007 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 29 | 11/01/2007 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 28 | 08/21/2007 | MAIL RESTRICTION REQUIREMENT | 369 | | -1 |
| 27 | 08/20/2007 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 25 | 03/30/2007 | MAIL-PETITION DECISION - GRANTED | | | |
| 24 | 03/22/2007 | CORRESPONDENCE ADDRESS CHANGE | | | |

| | | | | | |
|---|---|---|---|---|---|
| 23 | 03/22/2007 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 22 | 11/21/2006 | PETITION ENTERED | | | |
| 21 | 08/07/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 20 | 12/05/2005 | PRELIMINARY AMENDMENT | | | |
| 19 | 08/07/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 18 | 05/11/2006 | REFERENCE CAPTURE ON IDS | | | |
| 17.7 | 05/11/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 17 | 05/11/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 16 | 05/01/2006 | APPLICATION RETURN FROM OIPE | | | |
| 15 | 05/01/2006 | APPLICATION IS NOW COMPLETE | | | |
| 14 | 05/01/2006 | APPLICATION RETURN TO OIPE | | | |
| 13 | 04/28/2006 | APPLICATION DISPATCHED FROM OIPE | | | |
| 12 | 04/28/2006 | APPLICATION IS NOW COMPLETE | | | |
| 11 | 12/05/2005 | ADDITIONAL APPLICATION FILING FEES | | | |
| 10 | 12/05/2005 | SMALL ENTITY STATEMENT (37 CFR 1.27) | | | |
| 9 | 06/17/2005 | CLAIM PRELIMINARY AMENDMENT | | | |
| 8 | 12/05/2005 | A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN | | | |
| 7 | 12/05/2005 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 6 | 12/13/2005 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 5 | 08/16/2005 | CLEARED BY L&R (LARS) | | | |
| 3 | 07/01/2005 | REFERRED TO LEVEL 2 (LARS) BY OIPE CSR | | | |
| 2 | 06/28/2005 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 06/17/2005 | 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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IRVINE, CA 92614

MAILED

DEC 20 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Donald T. Shannon | : | |
| Application No. 11/156,028 | : | DECISION ON PETITION |
| Filed: June 17, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 37888-01400 | : | 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 18, 2010.

The request is **APPROVED**.

The request was signed by Peter J. Gluck on behalf of the practitioners of record associated with Customer Number 86451.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to inventor Donald Shannon at the address indicated below.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Donald Shannon
30 Fairbanks, Suite 114
Irvine, CA 92618

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/156,028 | 06/17/2005 | Donald T. Shannon | 37888-01400 |

**CONFIRMATION NO. 5404**

**POWER OF ATTORNEY NOTICE**

86451
Luce, Forward, Hamilton & Scripps LLP
2050 Main Street, Suite 600
Irvine, CA 92614

*OC000000044994926*

Date Mailed: 12/17/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 11/18/2010.

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

/idingle/

---

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

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 |
|---|---|---|---|
| 11/156,028 | 06/17/2005 | Donald T. Shannon | 37888-01400 |

**CONFIRMATION NO. 5404**

**POA ACCEPTANCE LETTER**

Donald Shannon
30 Fairbanks, Suite 114
Irvine, CA 92618

*OC000000044994927*

Date Mailed: 12/17/2010

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 11/18/2010.

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

/idingle/

---

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

| | |
|---|---|
| **Doc Code: PET.AUTO**<br>**Document Description: Petition automatically granted by EFS-Web** | PTO/SB/83<br>U.S. Patent and Trademark Office<br>Department of Commerce |

| | |
|---|---|
| Electronic Petition Request | **REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS** |
| Application Number | 11156081 |
| Filing Date | 17-Jun-2005 |
| First Named Inventor | Martin Pralle |
| Art Unit | 2815 |
| Examiner Name | JAY KIM |
| Attorney Docket Number | 082128-0127 IOPL-0123 |
| Title | Photonic crystal emitter, detector and sensor |

◉ Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number: 48329

The reason(s) for this request are those described in 37 CFR:

10.40(b)(4)

Certifications

☒ I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment

☒ I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled

☒ I/We have notified the client of any responses that may be due and the time frame within which the client must respond

Change the correspondence address and direct all future correspondence to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71:

| | |
|---|---|
| Name | ION OPTICS 411 WAVERLY OAKS ROAD |
| Address | SUITE 144 |
| City | WALTHAM |
| State | MA |
| Postal Code | 02154 |
| Country | US |

| I am authorized to sign on behalf of myself and all withdrawing practitioners. | |
|---|---|
| Signature | /Teja, Joseph Jr/ |
| Name | Teja, Joseph Jr |
| Registration Number | 45157 |

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Decision Date : July 15,2011

In re Application of :

Martin Pralle

Application No : 11156081

Filed : 17-Jun-2005

Attorney Docket No : 082128-0127 IOPL-0123

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY/AGENTOF RECORD

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed July 15,2011

The request is **APPROVED.**

The request was signed by Teja, Joseph Jr (registration no. 45157 ) on behalf of all attorneys/agents associated with Customer Number 48329 . All attorneys/agents associated with Cusotmer Number 48329 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

| | |
|---|---|
| Name | ION OPTICS |
| Name2 | 411 WAVERLY OAKS ROAD |
| Address 1 | SUITE 144 |
| Address 2 | |
| City | WALTHAM |
| State | MA |
| Postal Code | 02154 |
| Country | US |

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED
JAN 12 2011
OFFICE OF PETITIONS

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO CA 92121

| | | |
|---|---|---|
| In re Application of | : | |
| Harleen K. Gill et al. | : | |
| Application No. 11/156,178 | : | DECISION ON PETITION |
| Filed: June 17, 2005 | : | |
| Attorney Docket No. 040649 | : | |

This is a decision on the petition, filed July 30, 2010, which is being treated as a petition under 37 CFR 1.183 "to waive the two month time period set forth in 37 CFR 41.41(a)(1) for filing the Reply Brief in this appeal."

The petition is **DISMISSED**.

The petition fee of $400 under 37 CFR 1.17(f), required for consideration of a petition under 37 CFR 1.183, has been charged to Deposit Account 17-0026, as authorized.

An Appeal Brief was filed in the instant application in January 27, 2010. Examiner responded with an Examiner's Answer on May 27, 2010. Appellants filed a reply brief on July 30, 2010, along with the instant petition under 37 CFR 1.183 "to waive the two month time period set forth in 37 CFR 41.41(a)(1) for filing the Reply Brief in this appeal."

Under 37 CFR 41.41(a)(1) and 41.43(b), appellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer or supplemental examiner's answer. Extensions of time to file the reply brief may be granted pursuant to 37 CFR 1.136(b) (for patent applications). Extensions of time under 37 CFR 1.136(a) are not permitted. See MPEP § 1208 (I).

37 CFR 1.136(b) states:

> *(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any*

*request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings; § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Interferences. Any request under this section must be accompanied by the petition fee set forth in § 1.17(g).*

37 CFR 1.183 states:

*In an extraordinary situation, when justice re-quires, 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).*

Petitioner had the option of requesting an extension of time under 1.136(b) during the time period when such extension was available. However, the record indicates that such an extension of time was not requested. Petitioner states "[i]t was believed that the Reply Brief had been timely e-filed using the PTO's e-file system. Upon checking docketing information, it was later determined that an inadvertent mistake had been made in the filing of the Reply Brief in that the docket number of this application was mixed up with the docket number from another application in a similar situation. As a result, the Reply Brief in this application was not timely filed." A review of the Reply Brief indicates that it was signed on July 23, 2010, and was presumably ready for submission to USPTO on or about July 23, 2010. However, it was submitted via USPTO's Electronic Filing System (EFS) on July 30, 2010. It is not clear from the petition whether the alleged mix up of the docket number of the instant application "with the docket number from another application in a similar situation" resulted in the filing of the reply brief in question in "another application." If so, petitioner must identify the other application by serial number. Petitioner's reference to 37 CFR 41.1(b) has been noted. However, an appeal to the provisions of 37 CFR 41.1(b) will not warrant suspension of the two-month reply requirement set forth in 37 CFR 41.41(a)(1). Petitioner has not shown an extraordinary circumstance where justice requires suspension of the rules. Accordingly, the petition is DISMISSED.

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

By mail: Mail Stop PETITIONS

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

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

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-4914.

This decision is forwarded to Technology Center Group Art Unit 2618 for further processing.

Ramesh Krishnamurthy

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No.

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

MAILED
JUL 11 2011
OFFICE OF PETITIONS

In re Application of :
Elzur et al. :
Application No. 11/156,206 : ON APPLICATION FOR
Filed: June 17, 2005 : PATENT TERM ADJUSTMENT
Atty Docket No. 16363US03 :

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 January 6, 2011. Applicant requests reconsideration of the initial determination of patent term adjustment solely on the basis that the Office will take in excess of three years to issue the patent.

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

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term 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).

---

[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 application is being forwarded to the Office of Data Management for processing into a patent.

Telephone inquiries specific 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
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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

AUG 08 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Uri Elzur et al | : | |
| Application No. 11/156,206 | : | DECISION GRANTING PETITION |
| Filed: June 17, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 11/156,206 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 8, 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 August 8, 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) 272-3208.

This application is being referred to Technology Center AU 2184 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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JAN 18 2011

OFFICE OF PETITIONS

**KILPATRICK TOWNSEND & STOCKTON LLP**
**TWO EMBARCADERO CENTER**
**EIGHTH FLOOR**
**SAN FRANCISCO CA 94111-3834**

| | | |
|---|---|---|
| In re Application of | : | |
| Christopher Pate et al. | : | |
| Application No. 11/156,213 | : | DECISION ON PETITION |
| Filed: June 17, 2005 | : | |
| Attorney Docket No. **09623E-055300US** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 17, 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, January 28, 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 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 $1620, and (3) a proper statement of unintentional delay. Accordingly, the reply to the non-final Office action of January 28, 2010 is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 2629 for appropriate action on the concurrently filed amendment.

Ramesh Krishnamurthy

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ALLERGAN, INC.
2525 DUPONT DRIVE, T2-7H
IRVINE CA 92612-1599

**MAILED**

NOV 18 2011

**OFFICE OF PETITIONS**

In re Application of
Pamela D. Van Shaack et al.
Application No. 11/156,502
Filed: June 17, 2005
Attorney Docket No. 17798 (BOT)

LETTER REGARDING
PATENT TERM ADJUSTMENT

This letter is in response to the "PETITION UNDER M.P.E.P. §1.705(B)", filed November 9, 2011. Pursuant to their duty of good faith and candor to the Office, applicants note that the term determined by the Office is 107 days greater than the term to which Applicants are entitled.

The request for review of the initial determination of patent term adjustment (PTA) 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 six hundred forty-five **(645)** days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On October 21, 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 752 days. Applicants direct the office to the amendment filed August 14, 2008 and argues that the response is a Supplemental Response, which under 37 C.F.R. 1.704(c)8 should reduce the PTA.

A review of the record reveals that the initial determination of patent term adjustment of 752 days is incorrect.

Pursuant to 37 CFR 1.704(b), a period of reduction of 107 days should have been entered. 37 CFR 1.704(b) provides that:

> 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.

In this instance, a non-Final Office action was mailed November 29, 2007. An amendment filed April 29, 2008 was not in compliance and the period for reply continued to run. (See Notice of Non-Compliant Amendment (37 CFR 1.121) mailed August 6, 2008). A proper reply, was not received in the Office until August 14, 2008. Pursuant to § 1.704(b), the patent term adjustment should have been reduced by an additional 107 days for applicant delay from April 29, 2008 to August 14, 2008, the date of filing of the reply to the non-Final Amendment.

In view thereof, the determination of Patent Term Adjustment at the time of the mailing of the notice of allowance is SIX HUNDRED FORTY-FIVE (645)days (37 days of "A delay days" plus 931 "C delay days" reduced by 323 days of applicant delay).

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

Applicants are reminded 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 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*: 11156502 Search Explanation of PTA Calculation Explanation of PTE Calculation

## PTA Calculations for Application: 11156502

| | | | |
|---|---|---|---|
| Application Filing Date | 06/17/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 968 |
| A Delays | 37 | PTO Manual Adjustment | -107 |
| B Delays | 0 | Applicant Delay (APPL) | 216 |
| C Delays | 931 | Total PTA (days) | 645 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 88 | 11/17/2011 | | P028 | Adjustment of PTA Calculation by PTO | | 107 | 0 |
| 82 | 10/21/2011 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 81 | 10/19/2011 | | OAR | Office Action Review | | | 0 |
| 80 | 10/19/2011 | | OAR | Office Action Review | | | 0 |
| 79 | 10/19/2011 | | IREV | Issue Revision Completed | | | 0 |
| 78 | 10/19/2011 | | DVER | Document Verification | | | 0 |
| 77 | 10/19/2011 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 76 | 10/19/2011 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 75 | 10/17/2011 | | EX.R | Reasons for Allowance | | | 0 |
| 74 | 10/17/2011 | | CNTA | Allowability Notice | | | 0 |
| 70 | 09/28/2011 | | ELC_RVW | Electronic Review | | | 0 |
| 69 | 09/28/2011 | | EML_NTF | Email Notification | | | 0 |
| 68 | 09/28/2011 | 03/12/2009 | MAPDR | Mail BPAI Decision on Appeal - Reversed | 931 | | 47 |
| 67 | 09/26/2011 | | APDR | BPAI Decision - Examiner Reversed | | | 0 |
| 65 | 05/06/2010 | | AP_DK_M | Docketing Notice Mailed to Appellant | | | 0 |
| 64 | 05/05/2010 | | APAS | Assignment of Appeal Number | | | 0 |
| 63 | 05/03/2010 | | APWD | Appeal Awaiting BPAI Docketing | | | 0 |
| 62 | 04/28/2010 | | MRBNE | Mail Reply Brief Noted by Examiner | | | 0 |
| 61 | 04/26/2010 | | RBNE | Reply Brief Noted by Examiner | | | 0 |
| 60 | 02/19/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 58 | 02/19/2010 | | TCWD | Appeal ready for BPAI docketing | | | 0 |
| 57 | 02/05/2010 | | MM327 | Mail Miscellaneous Communication to Applicant | | | 0 |
| 56 | 02/02/2010 | | M327 | Miscellaneous Communication to Applicant - No Action Count | | | 0 |
| 59 | 01/27/2010 | | APRB | Reply Brief Filed | | | 0 |
| 55 | 01/04/2010 | | TCRD | Return of Undocketed appeal to the TC | | | 0 |
| 54 | 01/04/2010 | | PACC | Exam. Ans. Review Complete | | | 0 |
| 53 | 12/09/2009 | | MAPEA | Mail Examiner's Answer | | | 0 |
| 52 | 12/07/2009 | | APEA | Examiner's Answer to Appeal Brief | | | 0 |
| 51 | 10/04/2009 | | APBR | Appeal Brief Review Complete | | | 0 |
| 50 | 10/04/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 49 | 09/14/2009 | | AP.B | Appeal Brief Filed | | | 0 |
| 48 | 09/14/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 47 | 03/12/2009 | 02/12/2009 | N/AP | Notice of Appeal Filed | | 28 | 45 |
| 46 | 03/12/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 45 | 11/12/2008 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 44 | 11/10/2008 | | CTFR | Final Rejection | | | 0 |
| 43 | 08/28/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 41 | 08/25/2008 | | C.AD | Correspondence Address Change | | | 0 |
| 42 | 08/14/2008 | | A... | Response after Non-Final Action | | | 0 |
| 40 | 08/06/2008 | | MCTMS | Mail Miscellaneous Communication to Applicant | | | 0 |
| 39 | 08/04/2008 | | CTMS | Miscellaneous Action with SSP | | | 0 |
| 38 | 06/02/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 37 | 04/29/2008 | 02/29/2008 | A... | Response after Non-Final Action | | 60 | 35 |
| 36 | 04/29/2008 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 35 | 11/29/2007 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 34 | 11/26/2007 | | CTNF | Non-Final Rejection | | | 0 |
| 32 | 08/29/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 30 | 08/29/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 28 | 08/29/2007 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 31 | 08/21/2007 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 29 | 08/21/2007 | 06/23/2007 | RCEX | Request for Continued Examination (RCE) | | 59 | 24 |
| 27 | 08/21/2007 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 33 | 04/19/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 26 | 04/19/2007 | | RCAP | Reference capture on IDS | | | 0 |
| 25.7 | 04/19/2007 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 25 | 04/19/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |

| | | | | | | | |
|---|---|---|---|---|---|---|---|
| 24 | 03/23/2007 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 23 | 03/19/2007 | | CTFR | Final Rejection | | | 0 |
| 22 | 01/05/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 21 | 12/14/2006 | 10/06/2006 | A... | Response after Non-Final Action | | 69 | 19 |
| 20 | 12/14/2006 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 19 | 07/06/2006 | 05/30/2006 | MCTNF | Mail Non-Final Rejection | 37 | | 15 |
| 18 | 05/15/2006 | | CTNF | Non-Final Rejection | | | 0 |
| 16 | 02/02/2006 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 15 | 01/30/2006 | | ELC. | Response to Election / Restriction Filed | | | 0 |
| 14 | 12/29/2005 | | MCTRS | Mail Restriction Requirement | | | 0 |
| 13 | 12/23/2005 | | CTRS | Restriction/Election Requirement | | | 0 |
| 10 | 10/04/2005 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 9 | 10/04/2005 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 17 | 09/30/2005 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 12 | 09/30/2005 | | RCAP | Reference capture on IDS | | | 0 |
| 11.7 | 09/30/2005 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 11 | 09/30/2005 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 7 | 07/15/2005 | | COMP | Application Is Now Complete | | | 0 |
| 8 | 07/14/2005 | | WROIPE | Application Return from OIPE | | | 0 |
| 6 | 07/14/2005 | | ROIPE | Application Return TO OIPE | | | 0 |
| 4 | 07/14/2005 | | COMP | Application Is Now Complete | | | 0 |
| 5 | 07/13/2005 | | OIPE | Application Dispatched from OIPE | | | 0 |
| 3 | 06/29/2005 | | L194 | Cleared by OIPE CSR | | | 0 |
| 2 | 06/24/2005 | | SCAN | IFW Scan & PACR Auto Security Review | | | 0 |
| 1 | 06/17/2005 | | IEXX | Initial Exam Team nn | | | 0 |
| 0.5 | 06/17/2005 | | EFILE | Filing date | | | 0 |

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IRVINE CA 92612-1599

MAILED
APR 19 2012
OFFICE OF PETITIONS

In re Patent No. 8,105,611
Issue Date: January 31, 2012
Application No. 11/156,502
Filed: June 17, 2005
Attorney Docket No. 17798 (BOT)

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

This letter is in response to the "PETITION UNDER M.P.E.P. §1.705(D)", filed March 26, 2012. Patentees request that the patent term adjustment indicated on the patent be increased by eighty-four (84) days.

The request for reconsideration of patent term adjustment is **GRANTED to the extent indicated herein**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of six hundred forty-five (645) days.

Patentees dispute the period of reduction of 84 days entered for the November 9, 2011 filing of a letter that Patentees submitted pursuant to their duty of good faith and candor regarding an error in patent term adjustment.

Patentees are correct. A review of the record confirms that a period of reduction of 84 days was entered for the filing of a candor letter on November 9, 2011.

§ 1.704(e) provides that:

> Submission of an application for patent term adjustment under § 1.705(b) (with or without request under §1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

Likewise, filing of a letter pursuant to comment 43 is covered by 37 CFR 1.704(e). Therefore, the Patent Term Adjustment was incorrectly reduced. Consequently 84 days will be properly restored to patentees patent term adjustment.

In view thereof, the patent should have issued with a revised patent term adjustment of six hundred forty-five (645) days.

The Certificate of Correction Branch has been advised of this decision. The application is, thereby, forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **SIX HUNDRED FORTY-FIVE (645)** days.

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

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 : 8,105,611 B2

DATED : January 31, 2012

INVENTOR(S) : Pamela D. Van Schaack

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 (561) days

Delete the phrase "by 561 days" and insert – by 645 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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Terry W. Kramer, Esq.
Kramer & Amado, P.C.
1725 Duke Street, Suite 240
Alexandria VA 22314

MAILED
SEP 21 2010
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,590,053 | : |
| Roberts et al. | : DECISION ON REQUEST FOR |
| Issue Date: September 15, 2009 | : RECONSIDERATION OF |
| Application No. 11/156,566 | : PATENT TERM ADJUSTMENT |
| Filed: June 21, 2005 | : AND NOTICE OF INTENT |
| Attorney Docket No. ALC 3181 | : TO ISSUE CERTIFICATE OF |
| Title: MULTIPLE ENDPOINT | : CORRECTION |
| PROTECTION USING SPVCS | : |

This is a decision on the petition filed on May 20, 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 20, 2010 dismissing 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 **nine hundred seventy-seven (977)** 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 nine hundred seventy-seven (977) 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: John Granchelli
Docket-Administrator- Room 3D-201
Alcatel-Lucent USA inc
600-700 Mountain Avenue
Murray Hill, NJ 07974-0636

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,590,053 B2

DATED : September 15, 2009 **DRAFT**

INVENTOR(S) : Roberts 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 646 days

Delete the phrase "by 646 days" and insert – by 977 days--

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STAAS & HALSEY LLP
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1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

**MAILED**

APR 06 2012

**OFFICE OF PETITIONS**

In re Patent No. 7,480,844 :
Issue Date: January 20, 2009 :
Application No. 11/156,633 : DECISION ON PETITION
Filed: June 21, 2005 :
Attorney Docket No. 1076.1103 :

This is a decision on the Request For Certificate of Correction, which is being treated as a Petition Under 37 CFR §3.81(b), filed May 4, 2009, 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 requests 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:

"Fujitsu Limited, Kawasaki (JP)"

to:

--Fujitsu Microelectronics Limited, Tokyo (JP)--

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), was submitted. However, the requisite $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), is required. Therefore, since the PTOL-85B was accompanied deposit account authorization, the fee has been charged. 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. 7,480,844.

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 (01-10)
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: Kadaba 14-19-18-24-9 (SR)-US-NP | Patent Number: 7,660,244 |
| Filing Date (or 371(b) or (f) Date): June 20, 2005 | Issue Date: February 9, 2010 |
| First Named Inventor: Srinivas R. Kadaba | |
| Title: Method and apparatus for quality-of-service based admission control using a virtual scheduler | |

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 /Gregory J. Murgia/ | Date August 9, 2010 |
| Name (Print/Typed) Gregory J. Murgia | Registration Number 41,209 |

***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.*

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Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560

Mail Date: 08/16/2010

| | | |
|---|---|---|
| **Applicant** | : Srinivas R. Kadaba | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7660244 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/156,752 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/20/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1215** 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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DUKE W. YEE
YEE & ASSOCIATES, P.C.
P.O. BOX 802333
DALLAS TX 75380

MAILED

NOV 10 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Chron et al. | : | |
| Application No. 11/156,842 | : | DECISION ON PETITION |
| Filed: June 20, 2005 | : | UNDER 37 CFR 1.78(a)(3) |
| Atty Docket No. YOR920050067US1 | : | |
| | : | |

This is a decision on the PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED DOMESTIC PRIORITY CLAIM UNDER 37 CFR 1.78(a)(3), filed October 26, 2011, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed applications set forth in the amendment filed October 26, 2011.

The petition is **GRANTED**.

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) and must be filed during the pendency of the nonprovisional application. 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 where there is a question whether the delay was unintentional.

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 required by 37 CFR 1.78(a)(2)(iii). It is noted that the reference to add prior-filed nonprovisional application Nos. 10/943,397 and 10/944,597 as continuation-in-part applications includes an incorporation by reference of the prior-filed applications. In this instance, this is acceptable as the prior-filed applications were incorporated by reference on filing of the application (but not properly claimed under §120). Thus, the incorporation by reference does not constitute new matter.

Accompanying the amendment is a request for continued examination (RCE), which is properly submitted for consideration of the amendment after mailing of a final Office action.

The petition includes the required statement of unintentional delay and payment of the surcharge.

All of the above requirements having been satisfied, the late claim for benefit of priority to the prior-filed application under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

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

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3219. All other inquiries concerning

either the examination procedures or status of the application should be directed to the Technology Center.

This application is being referred to Technology Center Art Unit 2168 for processing of the request for continued examination and for consideration by the examiner of the claim for benefit of priority under 35 U.S.C. §§ 120 of the prior-filed applications as set forth in the amendment filed October 26, 2011.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

**ATTACHMENT:** Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 11/156,842 | 06/20/2005 | 2168 | 1200 | YOR920050067US1 | 24 | 3 |

**CONFIRMATION NO. 6904**

**CORRECTED FILING RECEIPT**

*OC000000050868933*

35526
DUKE W. YEE
YEE & ASSOCIATES, P.C.
P.O. BOX 802333
DALLAS, TX 75380

Date Mailed: 11/09/2011

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)**

Edward Gustav Chron, Sunnyvale, CA;
Frederick Douglis, Basking Ridge, NJ;
Stephen Paul Morgan, San Jose, CA;

**Assignment For Published Patent Application**

International Business Machines Corporation, Armonk, NY

**Power of Attorney:** The patent practitioners associated with Customer Number 35526

**Domestic Priority data as claimed by applicant**

This application is a CIP of 10/943,397 09/17/2004 ABN
and is a CIP of 10/944,597 09/17/2004 PAT 7,958,093

**Foreign Applications** (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see http://www.uspto.gov for more information.)

**If Required, Foreign Filing License Granted:** 07/21/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/156,842**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Method for bulk deletion through segmented files

**Preliminary Class**

707

## 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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180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

MAILED
SEP 15 2010
OFFICE OF PETITIONS

In re Application of
Lieven Wulteputte, et al.
Application No. 11/156,852
Filed: June 20, 2005
Attorney Docket No. 228513

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 5, 2010, to revive the above-identified application.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 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 August 29, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment with drawings, (2) the petition fee of $1620, and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 3625 for appropriate action by the Examiner in the normal course of business on the reply received August 5, 2010.

April M. Wise
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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**CANTOR COLBURN, LLP**
**20 CHURCH STREET**
**22ND FLOOR**
**HARTFORD, CT 06103**

MAILED
AUG 05 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Suzuki et al. | : | |
| Application No. 11/156,907 | : | ON PETITION |
| Filed: June 20, 2005 | : | |
| Attorney Docket No. KOT0165US | : | |

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 file a reply in a timely manner to the Restriction Requirement, mailed May 18, 2009, 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 timely obtained. Accordingly, the application became abandoned on June 19, 2009. A Notice of Abandonment was mailed July 7, 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 election of the invention to be examined, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay.

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

This matter is being referred to Technology Center 1796 for further examination on the merits.

Carl Friedman
Petitions Examiner
Office of Petitions

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FEB 14 2011

**OFFICE OF PETITIONS**

COOK, ALEX, McFARRON, MANZO,
CUMMINGS & MEHLER, LTD.
SUITE 2850
200 WEST ADAMS STREET
CHICAGO IL 60606

| | |
|---|---|
| In re Patent No. 7,528,811 | : DECISION ON APPLICATION FOR |
| Issued: May 5, 2009 | : PATENT TERM ADJUSTMENT and |
| Application No. 11/156,920 | : NOTICE OF INTENT TO ISSUE |
| Filed: June 20, 2005 | : CERTIFICATE OF CORRECTION |
| Dkt. No.: 0553-0450 | : |

This is a decision on the petition under 37 CFR 1.705(d) filed July 6, 2009 requesting that the patent term adjustment be increased from 595 days to 914 days.

The request for reconsideration of the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein**.

The patent is entitled to an overall adjustment of 904 days.

The above-identified application issued as U.S. Pat. No. 7,528,811 on May 5, 2009. The patent issued with a patent term adjustment of 595 days. The instant application for patent term adjustment was timely filed July 6, 2009. Patentees assert that the patent is entitled to an overall adjustment of 914 days (961 days under 37 CFR 1.703(a) and (b) minus 47 days of applicant delay under 37 CFR 1.704).

A review of the record reveals that the period of adjustment pursuant to 37 CFR 1.703(a) is 642 days and that the period adjustment pursuant to 37 CFR 1.703(b) is 319 days. However, as set forth at 37 CFR 1.703(f), to the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. The period of adjustment under 37 CFR 1.703(a)(2) and 1.703(b) share 10 overlapping days (from December 14, 2008 to December 23, 2008).

In view thereof, the patent is entitled to an overall adjustment of 904 days (961 days under § 1.703 minus 10 overlapping days in accordance with 37 CFR 1.703(f) minus 47 days of applicant delay under § 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 required fee the $200.00 fee set forth at 37 CFR 1.18(e) has been charged to the authorized deposit account. 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 904 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 Advisor
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,528,811

DATED : May 5, 2009 **DRAFT**

INVENTOR(S) : Iwabuchi

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 595 days

Delete the phrase "by 595 days" and insert -- by 904 days --

UNITED STATES PATENT AND TRADEMARK OFFICE

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LUEDEKA NEELY & GRAHAM, P.C.
P.O. BOX 1871
KNOXVILLE, TN 37901

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DEC 06 2010
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|---|---|---|
| In re Application of | : | |
| Thomas E. Stull et al | : | |
| Application No. 11/157,004 | : | DECISION ON PETITION |
| Filed: June 20, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 63720.US | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 11, 2010.

The request is **APPROVED**.

The request was signed by Robert O. Fox on behalf of the practitioners of record associated with Customer Number 00408.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to assignee Integrated Turf Solutions, LLC at the address indicated below.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Integrated Turf Solutions, LLC
799 Industrial Blvd.
Chatsworth, GA 30705-2021

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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www.uspto.gov

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/157,004 | 06/20/2005 | Thomas E. Stull | 63720.US |

**CONFIRMATION NO. 6181**

**POA ACCEPTANCE LETTER**

Integrated Turf Solutions, LLC
799 Industrial Blvd.
Chatsworth, GA 30705-2021

*OC000000044790104*

Date Mailed: 12/06/2010

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 11/11/2010.

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

/idingle/

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
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/157,004 | 06/20/2005 | Thomas E. Stull | 63720.US |

**CONFIRMATION NO. 6181**

**POWER OF ATTORNEY NOTICE**

408
LUEDEKA, NEELY & GRAHAM, P.C.
P O BOX 1871
KNOXVILLE, TN 37901

*OC000000044790103*

Date Mailed: 12/06/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 11/11/2010.

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

/idingle/

---

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

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**LAW OFFICE OF DAVID H. JUDSON**
**15950 DALLAS PARKWAY**
**SUITE 225**
**DALLAS TX 75248**

MAILED

OCT 25 2010

OFFICE OF PETITIONS

In re Application of
Subhash C. AGRAWAL
Application No. 11/157,238
Filed: June 21, 2005
Docket No. AGARWAL 001

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 20, 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 1, 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 November 2, 2008. A Notice of Abandonment was mailed March 17, 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 reconsideration, (2) the petition fee of $810; and (3) a proper statement of unintentional delay.

Since the payment of the petition fee to obtain the revival of an abandoned application is a statutory prerequisite for revival of an abandoned application, the fee has been charged, as authorized. The request to withdraw the Notice of Non-Compliant Amendment is acknowledged, however, is being referred to the Technology Center for a decision.

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

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center at (571) 272-2800.

This application is being referred to Technology Center AU 2876 for appropriate action by the Examiner in the normal course of business.

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

OK TO ENTER: /C.M./

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION



**PATENT NO.** : 7,905,833
**APPLICATION NO.** : 11/157365
**ISSUE DATE** : March 15, 2011
**INVENTOR(S)** : Brister, et al.

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

| Issued Patent | | Description of Discrepancy |
|---|---|---|
| Column | Line | |
| (Item 56)<br>Page 5<br>Col. 1 | 75 | Under U. S. Patent Documents,<br>change "09/2002" to --11/2002--. |
| (Item 56)<br>Page 8<br>Col. 1 | 64 | Under Other Publications,<br>change "continuos" to --continuous--. |
| (Item 56)<br>Page 8<br>Col. 1 | 71 | Under Other Publications,<br>change "Voltammetryand"<br>to --Voltammetry and--. |
| (Item 56)<br>Page 8<br>Col. 2 | 38 | Under Other Publications,<br>change "1988," to --1988, 23,--. |
| (Item 56)<br>Page 9<br>Col. 1 | 27 | Under Other Publications,<br>change "Continous" to --Continuous--. |
| (Item 56)<br>Page 9<br>Col. 1 | 29 | Under Other Publications,<br>change "og" to --of--. |
| (Item 56)<br>Page 9<br>Col. 1 | 33 | Under Other Publications,<br>change "Sensivity" to --Sensitivity--. |
| (Item 56)<br>Page 9<br>Col. 1 | 43 | Under Other Publications,<br>change "Elecron" to --Electron--. |
| (Item 56)<br>Page 9<br>Col. 1 | 44 | Under Other Publications,<br>change "Electronanalysis"<br>to --Electroanalysis--. |
| (Item 56)<br>Page 9<br>Col. 1 | 52 | Under Other Publications,<br>change "Membran," to --Membrane,--. |

MAILING ADDRESS OF SENDER:

Rose M. Thiessen
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, California 92614

DOCKET NO. DEXCOM.061A1

OK TO ENTER: /C.M./

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

**PATENT NO.** : 7,905,833



**APPLICATION NO.** : 11/157365

**ISSUE DATE** : March 15, 2011

**INVENTOR(S)** : Brister, et al.

| | | |
|---|---|---|
| (Item 56)<br>Page 9<br>Col. 1 | 58 | Under Other Publications,<br>change "on" to --of--. |
| (Item 56)<br>Page 9<br>Col. 2 | 13 | Under Other Publications,<br>change "hypoglycaemic"<br>to --hypoglycemic--. |
| (Item 56)<br>Page 9<br>Col. 2 | 32 | Under Other Publications,<br>change "patents" to --patients--. |
| (Item 56)<br>Page 9<br>Col. 2 | 58 | Under Other Publications,<br>change "impleated" to --implanted--. |
| (Item 56)<br>Page 10<br>Col. 1 | 29 | Under Other Publications,<br>change "basedon" to –based--. |
| (Item 56)<br>Page 10<br>Col. 1 | 33 | Under Other Publications,<br>change "reliablity" to --reliability--. |
| (Item 56)<br>Page 10<br>Col. 1 | 34 | Under Other Publications,<br>change "Biollogy" to --Biology--. |
| (Item 56)<br>Page 10<br>Col. 1 | 38 | Under Other Publications,<br>change "Hypoglycaemia-warning"<br>to --Hypoglycemia-warning--. |
| (Item 56)<br>Page 10<br>Col. 2 | 56 | Under Other Publications,<br>change "Senso" to --Sensor--. |
| (Item 56)<br>Page 11<br>Col. 1 | 24 | Under Other Publications,<br>change "2008, 2008" to --2008--. |
| (Item 56)<br>Page 11<br>Col. 1 | 54 | Under Other Publications,<br>change "artifical" to --artificial--. |
| (Item 56)<br>Page 11<br>Col. 2 | 1 | Under Other Publications,<br>change "Potentially-impintable,"<br>to --Potentially-implantable,--. |

MAILING ADDRESS OF SENDER:

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2040 Main Street, 14th Floor
Irvine, California 92614

DOCKET NO. DEXCOM.061A1

OK TO ENTER: /C.M./

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

**PATENT NO.** : 7,905,833



**APPLICATION NO.** : 11/157365

**ISSUE DATE** : March 15, 2011

**INVENTOR(S)** : Brister, et al.

| | | |
|---|---|---|
| (Item 56)<br>Page 11<br>Col. 2 | 13 | Under Other Publications,<br>change "Enzymlology,"<br>to --Enzymology,--. |
| (Item 56)<br>Page 11<br>Col. 2 | 22 | Under Other Publications,<br>change "artifical" to --artificial--. |
| (Item 56)<br>Page 11<br>Col. 2 | 53 | Under Other Publications,<br>change "Thechnol." to --Technol.--. |
| (Item 56)<br>Page 12<br>Col. 1 | 15 | Under Other Publications,<br>change "your and" to --you and--. |
| (Item 56)<br>Page 12<br>Col. 1 | 24 | Under Other Publications,<br>change "dynamcs" to --dynamics--. |
| (Item 56)<br>Page 12<br>Col. 1 | 27 | Under Other Publications,<br>change "glocuse" to --glucose--. |
| (Item 56)<br>Page 12<br>Col. 1 | 28 | Under Other Publications,<br>change "Diabetese" to --Diabetes--. |
| (Item 56)<br>Page 12<br>Col. 1 | 45 | Under Other Publications,<br>change "Thechnol." to --Technol.--. |
| (Item 56)<br>Page 12<br>Col. 1 | 50 | Under Other Publications,<br>change "Diabetese" to --Diabetes--. |
| (Item 56)<br>Page 12<br>Col. 1 | 65 | Under Other Publications,<br>change "inactiviation" to --inactivation--. |
| (Item 56)<br>Page 12<br>Col. 2 | 39 | Under Other Publications,<br>change "Aniodic" to --Anodic--. |
| (Item 56)<br>Page 12<br>Col. 2 | 49 | Under Other Publications,<br>change "biotelemeter" to --biotelemetry--. |

MAILING ADDRESS OF SENDER:

Rose M. Thiessen
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2040 Main Street, 14th Floor
Irvine, California 92614

DOCKET NO. DEXCOM.061A1

OK TO ENTER: /C.M./

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

**PATENT NO.** : 7,905,833



**APPLICATION NO.** : 11/157365

**ISSUE DATE** : March 15, 2011

**INVENTOR(S)** : Brister, et al.

| | | |
|---|---|---|
| (Item 56)<br>Page 13<br>Col. 1 | 4 | Under Other Publications,<br>change "activitiy," to --activity,--. |
| (Item 56)<br>Page 13<br>Col. 1 | 18 | Under Other Publications,<br>change "Beioelectronics,"<br>to --Bioelectronics,--. |
| (Item 56)<br>Page 13<br>Col. 1 | 19 | Under Other Publications,<br>change "glocuse" to --glucose --. |
| (Item 56)<br>Page 13<br>Col. 1 | 23 | Under Other Publications,<br>change "experiemental"<br>to --experimental--. |
| (Item 56)<br>Page 13<br>Col. 1 | 28 | Under Other Publications,<br>change "valication" to --validation--. |
| (Item 56)<br>Page 13<br>Col. 1 | 29 | Under Other Publications,<br>change "glucose-iunsulin interaaction in tyhpe"<br>to --glucose-insulin interaction in type--. |
| (Item 56)<br>Page 13<br>Col. 1 | 39 | Under Other Publications,<br>change "Biolelectronics"<br>to --Bioelectronics--. |
| (Item 56)<br>Page 13<br>Col. 1 | 42 | Under Other Publications,<br>change "reman" to --raman--. |
| (Item 56)<br>Page 13<br>Col. 1 | 61 | Under Other Publications,<br>change "amperometeric"<br>to --amperometric--. |
| (Item 56)<br>Page 13<br>Col. 1 | 68 | Under Other Publications,<br>change "Thechnol." to --Technol.--. |
| (Item 56)<br>Page 13<br>Col. 2 | 19 | Under Other Publications,<br>change "termistor" to --thermistor--. |
| (Item 56)<br>Page 13<br>Col. 2 | 20 | Under Other Publications,<br>change "metobolites," to --metabolites,--. |

MAILING ADDRESS OF SENDER:

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KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, California 92614

DOCKET NO. DEXCOM.061A1

OK TO ENTER: /C.M./

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

**PATENT NO.** : 7,905,833



**APPLICATION NO.** : 11/157365

**ISSUE DATE** : March 15, 2011

**INVENTOR(S)** : Brister, et al.

| | | |
|---|---|---|
| (Item 56)<br>Page 13<br>Col. 2 | 22 | Under Other Publications,<br>change "cholesteral and cholesteral"<br>to --cholesterol and cholesterol--. |
| (Item 56)<br>Page 13<br>Col. 2 | 24 | Under Other Publications,<br>change "Apllied" to --Applied--. |
| (Item 56)<br>Page 14<br>Col. 1 | 7 | Under Other Publications,<br>change "Subcutaenous" to --Subcutaneous--. |
| (Item 56)<br>Page 14<br>Col. 1 | 13 | Under Other Publications,<br>change "assitance" to --assistance--. |
| (Item 56)<br>Page 14<br>Col. 1 | 14 | Under Other Publications,<br>change "Thechnol." to --Technol.--. |
| (Item 56)<br>Page 14<br>Col. 1 | 47 | Under Other Publications,<br>change "pancrease" to --pancreas--. |
| (Item 56)<br>Page 14<br>Col. 1 | 54 | Under Other Publications,<br>change "Thechnol." to --Technol.--. |
| (Item 56)<br>Page 14<br>Col. 1 | 69 | Under Other Publications,<br>change "Membrance" to --Membrane--. |
| (Item 56)<br>Page 14<br>Col. 2 | 2 | Under Other Publications,<br>change "cholesteral" to --cholesterol--. |
| (Item 56)<br>Page 14<br>Col. 2 | 15 | Under Other Publications,<br>change "Deabetes" to --Diabetes--. |
| (Item 56)<br>Page 14<br>Col. 2 | 32 | Under Other Publications,<br>change "Tranducers" to --Transducers--. |
| (Item 56)<br>Page 15<br>Col. 1 | 69 | Under Other Publications,<br>change "systme" to --system--. |

MAILING ADDRESS OF SENDER:

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Irvine, California 92614

DOCKET NO. DEXCOM.061A1

OK TO ENTER: /C.M./

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

**PATENT NO.** : 7,905,833



**APPLICATION NO.** : 11/157365

**ISSUE DATE** : March 15, 2011

**INVENTOR(S)** : Brister, et al.

| | | |
|---|---|---|
| 2 | 9-10 (Approx.) | Delete "In an embodiment of the first aspect, the identification key comprises calibration information." and insert the same on line 10, col. 2, below "sensor's life." as a new paragraph. |
| 5 | 33 | Change "andrenostenedione;" to --androstenedione;--. |
| 5 | 48 (Approx.) | Change "diptheria/" to --diphtheria/--. |
| 5 | 55 | Change "perioxidase;" to --peroxidase;--. |
| 5 | 61 (Approx.) | Change "phenyloin;" to --phenytoin--. |
| 6 | 1-2 | Change "duodenalisa," to --duodenalis,--. |
| 6 | 9 | Change "Trepenoma pallidium," to --Treponema pallidum,--. |
| 6 | 10 | Change "stomatis" to --stomatitis--. |
| 6 | 31 | Change "(barbituates," to --(barbiturates,--. |
| 6 | 58 | Change "and or" to --and/or--. |
| 15 | 41 | Change "of" to --off--. |
| 16 | 13 | Change "by" to --be--. |
| 16 | 62 | Change "Bellafonte," to --Bellefonte,--. |
| 28 | 3 | Change "a" to --α--. |
| 28 | 14 | Change "with a α" to --with α--. |
| 29 | 21 | Change "York))" to --York.--. |
| 29 | 64 | Change "density- polyethylene," to --density polyethylene, --. |
| 29 | 67 | Change "hydroxyapeptite," to --hydroxyapatite,--. |
| 30 | 2 | Change "nintinol," to --nitinol,--. |
| 33 | 37 | Change "and or" to --and/or--. |
| 36 | 57 | Change "of" to --off--. |
| 39 | 46 | Change "pad" to --pad.--. |
| 40 | 3 | Change "pad 8'is" to --pad 8' is--. |
| 42 | 31 | Change "of" to --off--. |
| 43 | 39 | Change "and or" to --and/or--. |

MAILING ADDRESS OF SENDER:

Rose M. Thiessen
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2040 Main Street, 14th Floor
Irvine, California 92614

DOCKET NO. DEXCOM.061A1

OK TO ENTER: /C.M./

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

**PATENT NO.** : 7,905,833



**APPLICATION NO.** : 11/157365

**ISSUE DATE** : March 15, 2011

**INVENTOR(S)** : Brister, et al.

| | | |
|---|---|---|
| 61 | 52-61 | Delete "In alternative embodiments, the acceptability is determined by a quality evaluation, for example, calibration quality can be evaluated by determining the statistical association of data that forms the calibration set, which determines the confidence associated with the conversion function used in calibration and conversion of raw sensor data into estimated analyte values. See, e.g., co-pending U.S. patent application Ser. No. 10/633,367 filed Aug. 1, 2003 entitled, "SYSTEM AND METHODS FOR PROCESSING ANALYTE SENSOR DATA."" and insert the same on Col. 61, Line 53, below "determined." as a new paragraph. |
| 63 | 27 | Change "can by" to --can be--. |
| 68 | 48 | Change "1-3-," to --1-, 3-,--. |
| 74 | 9 | In Claim 1, change "receiver id" to --receiver is--. |
| 74 | 30 | In Claim 5, change "is" to --are--. |
| 74 | 46 | In Claim 7, change "sensor system." to --sensor.--. |
| 74 | 49-50 | In Claim 8, after "change." delete "display of sensor data after the predetermined time period." |
| 75 | 6 (Approx.) | In Claim 15, change "comprises" to --comprise--. |

11724017:JSJ
080911

MAILING ADDRESS OF SENDER:

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2040 Main Street, 14th Floor
Irvine, California 92614

DOCKET NO. DEXCOM.061A1

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20110822

**DATE** : August 19, 2011

**TO SPE OF** : ART UNIT 3735

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,905,833

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

/CHARLES A MARMOR II/
Supervisory Patent Examiner.Art Unit 3735

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MAILED
MAY 02 2011
OFFICE OF PETITIONS

**CHARLES G. CALL**
**361 WILD COFFEE LN**
**MARCO ISLAND FL 34145-1849**

| | | |
|---|---|---|
| In re Application of | : | |
| BASSOLI, et al | : | |
| Application No. 11/157,464 | : | ON PETITION |
| Filed: June 21, 2005 | : | |
| Attorney Docket No. F-23 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 22, 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 January 22, 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)(II)(A)(2). A three (3) month extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is July 23, 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 $1620; and (3) the required statement of unintentional delay have been received.

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 2463 for processing of the RCE and the amendment submitted in accordance with 37 CFR 1.114 within 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
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Paper No.

MAILED
AUG 16 2010
OFFICE OF PETITIONS

Hahn & Voight-Medtronic, Inc. patent applications
1012 14th Street, NW Suite 620
Washington DC 20005

| | | |
|---|---|---|
| In re Patent No. 7,608,458 | : | DECISION ON REQUEST FOR |
| Soykan et al. | : | RECONSIDERATION OF |
| Issue Date: October 27, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/157,549 | : | and |
| Filed: June 21, 2005 | : | NOTICE OF INTENT TO ISSUE |
| Atty Docket No.: P11348.02-MED-10002US/CIP | : | 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 one thousand, one hundred and fifty-three (1153) 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 fifty-three (1153) days is **GRANTED**.

On December 4, 2009, Patentee submitted a petition under 37 CFR 1.705(d) along with the $200.00 fee set forth in 37 CFR 1.18(e). On March 1, 2010, Patentee filed a Request for Recalculation of Patent Term Adjustment in view of Wyeth. On March 17, 2010, the Office mailed a decision granting the petition under 37 CFR 1.705(d) to the extent that a certificate of correction would be issued indicating that the term of the patent was extended or adjusted by 1135 days. On April 21, 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 1418 days. On May 18, 2010, the Office mailed

a "NOTICE CONCERNING IMPROPER CALCULATION OF PATENT TERM ADJUSTMENT BASED UPON USPTO IMPROPERLY MEASURING REDUCTION PERIOD UNDER 37 CFR 1.704(c)(10)," vacating the April 21, 2010 mailing, and indicating that the patent term adjustment had been determined to be 1464 days.

The Office notes that the decisions of April 21, 2010 and May 18, 2010 were each issued in error as they accorded Patentee 283 and 329 more days of patent term adjustment than were warranted, respectively. The present decision supersedes the decisions mailed on April 21, 2010 and May 18, 2010.

The Office has determined that the patent term adjustment for the above-identified patent is **1135 days**. The 329 additional days of adjustment will be removed.

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 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 and thirty-five (1135) 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 : 7,608,458 B2

DATED : **October 27, 2009** **DRAFT**

INVENTOR(S) : **Soykan 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 852 days

Delete the phrase "by 852 days" and insert – by 1153 days --

tUNITED 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.

Hahn & Voight-Medtronic, Inc. patent applications
1012 14th Street, NW Suite 620
Washington DC 20005

MAILED
NOV 08 2010
OFFICE OF PETITIONS

In re Patent No. 7,608,458 :
Soykan et al. :
Issue Date: October 27, 2009 : LETTER
Application No. 11/157,549 :
Filed: June 21, 2005 :
Atty Docket No.: P11348.02-MED- :
10002US/CIP :

This letter is in response to the "Response to Decision on Request for Reconsideration of Patent Term Adjustment," filed on August 25, 2010.

A petition pursuant to 37 C.F.R. § 1.705(d) was filed on May 20, 2010, and was granted via the mailing of a decision on August 16, 2010, which indicated that the patent term adjustment indicated on the above-identified patent is extended or adjusted by one thousand, one hundred and fifty-three (1153) days. A certificate of correction was included therewith, which indicated the same.

With this submission of August 25, 2010, Patentee has indicated that the certificate of correction that was included with the decision of August 16, 2010 contains the correct patent term adjustment, however there are two typographical errors on the second page of this decision, which each lists the patent term adjustment as 1135 days, instead of 1153 days. Patentee has requested that the Certificate of Correction branch be notified of the typographical error that is contained on the second page of this petition.

This letter will serve as notice that the text "one thousand, one hundred and thirty-five" and the number "1135" which appears

on the second page of the decision on August 16, 2010 is a typographical error. The correct number of days of patent term adjustment is one thousand, one hundred and fifty-three (1153) 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 **one thousand, one hundred and fifty-three (1153) 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

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

WALL & TONG, LLP/
ALCATEL-LUCENT USA INC.
25 JAMES WAY
EATONTOWN NJ 07724

MAILED
DEC 05 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| David R. Francisco et al | : | |
| Application No. 11/157,570 | : | DECISION GRANTING PETITION |
| Filed: June 21, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. FRANCISCO 1-8-2-3 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 1 , 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 November 21, 2011 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 2464 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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P.O. Box 1450
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**ROBERT A. PARSONS**
**4000 N. CENTRAL AVENUE, SUITE 1220**
**PHOENIX AZ 85012**

**MAILED**

AUG 01 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Michael D. Metcalf et al | : | |
| Application No. 11/157,574 | : | DECISION ON PETITION |
| Filed: June 21, 2005 | : | |
| Attorney Docket No. 5002-A1 | : | |

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 petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an RCE and an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action mailed November 4, 2009, 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 2614 for appropriate action by the Examiner in the normal course of business.

/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

**LAM RESEARCH CORPORATION**
**4650 CUSHING PARKWAY CA-1**
**FREMONT CA 94538**

**MAILED**
SEP 15 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,113,842 | : | |
| Issued: September 26, 2006 | : | |
| Application No. 11/157,644 | : | ON PETITION |
| Filed: June 21, 2005 | : | |
| Attorney Docket No. 54593/315473 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed August 23, 2011.

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

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

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

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 not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent regarding 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.

Telephone inquiries 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

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

**MAILED**

AUG 09 2010

**OFFICE OF PETITIONS**

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

| | | |
|---|---|---|
| In re Application of | : | |
| Lennell, et al. | : | |
| Application No. 11/157,718 | : | ON APPLICATION FOR |
| Filed: June 21, 2005 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. **13488US04** | : | |

This is in response to the "APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 USC 154(b) ACCOMPANYING THE NOTICE OF ALLOWANCE (37 C.F.R. 1.705)", filed July 15, 2010, which is properly treated under 37 CFR 1.705(b). Applicant submits that the patent term adjustment to be indicated on the patent is one thousand, one hundred and five (1,105) days, not four hundred and sixty-one (461) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

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

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term 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].

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including –

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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.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on March 30, 2010.

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) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

**MAILED**

APR 07 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No.7,826,446 | : | |
| Lenell, et al. | : | DECISION FOR REQUEST |
| Issue Date : November 2, 2010 | : | FOR RECONSIDERATION |
| Application No. 11/157,718 | : | OF PATENT TERM |
| Filed: June 21, 2005 | : | ADJUSTMENT |
| Attorney Docket No. **13488US04** | : | |

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 December 23, 2010. Patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from one thousand, one hundred and four (1,104) days to one thousand, one hundred and five (1,105) 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 November 2, 2010, the above-identified application matured into U.S. Patent No. 7,826,446 with a revised patent term of 1,104 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 June 22, 2008, and ends on March 29, 2010, the day before the RCE was filed, and is 646 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

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

**ROSENBERG, KLEIN & LEE**
**3458 ELLICOTT CENTER DRIVE-SUITE 101**
**ELLICOTT CITY MD 21043**

MAILED

FEB 10 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| PAIK | : | |
| Application No. 11/157,878 | : | DECISION ON PETITION |
| Filed: June 22, 2005 | : | |
| Attorney Docket No. MR2685-181 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 5, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowability, mailed April 20, 2009, which set a period for reply of three (3) months. Accordingly, this application became abandoned on July 21, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the Issue Fee of $755 and Publication Fee of $300; (2) the petition fee of $810; and (3) the required statement of unintentional delay.

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

All other inquiries should be directed to the Office of Data Management at (571) 272-4000.

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

/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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**E I DU PONT DE NEMOURS AND COMPANY**
**LEGAL PATENT RECORDS CENTER**
**BARLEY MILL PLAZA 25/1122B**
**4417 LANCASTER PIKE**
**WILMINGTON DE 19805**

MAILED

OCT 26 2010

OFFICE OF PETITIONS

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| In re Application of | : | |
| Chou et al. | : | |
| Application No. 11/157,895 | : | DECISION ON PETITION |
| Filed: June 21, 2005 | : | |
| Attorney Docket No. AD7137USNA | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 29, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to take appropriate action in a timely manner after the decision of April 28, 2010 by the Board of Patent Appeals and Interferences. Therefore, 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 June 29, 2010. *See* MPEP 1214.06. A Notice of Abandonment was mailed July 28, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form an Amendment; (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.

The file is now being forwarded to Technology Center 1796 for processing of the Amendment filed with the instant petition.

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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**TIMOTHY R. KROBOTH**
**KROBOTH LAW OFFICE**
**5501 PROVIDENCE COUNTRY CLUB DRIVE**
**CHARLOTTE NC 28277**

MAILED
MAR 29 2012
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,333,194 | : | |
| Issued: February 19, 2008 | : | |
| Application No. 11/157,944 | : | DECISION ON PETITION |
| Filed: June 22, 2005 | : | |
| Attorney Docket No. 50-19 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed March 8, 2012, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on February 20, 2012 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.

Telephone inquiries 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

Commissioner for Patents
United States Patent and Trademark Office
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NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

**MAILED**

OCT 31 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hiroko Yamamoto et al | : | |
| Application No. 11/158,004 | : | DECISION GRANTING PETITION |
| Filed: June 22, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 740756-2860 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, October 28, 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 September 23, 2011 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 2823 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 07/20/11

**TO SPE OF** : ART UNIT 3739

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 11158340 Patent No.: 7655003

**CofC mailroom date:** 07/13/11

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**
**You can fax the Director SPE response to 571-273-3421**

**Note:** _____

*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.

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

**Comments: Changes directed to formalities only. /Linda C.M. Dvorak/ 3739**

**SPE** **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No.

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NOV 08 2010

OFFICE OF PETITIONS

BOND, SCHOENECK & KING, PLLC
10 BROWN ROAD, SUITE 201
ITHACA NY 14850-1248

| | | |
|---|---|---|
| In re Patent No. 7,699,837 | : | |
| Cox et al. | : | |
| Issue Date: 04/20/2010 | : | DECISION ON APPLICATION |
| Application No. 11/158,365 | : | FOR |
| Filed: 06/22/2005 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. | : | |
| 616P005A | : | |

This is in response to the "PETITION For Reconsideration of Patent Term Adjustment," filed August 13, 2010, which is treated as a request for reconsideration of the initial determination of patent term adjustment under 35 U.S.C. 154(b) of 487 days.

The application for patent term adjustment under § 1.705(b) is **DISMISSED AS UNTIMELY FILED**.

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.

35 U.S.C. 154(b) provides for patent term adjustment for examination delay. Pursuant to 35 U.S.C. 154(b)(3)(B) and implementing regulation 37 C.F.R. § 1.705, an applicant shall receive an initial determination of patent term adjustment with the mailing of the Notice of Allowance and shall be given one

opportunity to request reconsideration of that determination by way of filing of an application for patent term adjustment prior to the payment of the issue fee.

Patentees assert, in essence, that the periods of reduction of 185 days and 49 days for applicant delay are incorrect and should be removed.

On December 4, 2009, the Office mailed a 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 487 days. This determination was based, in part, on periods of reduction of: (i) 185 days for applicant delay associated with then applicants' reply filed on February 27, 2009, (ii) 49 days for applicant delay associated with the filing of an IDS on April 17, 2009. PALM records indicate that the issue fee payment was received in the Office on March 2, 2010. No filing of an application for patent term adjustment preceded the payment of the issue fee. 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 March 2, 2010. Accordingly, it is appropriate to dismiss this petition as untimely filed under 1.705(b).

Consideration under 1.705(d) is not appropriate. As stated in MPEP 2730, 1.703(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.

The issues raised should have been timely raised on application for patent term adjustment under § 1.705(b).

Submission of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required. The overpayment of $200.00 will be credited to counsel's deposit account.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Anthony Knight
Director
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) |
|---|---|---|---|---|
| 7,154,142 | 2006-12-26 | 11/158,412 | 2005-06-21 | LKSP0145USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-03 |
| Name | Winston Hsu | Registration Number | 41526 |

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. 7154142
Issue Date: December 26,2006
Application No. 11158412
Filed: June 21,2005
Attorney Docket No. JCLA14528

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

This is a decision on the electronic petition, filed April 3,2012 ,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 April 3,2012 .
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.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 03/15/12

**TO SPE OF** : ART UNIT 3716

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 11158478 Patent No.: 8057296

CofC mailroom date: 03/05/12

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:** _____

D. Cabral — 3716

**SPE** — **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. |
|---|---|---|---|---|
| 11/158,479 | 06/21/2005 | Toshiyoshi Fujiwara | 09857/0203064-US0 | 9608 |

7590 04/20/2011
FISH & RICHARDSON P.C. (NY)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

| EXAMINER |
|---|
| LI, BAO Q |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1648 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 04/20/2011 | ELECTRONIC |

# 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

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

April 18, 2011

FISH & RICHARDSON P.C. (NY)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

Re Application of
**FUJIWARA, TOSHIYOSHI** Et al
Application No: **11/158479**
Filed: **06/21/2005**
Attorney Docket No: **09857/0203064-US0**

: **DECISION ON PETITION**
: **ACCEPTANCE OF COLOR**
: **DRAWINGS**
:

This is a decision on the Renewal of 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 21, 2005.

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 containing the following language as the first paragraph in that portion of the specification relating to the brief description of the drawings.

   *"The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."*

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.

/Bernadette Queen/
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
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**DALY, CROWLEY, MOFFORD & DURKEE, LLP**
**SUITE 301A**
**354A TURNPIKE STREET**
**CANTON MA 02021-2714**

MAILED
FEB 28 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,217,927 | : | |
| Issue Date: March 6, 2007 | : | |
| Application No. 11/158,905 | : | NOTICE |
| Filed: June 22, 2005 | : | |
| Attorney Docket No. MIT-159AUS | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed January 10, 2011. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

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

Your fee deficiency submission under 37 CFR 1.28 is hereby accepted. The petition is **GRANTED**.

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

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

This file is being forwarded to Files Repository.

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

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

cc: Daniel O'Brien
Massachusetts Institute of Technology
Technology Licensing Office
Five Cambridge Center, Kendall Square
Cambridge, MA 02142-1493

UNITED STATES PATENT AND TRADEMARK OFFICE

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MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

**MAILED**
MAY 05 2011
**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of: | : |
| Bevilacqua et al. | : ON APPLICTION FOR |
| Application No. 11/159376 | : PATENT TERM ADJUSTMENT |
| Filing or 371(c) Date: 06/22/2005 | : |
| Atty. Docket No.: 33743-504 CON2 | : |

This letter is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed April 6, 2011, requesting reconsideration of the patent term adjustment to credit applicants for two hundred (200) days of adjustment of the patent term.

The petition to correct the patent term adjustment indicated on the above-identified patent to credit applicants for two hundred (200) days of adjustment of the patent term is **DISMISSED**.

On January 6, 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 zero (0) days.

On April 6, 2011, applicants timely submitted the instant application for patent term adjustment[1]. Applicants request that the Determination of Patent Term Adjustment be corrected from zero (0) days, as indicated on the Determination of PTA mailed January 6, 2011, to credit applicants for two hundred (200) days in connection with the filing of an Information Disclosure Statement ("IDS"). Applicants aver that the Office errantly calculated a reduction of 200 days in connection with the filing of a Supplemental IDS, filed December 10, 2010. Applicants file the present petition and aver that the petition "reiterate[s] that each item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart application and the communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of this IDS."

[1] PALM records show that the Issue Fee payment was received in this Office on April 6, 2011.

37 CFR 1.704(c)(8) states:

> 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: 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 CFR 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.

A review of the record reveals that applicants filed a response to an Office action on May 24, 2010. Thereafter applicants' filed a Supplemental IDS on December 10, 2010. A further review of the application file reveals that the Supplemental IDS, filed December 10, 2010, was not accompanied by the statement set forth at 37 CFR 1.704(d).

Applicants' argument that the 200-day period of reduction for applicant delay should be removed is unavailing. It is undisputed that the IDS was not accompanied by the statement set forth under § 1.704(d)[2]. Further, there is no provision in the rules for the Office to accept a statement under § 1.704(d) which did not accompany (*i.e.*, was not filed contemporaneously with) the IDS. Accordingly, the reduction of 200 days for applicant delay is proper and will not be removed.

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,

---

[2] A review of the Supplemental IDS filed December 10, 2010 reveals that the IDS was accompanied by a statement that each item of information contained in this Supplemental Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application [] not more than three months prior to the filing of this Supplemental Information Disclosure Statement [].

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 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) 272-3232.

/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
www.uspto.gov

King and Spalding LLP
1700 Pennsylvania Ave, NW
Suite 200
Washington, DC 20006

Mail Date: 08/03/2010

| | | |
|---|---|---|
| **Applicant** | : Yigal Mordechai Edery | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7647633 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/159,455 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/22/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1043** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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**MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO**
**ONE FINANCIAL CENTER**
**BOSTON, MA 02111**

**MAILED**

OCT 12 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| **Robert F. BAUGH**, et *al.* | : | |
| Application No. 11/159,482 | : | NOTICE PURSUANT TO |
| Filed: June 23, 2005 | : | 37 CFR § 1.28(c) |
| Attorney Docket No. **37272-505C07US** | : | |

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) 272-7353.

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

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**CHRISTIE, PARKER & HALE, LLP**
**PO BOX 7068**
**PASADENA CA 91109-7068**

MAILED
APR 29 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hyun-Gon Noh, et al. | : | |
| Application No. 11/159,518 | : | DECISION GRANTING PETITION |
| Filed: June 21, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 54648/P849 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, April 27, 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 March 25, 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 Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 1726 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed .

/Terri Johnson/
Terri Johnson
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.*

PTO/SB/131 (01-10)
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: TI-33166.1 | Patent Number: 7,664,808 |
| Filing Date (or 371(b) or (f) Date): 06-23-2005 | Issue Date: 02/16/2010 |
| First Named Inventor: Zhongnong Jiang | |
| Title: EFFICIENT REAL-TIME COMPUTATION OF FIR FILTER COEFFICIENTS | |

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 / Wade J. Brady III / | Date August 2, 2010 |
| Name (Print/Typed) Wade J. Brady III | Registration Number 32,080 |

***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.*

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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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

Mail Date: 08/11/2010

| | | |
|---|---|---|
| **Applicant** | : Zhongnong Jiang | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7664808 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/159,618 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/23/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1273** 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 : 02/17/11

TO SPE OF : ART UNIT 3633

SUBJECT : Request for Certificate of Correction for Appl. No.: 11159689 Patent No.: 7849659

CofC mailroom date: 02/08/11

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**

_____
**Certificates of Correction Branch**

*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

2/23/11

SPE ART UNIT 3633

SPE BRIAN GLEISNER Art Unit 3633

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

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

| | | |
|---|---|---|
| In re Patent of Ikeda et al. | : | DECISION ON REQUEST |
| Patent No. 7,573,429 | : | FOR RECONSIDERATION OF |
| Issue Date: August 11, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/159,825 | : | AND NOTICE OF INTENT TO |
| Filing Date: June 23, 2005 | : | ISSUE CERTIFICATE OF |
| Attorney Docket No. 9281-5125 | : | CORRECTION |

This is a decision on the "Second Request for Reconsideration of Patent Term Adjustment" filed May 20, 2010, which is being treated as a renewed petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by two hundred fifty-three (253) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by two hundred fifty-three (253) days is **GRANTED to the extent indicated herein**.

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.

Delay under 37 C.F.R. § 1.703(a) ("A Delay")

The period of A Delay is 132 days and is not in dispute.

Delay under 37 C.F.R. § 1.703(b) ("B Delay")

Patentees contend the period of B Delay is 252 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 period of B Delay, the over three year period began on June 24, 2008, and ended on March 1, 2009, *the day before* the RCE was filed, and is 251 (not 252) days. *See* 35 U.S.C. § 154(b)(1)(B)(i).

Overlap Between A Delay and B Delay

The number of days of overlap between A Delay and B Delay is 0 days and is not in dispute.

Delay under 37 C.F.R. § 1.704 ("Applicant Delay")

The patent term adjustment set forth on the patent included a total reduction of 130 days for Applicant Delay. The prior petition under 37 C.F.R. § 1.705(d) filed October 9, 2009, appeared to assert Applicant Delay is 133 days instead of 130 days. As a result, the decision on petition reviewed the issue and concluded Applicant Delay is 133 days. The decision stated,

> 37 C.F.R. § 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. The Office mailed a Notice to File Missing Parts of Nonprovisional Application on July 25, 2005. Patentees filed a reply on October 28, 2005, three months and three days after the Office mailed the Notice. Therefore, the patent term adjustment set forth on the patent should have included a three-day reduction for delay in responding to the July 25, 2005 Notice the October 28, 2005 reply pursuant to 37 C.F.R. § 1.704(b).

The instant petition asserts the period of Applicant Delay is 131 days. However, the instant petition fails to provide any discussion of the basis for such an assertion.

The Office has reviewed the record and has determined the total number of days of Applicant Delay is 133 days, not 131 days.

Conclusion

In view of the prior discussion, the patent term adjustment is 250 days, which is the sum of 132 days of A Delay and 251 days of B Delay reduced by 0 days of overlap and reduced by 133 days of Applicant Delay.

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 **two hundred fifty (250)** 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. | : | 7,573,429 B2 |
| ISSUE DATE | : | August 11, 2009 |
| INVENTOR(S) | : | Ikeda 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 cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 122 days.

Delete the phrase "by 122 days" and insert - by 250 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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Paper No.

HOGAN LOVELLS US LLP
ONE TABOR CENTER, SUITE 1500
1200 SEVENTEENTH ST
DENVER CO 80202

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

| | | |
|---|---|---|
| In re Application of | : | |
| Daugherty et al. | : | |
| Application No. 11/159,828 | : | DECISION ON PETITION |
| Filed: June 23, 2005 | : | PURSUANT TO |
| Attorney Docket No.: PHEN234 | : | 37 C.F.R. § 1.137(B) |
| CIP3 | : | |
| Title: CINNAMON EXTRACT | : | |
| ENRICHED FOR POLYPHENOLS AND | : | |
| METHODS OF PREPARING SAME | : | |

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(b), filed May 13, 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 reply in a timely manner to the non-final Office action, mailed November 4, 2009, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on February 5, 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 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, Petitioner has submitted an amendment, the petition fee, and the proper statement of unintentional delay.

As such, the first three requirements 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.[1]

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's support staff will notify the Examiner of this decision, so that the amendment that was received on May 13, 2010 can be processed in due course.

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 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 this application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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1 See Rule 1.137(d).
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 Petitioner's further action(s).

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Alexandria, VA 22313-1450
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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

MAILED
JUN 29 2011
OFFICE OF PETITIONS

In re Patent No. 7,405,706 :
Issue Date: July 29, 2008 :
Application No. 11/159,848 : ON PETITION
Filed: June 23, 2005 :
Attorney Docket No. **9281-5122** :

This is a decision on the petition filed April 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**.

Petitioner states that the correct assignee's name is "Alps Electric Co., Ltd., Tokyo (JP); Honda Motor Co., Ltd., Tokyo (JP); and Nippon Sheet Glass Co., Ltd., Tokyo (JP)" 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.

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.

As authorized, the $130 fee for the petition under 37 CFR 3.81(b) has been assessed to petitioner's deposit account.

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.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20110429

**DATE** : April 29, 2011

**TO SPE OF** : ART UNIT 1621

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7687665

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

/DANIEL SULLIVAN/
Supervisory Patent Examiner.Art Unit 1621

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WILKINSON & GRIST
6TH FLOOR, PRINCE"S BUILDING
CHATER ROAD, CENTRAL
HONG KONG HK HONG KONG

MAILED
MAR 04 2011
OFFICE OF PETITIONS

In re Patent No. 7,754,444
Issue Date: July 13, 2010
Application No. 11/159,882
Filed: June 23, 2005
Attorney Docket No. H1584-28

DECISION ON PETITION

This is a decision on the Request For Certificate Of Correction, filed November 2, 2010, which is being treated as a Petition Under 37 CFR §3.81(b) to correct assignee's name --The University of Hong Kong, Hong Kong (CN)-- 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 correct assignee's name – The University Of Hong Kong, Hong Kong (CN)-- on the previously submitted PTOL-85B.

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

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

A petition under 37 CFR §3.81(b) requires a petition processing fee of $130.00 (Fee Code 1464), as set forth under 37 CFR 1.17(i). This petition lacks the processing fee. For this reason, the petition is dismissed.

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

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LAW OFFICE OF JIM BOICE
3839 BEE CAVE ROAD, SUITE 201
WEST LAKE HILLS TX 78746

MAILED

AUG 3 0 2010

OFFICE OF PETITIONS

In re Application of
Timothy Peter Ellison
Application No. 11/159,960
Filed: June 23, 2005
Attorney Docket No. **GB920040034US1**

ON PETITION

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

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed November 27, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 28, 2010.

The petition is **DISMISSED**.

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

**As to item (1)**

The proposed reply required for consideration of a petition to revive must be either 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). Therefore, since petitioner has not filed the proper reply to the Office action as required, the petition can not 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 JoAnne Burke 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
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3839 BEE CAVE ROAD, SUITE 201
WEST LAKE HILLS TX 78746

MAILED
MAY 03 2011
OFFICE OF PETITIONS

In re Application of :
Timothy Peter Ellison :
Application No. 11/159,960 : ON PETITION
Filed: June 23, 2005 :
Attorney Docket No. :
**GB920040034US1**

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed September 10, 2010, to revive the above-identified application.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed November 27, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 28, 2010.

The petition is **DISMISSED**.

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

**As to item (1)**

Petitioner still has not met the requirements to satisfy item (1). The proposed reply required for consideration of a petition to revive must be either a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). *See* MPEP 711.03(c)(III)(A)(2). Since the amendment submitted on September 10, 2010, does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b). A copy of the Advisory Action explaining why the amendment was not accepted is enclosed with this decision.

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 JoAnne Burke at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

Attachment: Copy of the Advisory Action

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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MAILED
MAY 18 2011
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3839 BEE CAVE ROAD, SUITE 201
WEST LAKE HILLS TX 78746

| | | |
|---|---|---|
| In re Application of | : | |
| Timothy Peter Ellison | : | |
| Application No. 11/159,960 | : | ON PETITION |
| Filed: June 23, 2005 | : | |
| Attorney Docket No. | : | |
| **GB920040034US1** | | |

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed May 9, 2011, to revive the above-identified application.

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 November 27, 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 February 28, 2010.

The petition is hereby **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 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) 272-4584.

This application is being referred to Technology Center AU 2192 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.

JoAnne Burke
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 7,061,805 | 2006-06-13 | 11/160,035 | 2005-06-06 | LKSP0127USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-05 |
| Name | Winston Hsu | Registration Number | 41526 |

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
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P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 7061805
Issue Date: June 13,2006
Application No. 11160035
Filed: June 6,2005
Attorney Docket No. 13991-US-PA

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

This is a decision on the electronic petition, filed April 5,2012 ,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 April 5,2012 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

JAN 20 2011

OFFICE OF PETITIONS

APEX JURIS, PLLC
12733 LAKE CITY WAY NORTHEAST
SEATTLE, WA 98125

In re Application of
Marty Williams
Application No. 11/160,087
Filed: June 8, 2005
Attorney Docket No.: 10.18.12.USP

ON PETITION

This is a decision in response to the petition, filed November 12, 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 failure to reply in a timely manner to the non-final Office action mailed March 11, 2009, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on June 12, 2009. A Notice of Abandonment was mailed on October 2, 2009. On November 12, 2010, 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 amendment; (2) the petition fee of $810; and (3) an adequate statement of unintentional delay[1].

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 November 12, 2010 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's credit card.

The application is being referred to Technology Center AU 3782 for appropriate action by the Examiner in the normal course of business on the amendment received November 12, 2010.

[1] 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. While 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, 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 undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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SEP 07 2011
OFFICE OF PETITIONS

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

| | | |
|---|---|---|
| In re Patent No. 7,967,844 | : | DECISION ON REQUEST FOR |
| Issued: June 28, 2011 | : | RECONSIDERATION OF PATENT |
| Application No. 11/160,141 | : | TERM ADJUSTMENT AND |
| Filed: June 10, 2005 | : | NOTICE OF INTENT TO ISSUE |
| Atty Docket No. 101896-0350 | : | CERTIFICATE OF CORRECTION |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) AFTER PATENT ISSUANCE," filed August 27, 2011. Patentees requests that the patent term adjustment for the above-identified patent be set at 1,219 days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED TO THE EXTENT INDICATED HEREIN**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **1,131 days**.

On June 28, 2011, Application No. 11/160,141 matured into Patent No. 7,967,844. The instant request for reconsideration filed August 27, 2011, was timely filed within two (2) months of the date the patent issued. See 37 CFR 1.705(d). Patentees dispute the reduction of 41 days associated with the filing of a "miscellaneous incoming letter" received in the Office on May 19, 2011. Patentees assert that the paper filed on May 19, 2011, was a Letter of Candor and Good Faith, and therefore, no reduction is warranted under 37 CFR 1.704(c)(10).

A review of the PALM calculations for this application reveals that the patent term adjustment was reduced by 41 days for the submission of the "miscellaneous incoming letter." See 37 CFR

1.704(c)(10). However, a review of the application record confirms that no paper aside from a filing akin to a Letter of Candor and Good Faith was filed after the mailing of the notice of allowance. A Letter of Candor and Good faith is not a paper for which its filing is considered a "failure to engage in reasonable efforts" within the meaning of 37 CFR 1.704(c)(10). Thus, it is concluded that the reduction of 41 days is not warranted.

In view thereof, the patent term adjustment indicated in the patent should be **1,131 days**.

Deposit account 10-0750 will be charged $200. 00 for the fee set forth in 37 CFR 1.18(e). No additional fees are 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.

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 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 and thirty-one (1,131) days.

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

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,967,844 B2

DATED : Jun. 28, 2011

INVENTOR(S) : Labrom 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 (1090) days

Delete the phrase "by 1090 days" and insert – by 1131 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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PHILIP S JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

**MAILED**
AUG 09 2011
**OFFICE OF PETITIONS**

| | |
|---|---|
| In re | : DECISION ON APPLICATION |
| Labrom, et al. | : FOR PATENT TERM ADJUSTMENT |
| Application No. 11/160,142 | : AND NOTICE OF INTENT |
| Filed: June 10, 2005 | : TO ISSUE |
| Patent No. 7,951,169 | : CERTIFICATE OF CORRECTION |
| Issued: May 31, 2011 | : |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(d) AFTER PATENT ISSUANCE", filed July 27, 2011. Patentees request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from four hundred eighteen (418) days to four hundred thirteen (413) days.

The application for patent term adjustment is **GRANTED**.

On January 26, 2011, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the instant application. The Notice stated that the patent term adjustment (PTA) to date was three hundred twenty-two (322) days. On April 22, 2011, Applicants filed a "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT", which was a candor letter indicating that the 322 days of patent term accorded was thought to be longer than appropriate by 45 days. On May 31, 2011, the application issued into Patent No. 7,951,169 with a patent term adjustment of four hundred eighteen (418) days.

A review of the file reveals that Applicants were assessed delay of forty (40) days for filing the "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT" on April 22, 2011. Pursuant to 37 C.F.R. § 1.704(e), the submission of an application for patent term adjustment will not be considered a failure to engage in

reasonable efforts to conclude prosecution of the application. Likewise, the submission of a candor letter will not be considered a failure to engage in reasonable efforts to conclude prosecution of the application. Accordingly, zero (0) days should have been assessed for this filing.

In addition, a review of the file reveals that Applicants also should have been assessed an additional twenty-eight (28) days of delay pursuant to 37 CFR 1.704(c)(8). Applicants filed an IDS on April 24, 2008, subsequent to a response filed on March 27, 2008. Accordingly, twenty-eight (28) days of Applicant delay should have been assessed with respect to the submission of this supplemental paper under 37 CFR 1.704(c)(8).

Lastly, a review of the file reveals that Applicants also should have been assessed an additional seventeen (17) days of delay for another instance pursuant to 37 CFR 1.704(c)(8). Applicants filed an IDS on December 17, 2009, subsequent to an RCE filed on November 30, 2009. Accordingly, seventeen (17) days of Applicant delay should have been assessed with respect to the submission of this supplemental paper under 37 CFR 1.704(c)(8)

In view thereof, the correct determination of patent term adjustment is four hundred thirteen (413) days (459 (427+17+15) days of "A" delay and 153 days of "B" delay, reduced by 182 (2+24+90+21+28+17) days of applicant delay and 17 days of overlap between "A" and "B" delay).

The $200 fee has been charged to Deposit Account No. 10-0750. Petitioner's request for waiver of this fee is dismissed, as the fee is required for the Office's consideration of the application for patent term adjustment.

The application is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction, indicating a Patent Term Adjustment of **four hundred thirteen (413) days**.

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

Cliff Congo
Petitions Attorney
Office of Petitions

Enclosure: draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,951,169 B2

DATED : **May 31, 2011**

INVENTOR(S) : Labrom 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 418 days.

Delete the phrase "by 418 days" and insert – by 413 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. 7074674
Issue Date: July 11,2006
Application No. 11160176
Filed: June 13,2005
Attorney Docket No. 14527-US-PA

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

This is a decision on the electronic petition, filed April 6,2012 ,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 April 6,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

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) |
|---|---|---|---|---|
| 7,074,674 | 2006-07-11 | 11/160,176 | 2005-06-13 | LKSP0129USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-06 |
| Name | Winston Hsu | Registration Number | 41526 |

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

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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Haim Zvi Melman
3 Hagai St.
Kfar Saba 44335
ISRAEL

MAILED
DEC 03 2010
OFFICE OF PETITIONS

In re Application of :
Melman :
Application No. 11/160,318 : DECISION ON PETITION
Filed: June 18, 2005 :
Title: APPARATUS AND METHOD FOR :
RETRIEVAL OF DOCUMENTS :

This is a decision on the petition filed October 7, 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 to withdraw the holding of abandonment is **Dismissed**.

Any request for reconsideration should be filed within **TWO MONTHS** of the mailing date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136.

This above-identified application became abandoned for failure to timely file a reply to a non-final Office action mailed August 5, 2009. The Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on November 6, 2009. A Notice of Abandonment was mailed on May 11, 2010.

Petitioner contends that a proper reply was filed. Petitioner further states that he was informed by the examiner that the response submitted was "ok".

Petitioner's argument has been considered but deemed unpersuasive. A review of the record shows that in response to the non-final rejection of August 5, 2009, correspondence was filed on September 28, 2009, October 5, 2009 and October 19, 2009. It should be noted that an extension of time pursuant to 37 CFR 1.136(a) was not obtained. Thus, a timely complete reply was required no later than November 5, 2009. Further, the examiner has reviewed the correspondence submitted and determined that a proper response has not been provided. The examiner determined the responses provided failed to meet the requirements of 37 CFR 1.85 and 1.111.

37 CFR 1.111 states in pertinent part:

> In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

Further, pursuant to 37 CFR 1.2 all business with the Patent and Trademark Office should be transacted in writing. 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. Thus, an allegation that petitioner was informed via telephone that a response filed was "OK", cannot be relied upon in an effort to have the abandonment withdrawn.

As such the holding of abandonment cannot be withdrawn.

If petitioners cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioners 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 $810(small entity)/ $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 petition must also be accompanied by a complete reply to the Office action.

While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the

value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site http://www.uspto.gov in the Site Index under "Attorney and Agent Roster". Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

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

| | |
|---|---|
| By mail: | Mail Stop Petition<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By facsimile: | (571) 273-8300 |
| By delivery service:<br>(FedEx, UPS, DHL, etc.) | U.S. Patent and Trademark Office<br>Customer Service Window,<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |

The Office of Petitions does not communicate via electronic mail (e-mail).

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

Charlema Grant
Petitions Attorney
Office of Petitions

Enclosure: Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b); Form PTO/SB/64, Privacy Act Statement.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Haim Zvi Melman
3 Hagai St.
Kfar Saba 44335 IL
ISRAEL

MAILED
FEB 25 2011
OFFICE OF PETITIONS

In re Application of :
Melman :
Application No. 11/160,318 : DECISION ON PETITION
Filed: June 18, 2005 :
Title: APPARATUS AND METHOD FOR :
RETRIEVAL OF DOCUMENTS

This is a decision on the petition, filed December 13, 2010 which is being treated as a petition under 37 CFR 1.181, requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED AS MOOT**.

In light of the correspondence mailed January 4, 2011 prosecution is reopened and the holding of abandonment is withdrawn.

This application is being referred to art unit 2163 for appropriate action in the normal course of business.

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

Charlema Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

K&L GATES LLP
PO BOX 1135
CHICAGO IL 60690

**MAILED**

OCT 07 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application | : | |
| Walker, et al. | : | |
| Application No. 11/160,363 | : | DECISION ON APPLICATION |
| Filed: June 21, 2005 | : | FOR PATENT TERM ADJUSTMENT |
| Docket No. 3718582-00143 | : | |

This is a decision on the petition under 37 CFR 1.705(b), filed July 14, 2010. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one thousand, one hundred sixty-two (1162) days to one thousand, one hundred forty-seven (1147) days.

The application for patent term adjustment is **GRANTED**.

On April 16, 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 was one thousand, one hundred sixty-two (1162) days.

The Office initially determined a patent term adjustment of one thousand, one hundred sixty-two (1162) days based on an adjustment for PTO delay of one thousand, one hundred sixty-two (1162) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 CFR § 1.703(a)(1), with no reductions for applicant delay.

However, Applicants point out that fifteen (15) days of applicant delay should have been assessed pursuant to 37 CFR 1.704(b). A review of the file reveals that the Office mailed a Notice to File Missing Parts on July 11, 2005. Applicants did not file a reply until October 26, 2005 (made timely by obtaining a two month extension of time). Accordingly, pursuant to 37 CFR 1.704(b), fifteen (15) days of applicant delay should have been assessed.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **one thousand, one hundred forty-seven (1147) days** (1162 days of PTO delay, reduced by 15 days of applicant delay).

Receipt of the $200 fee for filing the instant application for patent term adjustment is acknowledged.

The application is being forwarded to the Office of Data Management for processing into a patent.

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: copy of PAIR screen

# Patent Term Adjustments

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

Application Number*: 11160363 Search | Explanation of PTA Calculation | Explanation of PTE Calculation

## PTA Calculations for Application: 11160363

| | | | |
|---|---|---|---|
| Application Filing Date | 06/21/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 1162 |
| A Delays | 1162 | PTO Manual Adjustment | -15 |
| B Delays | 0 | Applicant Delay (APPL) | 0 |
| C Delays | 0 | Total PTA (days) | 1147 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 51 | 09/30/2010 | | P028 | Adjustment of PTA Calculation by PTO | | 15 | 0 |
| 42 | 04/16/2010 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 41 | 04/12/2010 | | IREV | Issue Revision Completed | | | 0 |
| 40 | 04/12/2010 | | DVER | Document Verification | | | 0 |
| 39 | 04/12/2010 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 38 | 04/12/2010 | | CNTA | Notice of Allowability | | | 0 |
| 31 | 02/19/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 33 | 01/25/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 32 | 01/25/2010 | 01/25/2010 | EIDS. | Electronic Information Disclosure Statement | | | 30 |
| 30 | 01/25/2010 | | A... | Response after Non-Final Action | | | 0 |
| 29 | 01/25/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 28 | 12/14/2009 | | EML_NTR | Email Notification | | | 0 |
| 27 | 12/14/2009 | | PA.. | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 26 | 12/08/2009 | | C.AD | Correspondence Address Change | | | 0 |
| 25 | 10/26/2009 | 08/21/2006 | MCTNF | Mail Non-Final Rejection | 1162 | | 1 |
| 24 | 10/24/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 23 | 09/29/2009 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 22 | 04/28/2009 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 20 | 03/16/2009 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 19 | 02/07/2009 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 18 | 12/29/2008 | | PG-ISSUE | PG-Pub Issue Notification | | | 0 |
| 16 | 12/04/2008 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 12 | 09/25/2008 | | OIPE | Application Dispatched from OIPE | | | 0 |
| 11 | 09/16/2008 | | PGPC | Sent to Classification Contractor | | | 0 |
| 10 | 09/16/2008 | | FLRCPT.U | Filing Receipt - Updated | | | 0 |
| 21 | 03/10/2006 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 17 | 03/10/2006 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 15 | 03/10/2006 | | RCAP | Reference capture on IDS | | | 0 |
| 14 | 03/10/2006 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 13 | 03/10/2006 | | BIG. | Statement Filed Indicating a Loss of Entitlement to Small Entity Status | | | 0 |
| 6 | 10/20/2005 | | MPTGR | Mail-Petition Decision - Granted | | | 0 |
| 9 | 10/26/2005 | | ADDFLFEE | Additional Application Filing Fees | | | 0 |
| 8 | 10/26/2005 | | OATHDECL | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | | | 0 |
| 5 | 09/26/2005 | | PET. | Petition Entered | | | 0 |
| 4 | 07/11/2005 | | INCD | Notice Mailed--Application Incomplete--Filing Date Assigned | | | 0 |
| 3 | 06/23/2005 | | L194 | Cleared by OIPE CSR | | | 0 |
| 2 | 06/21/2005 | | SCAN | IFW Scan & PACR Auto Security Review | | | 0 |
| 1 | 06/21/2005 | | IEXX | Initial Exam Team nn | | | 0 |

Export to: Excel

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) |
|---|---|---|---|---|
| 7,098,109 | 2006-08-29 | 11/160,523 | 2005-06-28 | LKSP0132USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-06 |
| Name | Winston Hsu | Registration Number | 41526 |

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
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www.uspto.gov

In re Patent No. 7098109
Issue Date: August 29,2006
Application No. 11160523
Filed: June 28,2005
Attorney Docket No. 11039-US-PA-1

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

This is a decision on the electronic petition, filed April 6,2012 ,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 April 6,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

# UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/160,565 | 06/29/2005 | Robert P. Morris | 1336/US | 1564 |

49277 7590 10/18/2010
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| ADDY, THJUAN KNOWLIN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2614 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/18/2010 | PAPER |

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAIL

OCT 18 2010

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh NC 27607

*In re* Application of:
Robert P. MORRIS
Appl. No.: 11/160,565
Filed: June 29, 2005
For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR PERFORMING A CONTEXT-BASED CALL ACTION IN RESPONSE TO AN INCOMING CALL INDICATION**

DECISION ON PETITION
UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on 16 July 2010.

The petition is **GRANTED**.

Pursuant to applicant's request filed on 16 July 2010, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Michael Horabik whose telephone number is (571) 272-3068.

*/Michael Horabik/*

Michael Horabik, TQAS
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/160,565 | 06/29/2005 | Robert P. Morris | I336/US | 1564 |

49277 7590 02/09/2011
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| ADDY, THJUAN KNOWLIN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2614 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/09/2011 | 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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P.O. Box 1450
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SCENERA RESEARCH, LLC
5400 Trinity Road
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Raleigh NC 27607

*In re* Application of:
Robert P. MORRIS
Appl. No.: 11/160,565
Filed: June 29, 2005
For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR PERFORMING A CONTEXT-BASED CALL ACTION IN RESPONSE TO AN INCOMING CALL INDICATION**

DECISION ON PETITION
UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on 24 January 2011.

The petition is **GRANTED**.

Pursuant to applicant's request filed on 24 January 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Michael Horabik whose telephone number is (571) 272-3068.

/Wellington Chin/

Wellington Chin, TQAS
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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49277 7590 05/17/2011
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| ADDY, THJUAN KNOWLIN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2614 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/17/2011 | 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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*In re* Application of:
Robert P. MORRIS
Appl. No.: 11/160,565
Filed: June 29, 2005
For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR PERFORMING A CONTEXT-BASED CALL ACTION IN RESPONSE TO AN INCOMING CALL INDICATION**

DECISION ON PETITION
UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on 16 May 2011.

The petition is **GRANTED**.

Pursuant to applicant's request filed 16 May 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Wellington Chin whose telephone number is (571) 272-3134.

/Wellington Chin/

Wellington Chin, TQAS
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/160,565 | 06/29/2005 | Robert P. Morris | 1336/US | 1564 |

49277 7590 08/30/2011
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| ADDY, THJUAN KNOWLIN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2614 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/30/2011 | 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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SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh NC 27607

*In re* Application of:
Robert P. MORRIS
Appl. No.: 11/160,565
Filed: June 29, 2005
For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR PERFORMING A CONTEXT-BASED CALL ACTION IN RESPONSE TO AN INCOMING CALL INDICATION**

DECISION ON PETITION UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on 09 August 2011.

The petition is **GRANTED**.

Pursuant to applicant's request filed 09 August 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Wellington Chin whose telephone number is (571) 272-3134.

/Wellington Chin/

Wellington Chin, TQAS
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/160,565 | 06/29/2005 | Robert P. Morris | 1336/US | 1564 |

49277 7590 01/05/2012
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| ADDY, THJUAN KNOWLIN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2614 | |

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

SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh NC 27607

*In re* Application of:
Robert P. MORRIS
Appl. No.: 11/160,565
Filed: June 29, 2005
For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR PERFORMING A CONTEXT-BASED CALL ACTION IN RESPONSE TO AN INCOMING CALL INDICATION**

DECISION ON PETITION UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on 30 November 2011.

The petition is **GRANTED**.

Pursuant to applicant's request filed 09 August 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Wellington Chin whose telephone number is (571) 272-3134.

/Wellington Chin/

Wellington Chin, TQAS
Technology Center 2600
Communications

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) |
|---|---|---|---|---|
| 7,164,283 | 2007-01-16 | 11/160,661 | 2005-07-05 | LKSP0169USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-05 |
| Name | Winston Hsu | Registration Number | 41526 |

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. 7164283
Issue Date: January 16,2007
Application No. 11160661
Filed: July 5,2005
Attorney Docket No. 12778-US-PA-1

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

This is a decision on the electronic petition, filed April 5,2012 ,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 April 5,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION
P.O. BOX 506
MERRIFIELD VA 22116

**MAILED**

MAR 20 2012

**OFFICE OF PETITIONS**

In re Application of :
Sam Shiaw-Shiang Jiang :
Application No. 11/160,684 : NOTICE
Filed: July 5, 2005 :
Attorney Docket No. **ASTP0046USA** :

This is a notice regarding your request filed February 9, 2012, for acceptance of a fee deficiency submission under 37 CFR 1.28.

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

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

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Sang N. Dang 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, Sang N. Dang 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 Sang N. Dang, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

This 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) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Sang N. Dang
Klein, O'Neill & Singh, LLP
18200 Von Karman Avenue, Suite 725
Irvine, CA 92612

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. 7183606
Issue Date: February 27,2007
Application No. 11160743
Filed: July 7,2005
Attorney Docket No. 11492-US-PA-1

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

This is a decision on the electronic petition, filed September 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 September 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.

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) |
|---|---|---|---|---|
| 7,183,606 | 2007-02-27 | 11/160,743 | 2005-07-07 | LKSP0078USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2011-09-23 |
| Name | Winston Hsu | Registration Number | 41526 |

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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SONIA HILLIOS
81 GUNN ROAD
SOUTHAMPTON, MA 01073

MAILED
MAR 3 1 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of<br>Sonia R. Hillios, et al.<br>Application No. 11/160,792<br>Filed: July 8, 2005<br>Attorney Docket No.: 38555.38-0 | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed February 14, 2011.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay 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, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on February 17, 2010. A Notice of Abandonment was subsequently mailed on March 1, 2010. On February 14, 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 the $755 issue fee and the $300 publication fee; (2) the petition fee of $810; 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

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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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MAILED

MAY 17 2011

OFFICE OF PETITIONS

Marek Kaminski
4451 Dewitz Rd.
Fall Creek, WI 54742

| | | |
|---|---|---|
| In re Application ofMarek and Zofia S. Kaminski | : | |
| Application No. 11/160,890 | : | Decision on Petition |
| Filing Date July 14, 2005 | : | |
| For: An Orthopedic Appliance and Method to Reduce Anterior Dislocation of Shoulder and to Provide Post Reduction Immobilization | : | |

This is a decision on the "complaint" alleging" undue abandonment" of the instant application filed March 7, 2011, which is being treated as a petition under 37 C.F.R. § 1.181 requesting withdrawal of the holding of abandonment.

The petition is **dismissed**.

Any request for reconsideration under 37 C.F.R. § 1.181 must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

## BACKGROUND

### Final Office Action and Response to the Final Office Action

The Office mailed a final Office action on June 24, 2009. The final Office action indicated Claims 8-18 were pending and indicated all the pending claims were rejected.

An amendment was filed in response to the final Office action on September 14, 2009.

#### The Rejection of Claims 8-11 and 13-18 Under 35 U.S.C. § 112, First Paragraph

The June 24, 2009 final Office action rejects Claims 8-11 and 13-18 under 35 U.S.C. § 112, first paragraph. The final Office action states, with emphasis added,

> [Claims 8-11 and 13-18] contain[] subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

> the inventor(s), *at the time the application was filed*, had possession of the claimed invention. Applicant's *original disclosure* failed to include deflating the pouch once reduction is accomplished.

The amendment does not remove the language involving "deflating the pouch" from any claim. The amendment also does not argue the rejection of Claims 8-11 and 13-18 based on the "deflating the pouch" language was improper or incorrect.

The final Office action states, with emphasis added,

> [Claim 9] contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention. Applicant's *original disclosure* failed to include allowing for the gradual inflation of the pouch while maintaining pressure and allowing for immediate release of the pressure when needed."

The amendment does not remove the language at issue from Claim 9. The amendment also does not argue the rejection of Claim 9 based on language at issue is improper or incorrect. Instead, the amendment attempts to add the language at issue to the specification.

The final Office action states, with emphasis added,

> [Claim 14] contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention. Applicant's *original disclosure* failed to include pulling the free ends of said chest belt through a chest belt buckle.

The amendment does not remove the language at issue from Claim 14. The amendment also does not argue the rejection of Claim 14 based on the language at issue is improper or incorrect. Instead, the amendment attempts to add the language at issue to the specification.

The final Office action states, with emphasis added,

> [Claim 16] contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention. Applicant's *original disclosure* failed to include flexing the elbow.

The amendment does not remove the language at issue from Claim 16. The amendment also does not argue the rejection of Claim 16 based on the language at issue is improper or incorrect. Instead, the amendment attempts to add similar language to the specification.

The final Office action states, with emphasis added,

> [Claim 17] contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention. Applicant's *original disclosure* failed to include deflating the pouch after the reduction of the anterior dislocation of the shoulder joint."

The amendment does not remove the language at issue from Claim 17. The amendment also does not argue the rejection of Claim 17 based on the language at issue is improper or incorrect. Instead, the amendment attempts to add similar language to the specification.

The final Office action states, with emphasis added,

> [Claim 18] contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention. Applicant's original disclosure failed to include leaving said chest belt temporarily in place, after the deflation of said pouch.

The amendment does not remove the language at issue from Claim 18. The amendment also does not argue the rejection of Claim 18 based on the language at issue is improper or incorrect. Instead, the amendment attempts to add similar language to the specification.

The Rejection of Claim 10 Under 35 U.S.C. § 112, First Paragraph

The final Office rejects Claim 10 under 35 U.S.C. § 112, second paragraph. The final Office action states, "The phrase 'strong fabric' is indefinite because the term strong is ambiguous."

The amendment deletes the term "strong" from the claim.

The Rejection of Claim 12 Under 35 U.S.C. § 102(b)

The final Office action rejects Claim 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,830,165.

The amendment does not make any change to Claim 12. The amendment also does not argue the rejection of Claim 12 under 35 U.S.C. § 102(b) was improper or incorrect.

Objection to Claims 8 and 10 Based on Informalities

The final Office action objects to Claim 8 based on informalities and suggests changes that may be made to correct the informalities. The amendment makes the requested changes.

The final Office action objects to Claim 10 based on informalities and suggests changes that may be made to correct the informalities. The amendment makes the requested changes.

## Advisory Action and Notice of Non-Compliant Amendment

The Office mailed an Advisory Action and a Notice of Non-Complaint Amendment on November 9, 2009. The Advisory Action states,

> The proposed amendment(s) ... raise new issues that would require further consideration and/or search.... New claims 8 and 10 disclose new limitations that have not been previously searched, and the [amended claims] are broader than the previously presented claims; therefore, a new search will be necessary.

The Notice of Non-Complaint Amendment states, with emphasis in the original,

> [T]he status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended)....
>
> The status identifiers on claim 8-18 say "(New)" and "(New Corrected)", however the status identifiers should [state] "Previously Presented" and "Amended"....
>
> Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment.

## Response to the Advisory Action and the Notice of Non-Compliant Amendment

A "Response to Advisory Action before the Filing of an Appeal dated November 9, 2009 and January 26, 2010 email" ("Response") was filed February 12, 2010.

The Response includes an amendment setting forth claims with corrected identifiers and requests reconsideration of the Advisory Action.

## Notice of Abandonment

The Office mailed a Notice of Abandonment on March 4, 2010.

## "Petition"

A "complaint" was filed March 7, 2011. The complaint alleges the abandonment of the application was "undue" and requests "corrective action." As previously noted, the complaint is being treated as a petition under 37 CFR 1.181 requesting withdrawal of the holding of abandonment.

As a preliminary matter, the Office notes a review of the record indicates an executed oath or declaration has not been filed for the instant application. The Office *strongly* recommends any future petition to revive, if such a petition is filed, include an executed oath or declaration.

The Petition is not Properly Signed

The original application papers state the inventors are Marek Kaminski ("Mr. Kaminski") and Zofia Stanislawa Kaminski ("Ms. Kaminski"). Since an executed oath or declaration has not been filed, the inventors for the application are Mr. Kaminski and Ms. Kaminski. *See* 37 C.F.R. § 1.41(a)(1).

37 C.F.R. § 1.33(b) 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 patent practitioner of record appointed in compliance with § 1.32(b);
> (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;
> (3) An assignee as provided for under § 3.71(b) of this chapter; or
> (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

The petition is only signed by Mr. Kaminski. The record fails to indicate Mr. Kaminski is a patent practitioner, an assignee as provided for under 37 C.F.R. § 3.71(b), or a sole inventor. Therefore, the petition is not properly signed and must be *dismissed.*

Any future papers filed in this application must be signed by all the inventors, a patent practitioner, or an assignee as provided for under 37 C.F.R. § 3.71(b).

The Petition is Untimely

Pursuant to 37 C.F.R. § 1.181(f), the Office may dismiss a petition to withdraw the holding of abandonment filed more than two months after the issuance of a Notice of Abandonment as untimely.

Petitioner has not provided any explanation for waiting a year to file the instant petition. In view of the complete absence of any explanation for the delay in the filing of the instant petition, the petition is *dismissed* as untimely.

A Proper Reply was not Filed in Response to the June 24, 2009 Final Office Action.

The instant application is abandoned unless one of the following items was timely filed in response to the final Office action:

1. An amendment *prima facie* placing the case in condition for allowance,
2. A Notice of Appeal and the required appeal fee, or
3. A Request for Continued Examination ("RCE"), a submission, and the required RCE fee.

Neither a Notice of Appeal nor a RCE was filed in response to the final Office action. Therefore, the application is abandoned unless the September 14, 2009 amendment *prima facie* ("on its face") placed the application in condition for allowance.

In order for an amendment to *prima facie* place the application in condition for allowance, the amendment must:

1. Be properly signed,
2. Comply with the requirements set forth in 37 C.F.R. § 1.121,
3. Resolve all outstanding rejections and objections, and
4. Not raise any new issues that would require further search and/or consideration.

The September 14, 2009 amendment does not satisfy the requirements set forth above.

The Amendment is not Properly Signed.

The amendment is signed by Mr. Kaminski, but not by Ms. Kaminski. Therefore, the amendment was not properly signed. Since the amendment was not properly signed, the amendment was not a proper reply to the final Office action.

The Amendment does not Comply With all the Requirements Set Forth in 37 C.F.R. § 1.121

37 C.F.R. § 1.121(b)(1) states,

> Amendments to the specification ... which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting ... (ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text.

The amendment adds language to the specification without underlining the added language. Therefore, the amendment fails to comply with 37 C.F.R. § 1.121(b)(1)(ii).

37 C.F.R. § 1.121(c)(2) states, "The text of any added subject matter [to a claim] must be shown by underlining the added text." The amendment adds language to Claim 10 without underlining the added language. Therefore, the amendment fails to comply with 37 C.F.R. § 1.121(c)(2).

37 C.F.R. § 1.121(c)(4)(i) states, "No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered." The amendment sets forth text for canceled claims. Therefore, the amendment fails to comply with 37 C.F.R. § 1.121(c)(4)(i).

37 C.F.R. § 1.121(c) states,

> [T]he status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

The Office informed Petitioner of the requirement for the claims in an amendment to use the status identifiers listed in 37 C.F.R. § 1.121(c) on two different occasions prior to Petitioner filing the September 14, 2009 amendment. Specifically, Petitioner had been informed of the requirement in a Notice of Non-Compliant Amendment mailed October 2, 2007, and in a Notice of Non-Compliant Amendment mailed November 6, 2007.

The amendment includes the status identifier of "(New; Corrected)" for claims 8 and 10. In other words, the amendment does not use any of the status identifiers identified in 37 C.F.R. § 1.121(c) for claims 8 and 10.

As discussed in M.P.E.P. § 714(II)(E), the Office has waived the requirements of 37 C.F.R. § 121 to the extent the Office will permit the use of the alternative status identifiers set forth in the same section of the M.P.E.P. "if the amendment otherwise complies with 37 CFR 1.121." The alternative status identifiers do not include "(New; Corrected) and the September 14, 2009 amendment did not otherwise comply with the requirements set forth in 37 C.F.R. § 121. Therefore, the amendment failed to comply with the status identifier requirements set forth in 37 C.F.R. § 121(c).

In view of the prior discussion, the amendment failed to comply with the requirements set forth in 37 C.F.R. § 1.121. Therefore, the amendment was not a proper reply to the final Office action.

Brief Discussion of the Issue of Whether or not the Amendment Resolved All the Outstanding Rejections and Objections

The amendment was clearly improper because it was not properly signed and did not comply with the requirements set forth in 37 C.F.R. § 1.121. Since the amendment was improper based on the previously discussed reasons, the Office technically does not need to determine if the amendment was also improper for any other reasons. However, as a courtesy, the Office will briefly discuss some, *but not necessarily all*, of the other reasons the amendment appears to have been improper.

A proper amendment after final should only require a cursory/brief review by an examiner in order to determine the amendment places *all* pending claims in condition for allowance. For example, in a case where some claims have been allowed and some claims have been rejected, an amendment canceling all the rejected claims would *prima facie* place the amendment in condition for allowance.

A review of the record fails to indicate a cursory/brief review of the amendment by an examiner would reveal the amendment resolved the rejection of every claim.

The final Office action rejected all the claims, except Claim 12, under 35 U.S.C. § 112, first paragraph.[1] In essence, the final Office action asserted the changes to the claims added new matter to the claims.

[1] Despite Petitioner's assertion Claim 8 was not rejected set forth on page 10 of a letter filed February 12, 2010, the final Office action did reject Claim 8.

The first rejection set forth in the final Office action indicated Claims 8-11 and 13-18 added new matter as a result of the addition of language involving deflating a pouch to Claim 8. The Office notes Claims 10-11 and 13-18 depend on Claim 8.

The amendment appears to totally ignore the first rejection set forth in the final Office action. Therefore, the amendment clearly failed to resolve all the rejections which applied to Claims 8-11 and 13-18.

The final Office action included rejections under 35 U.S.C. § 112, first paragraph, which applied directly to Claims 9, 14, 16, 17, and 18. The amendment did not delete the alleged new matter from the claims or argue the alleged new matter in each of the claims was not actually new matter. Instead, the amendment attempts to add the alleged new matter to the specification. A party cannot resolve an objection based on a claim containing new matter by add the alleged new matter to the specification. Therefore, the amendment clearly did not resolve the rejections which applied directly to Claims 9, 14, 16, 17, and 18.

The final Office action rejected Claim 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,830,165. The amendment does not address, or even recognize the existence of, the rejection of Claim 12. An amendment which ignores the rejection of a claim is not an amendment which clearly resolves the rejection of the claim.

Petitioner implies the amendment was proper because Petitioner made all the changes required by the examiner. The Office acknowledges a reply to a final Office action may be proper if:

1. The final Office action suggests changes to an application,
2. The final Office action states an amendment making the suggested changes will render *all* the claims allowable,
3. The amendment makes the suggested changes, and
4. The amendment does not make any changes other than the suggested changes.

Although the final Office action suggested changes to correct informalities in two claims, the final Office action did *not* state the changes would render all the claims allowable. In fact, the final Office action did not even state the changes would resolve the rejections, as opposed to the objections, pertaining to the two claims.

Even if the final Office action had stated the changes to the two claims would render all the claims allowable, the September 14, 2009 amendment would be improper because the amendment made several changes to the application that were not suggested by the examiner. Specifically, the amendment includes multiple changes to the specification. Petitioner alleges "the parts [of the] disclosure pertinent to claims 9, 14, 16, 17, 18 were amended in the strictest accordance with the examiner's instructions." Petition, p. 2. However, the final Office action does *not* instruct Petitioner to make any changes to the specification.

Brief Discussion of the Issue of Whether or not the Amendment Raised New Issue Requiring Further Search or Consideration

Petitioner's arguments that Claims 8 and 10 did not raise any new issues that would require further search or consideration appear to focus on the fact the examiner suggested Petitioner make the changes in order to satisfy informalities in the claims. However, the final rejection does *not* assert changes to the claims correcting the informalities would not raise new issues. Therefore, proof the examiner suggested the changes is not proof the changes did not raise any new issues by altering the scope of the claim.

Petitioner should note, even if the changes to Claims 8 and 10 did not raise any new issues, the amendment would still be improper for several reasons, which include:

1. The amendment was not properly signed,
2. The amendment did not comply with the requirements in 37 C.F.R. § 1.121, and
3. The amendment failed to *prima facie* resolve the rejection of each and every pending claim.

**Petitioner May Wish to File a Petition Under 37 C.F.R. § 1.137(b) to Revive the Application**

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b).

If a petition under 37 C.F.R. § 1.137(b) is filed, the petition must include a proper reply to the June 4, 2009 Office action, the required petition fee of $810, and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The required reply to the June 4, 2009 Office action can be:

1. An amendment *prima facie* placing the case in condition for allowance,
2. A Notice of Appeal and the required appeal fee,
3. A Request for Continued Examination ("RCE"), a submission (typically an amendment), and the required RCE fee, or
4. A continuation application.

A copy of a PDF "fillable" petition under 37 CFR 1.137(b) form can be found at: http://www.uspto.gov/web/forms/sb0064.pdf. A copy of a PDF "fillable" request for continued examination form can be found at: http://www.uspto.gov/web/forms/sb0030.pdf

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.[2] Document Code "PET.OP" should be used if the request is filed electronically.

[2] General Information concerning EFS Web can be found at http://www.uspto.gov/patents/process/file/efs/index.jsp.

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

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

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

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
AUG 02 2011
OFFICE OF PETITIONS

Marek Kaminski
4451 Dewitz Rd.
Fall Creek, WI 54742

In re Application of Marek and Zofia S. Kaminski :
Application No. 11/160,890 : Decision on Petition
Filing Date July 14, 2005 :
For: An Orthopedic Appliance and Method to Reduce Anterior Dislocation of Shoulder and to Provide Post Reduction Immobilization :

This is a decision on the petition filed July 11, 2011, which requests withdrawal of the holding of abandonment.

The petition is **dismissed**.

Any request for reconsideration under 37 C.F.R. § 1.181 must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.181."

## Background

The Office mailed a final Office action on June 24, 2009. The final Office action indicated Claims 8-18 were pending and indicated all the pending claims were rejected.

An amendment was filed in response to the final Office action on September 14, 2009.

The Office mailed an Advisory Action and a Notice of Non-Complaint Amendment on November 9, 2009.

A "Response to Advisory Action before the Filing of an Appeal dated November 9, 2009 and January 26, 2010 email" ("Response") was filed February 12, 2010. The Response includes an amendment setting forth claims with corrected identifiers and requests reconsideration of the Advisory Action.

The Office mailed a Notice of Abandonment on March 4, 2010.

A "complaint" alleging" undue abandonment" of the instant application was filed March 7, 2011. The Office treated the complaint as a petition under 37 C.F.R. § 1.181 requesting withdrawal of the holding of abandonment.

The Office issued a decision dismissing the complaint on May 17, 2011.

> Pursuant to 37 C.F.R. § 1.181(f), the Office may dismiss a petition to withdraw the holding of abandonment filed more than two months after the issuance of a Notice of Abandonment as untimely.
>
> Petitioner has not provided any explanation for waiting a year to file the instant petition. In view of the complete absence of any explanation for the delay in the filing of the instant petition, the petition is *dismissed* as untimely....
>
> The amendment is signed by Mr. Kaminski, but not by Ms. Kaminski. Therefore, the amendment was not properly signed. Since the amendment was not properly signed, the amendment was not a proper reply to the final Office action....
>
> [T]he amendment fails to comply with 37 C.F.R. § 1.121(b)(1)(ii)....
>
> [T]he amendment fails to comply with 37 C.F.R. § 1.121(c)(2)....
>
> [T]he amendment fails to comply with 37 C.F.R. § 1.121(c)(4)(i)....
>
> [T]he amendment failed to comply with the status identifier requirements set forth in 37 C.F.R. § 121(c).
>
> In view of the prior discussion, the amendment failed to comply with the requirements set forth in 37 C.F.R. § 1.121. Therefore, the amendment was not a proper reply to the final Office action....
>
> The amendment was clearly improper because it was not properly signed and did not comply with the requirements set forth in 37 C.F.R. § 1.121. Since the amendment was improper based on the previously discussed reasons, the Office technically does not need to determine if the amendment was also improper for any other reasons. However, as a courtesy, the Office will briefly discuss some, *but not necessarily all*, of the other reasons the amendment appears to have been improper.

<u>The Petition is Untimely.</u>

The Office mailed a Notice of Abandonment on March 4, 2010.

A petition under 37 C.F.R. § 1.181 was not filed until March 7, 2011.

The May 17, 2011 decision dismissed the "complaint" as untimely. The decision stated,

> Petitioner has not provided any explanation for waiting a year to file the instant petition. In view of the complete absence of any explanation for the delay in the filing of the instant petition, the petition is *dismissed* as untimely.

The instant petition states, "Thank you for not dismissing my petition as untimely." However, as noted above, the decision *clearly* dismissed the prior petition as untimely.

The instant petition states attempts to communicate with the examiner regarding the abandoned status of the application were made as late as April 7, 2010. However, the petition does not provide an explanation for the delay from April 8, 2010, to May 7, 2011, in the submission of a petition to withdraw the holding of abandonment.

In view of the prior discussion, the instant petition is dismissed as untimely.

A Proper Reply was not Filed in Response to the June 24, 2009 Final Office Action.

The application is abandoned unless a proper reply was timely filed in response to the June 24, 2009 final Office action. The only reply timely filed in response to the final Office was an amendment filed September 14, 2009. Therefore, the application is abandoned unless the September 14, 2009 amendment was a proper reply to the final Office action.

The September 14, 2009 amendment was not properly signed. Therefore, the amendment was not a proper reply to the final Office action and the application is abandoned.

The September 14, 2009 amendment did not comply with the requirements set forth in 37 C.F.R. § 1.121. Therefore, the amendment was not a proper reply to the final Office action and the application is abandoned.

The petition appears to argue, in essence, that the September 14, 2009 amendment did not raise new issues that would have required further search and/or consideration. The Office need not determine if the September 14, 2009 amendment raised new issues because the amendment was clearly not a proper reply to the final Office action *even if* the amendment did not raise any new issues. As previously stated, the amendment was not properly signed and did not comply with the requirements set forth in 37 C.F.R. § 1.121.

Conclusion

The instant petition is untimely and fails to demonstrate a proper reply was timely filed in response to the June 24, 2009 final Office action. Therefore, the petition is dismissed.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.[1] Document Code "PET.OP" should be used if the request is filed electronically.

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

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

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

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

[1] General Information concerning EFS Web can be found at http://www.uspto.gov/patents/process/file/efs/index.jsp.

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OFFICE OF PETITIONS

Marek Kaminski
4451 Dewitz Rd.
Fall Creek, WI 54742

In re Application of Marek and Zofia S. Kaminski :
Application No. 11/160,890 : Decision on Petition
Filing Date July 14, 2005 :
For: An Orthopedic Appliance and Method to :
Reduce Anterior Dislocation of Shoulder :
and to Provide Post Reduction
Immobilization

This is a decision on the petition filed September 22, 2011, which requests withdrawal of the holding of abandonment.

The petition is **dismissed**.

Any request for reconsideration under 37 C.F.R. § 1.181 must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.181."

The instant application is abandoned unless one of the following items was timely filed in response to the final Office action:

1. An amendment *prima facie* placing the case in condition for allowance,
2. A Notice of Appeal and the required appeal fee, or
3. A RCE, a submission, and the required RCE fee.

Neither a Notice of Appeal nor a RCE was filed in response to the final Office action. Therefore, the application is abandoned unless the September 14, 2009 amendment *prima facie* ("on its face") placed the application in condition for allowance. In order for an amendment to *prima facie* place the application in condition for allowance, the amendment must:

1. Comply with the requirements set forth in 37 C.F.R. § 1.121,
2. Be properly signed in accordance with 37 C.F.R. § 1.33,
3. Resolve <u>all</u> outstanding rejections and objections, and
4. Not raise any new issues that would require further search and/or consideration.

A prior decision mailed May 17, 2011, states,

> 37 C.F.R. § 1.121(b)(1) states,
>
> > Amendments to the specification ... which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting ... (ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text.
>
> The amendment adds language to the specification without underlining the added language. Therefore, the amendment fails to comply with 37 C.F.R. § 1.121(b)(1)(ii).

The instant petition does not establish, or even argue, the September 14, 2009 amendment complied with the provisions of 37 C.F.R. § 1.121(b)(1).

The May 17, 2011 decision states,

> 37 C.F.R. § 1.121(c)(2) states, "The text of any added subject matter [to a claim] must be shown by underlining the added text." The amendment adds language to Claim 10 without underlining the added language. Therefore, the amendment fails to comply with 37 C.F.R. § 1.121(c)(2).

The instant petition does not establish, or even argue, the September 14, 2009 amendment complied with the provisions of 37 C.F.R. § 1.121(c)(2).

The May 17, 2011 decision states,

> 37 C.F.R. § 1.121(c)(4)(i) states, "No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered." The amendment sets forth text for canceled claims. Therefore, the amendment fails to comply with 37 C.F.R. § 1.121(c)(4)(i).

The instant petition does not establish, or even argue, the September 14, 2009 amendment complied with the provisions of 37 C.F.R. § 1.121(c)(4)(i).

The May 17, 2011 decision states,

> 37 C.F.R. § 1.121(c) states,
>
> > [T]he status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered). The Office informed Petitioner of the requirement for the claims in an amendment to use the status identifiers listed in 37 C.F.R. § 1.121(c) on two

different occasions prior to Petitioner filing the September 14, 2009 amendment. Specifically, Petitioner had been informed of the requirement in a Notice of Non-Compliant Amendment mailed October 2, 2007, and in a Notice of Non-Compliant Amendment mailed November 6, 2007.

The amendment includes the status identifier of "(New; Corrected)" for claims 8 and 10. In other words, the amendment does not use any of the status identifiers identified in 37 C.F.R. § 1.121(c) for claims 8 and 10.

As discussed in M.P.E.P. § 714(II)(E), the Office has waived the requirements of 37 C.F.R. § 121 to the extent the Office will permit the use of the alternative status identifiers set forth in the same section of the M.P.E.P. "if the amendment otherwise complies with 37 CFR 1.121." The alternative status identifiers do not include "(New; Corrected) and the September 14, 2009 amendment did not otherwise comply with the requirements set forth in 37 C.F.R. § 121. Therefore, the amendment failed to comply with the status identifier requirements set forth in 37 C.F.R. § 121(c).

The instant petition does not establish, or even argue, the September 14, 2009 amendment complied with the status identifier requirements set forth in 37 C.F.R. § 1.121(c).

In view of the prior discussion, the record fails to establish the September 14, 2009 amendment complies with the requirements set forth in 37 C.F.R. § 1.121. Since the amendment failed to comply with the requirements set forth in 37 C.F.R. § 1.121, the amendment was improper and the application is abandoned.

Since the September 14, 2009 amendment is clearly abandoned because the amendment failed to comply with the requirements set forth in 37 C.F.R. § 1.121, the Office does not need to determine and address the extent to which the application is abandoned for other reasons as well or determine if the petition should be dismissed as untimely due to delay in the submission of the March 7, 2011 petition.

The instant petition appears to argue an error in the Notice of Abandonment prevented the abandonment of the application. However, the application became abandoned on a date prior to the Notice of Abandonment being mailed. In addition, the examiner's failure to correctly state the reason an application is abandoned does not change the fact the application is abandoned.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.[1] Document Code "PET.OP" should be used if the request is filed electronically.

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

[1] General Information concerning EFS Web can be found at http://www.uspto.gov/patents/process/file/efs/index.jsp.

By 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
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Marek Kaminski
4451 Dewitz Rd.
Fall Creek, WI 54742

**MAILED**

FEB 02 2012

**OFFICE OF PETITIONS**

In re Application of Marek and Zofia S. Kaminski :
Application No. 11/160,890 :
Filing Date July 14, 2005 :
For: An Orthopedic Appliance and Method to Reduce Anterior Dislocation of Shoulder and to Provide Post Reduction Immobilization :

Decision on Petition

This is a decision on the petition filed January 4, 2012, which requests withdrawal of the holding of abandonment.

The petition is **dismissed**.

Any request for reconsideration under 37 C.F.R. § 1.181 must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.181."

The instant petition is not signed by either inventor. Since the cover letter filed with the petition is signed by both inventors, the Office is treating the petition as "signed" in this case. However, all future papers should be signed by both inventors.

37 C.F.R. § 1.121(c) states,

> [T]he status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

The Office informed Applicants of the requirement for the claims in an amendment to use the status identifiers listed in 37 C.F.R. § 1.121(c) on <u>two</u> different occasions prior to Applicants filing an amendment on September 14, 2009.

The September 14, 2009 amendment includes the status identifier of "(New; Corrected)" for claims 8 and 10. In other words, the amendment does not use any of the status identifiers identified in 37 C.F.R. § 1.121(c) for claims 8 and 10.

Two prior decisions have stated, with emphasis added,

> As discussed in M.P.E.P. § 714(II)(E), the Office has waived the requirements of 37 C.F.R. § 121 to the extent the Office will permit the use of the alternative status identifiers set forth in the same section of the M.P.E.P. "if the amendment otherwise complies with 37 CFR 1.121." The alternative status identifiers **do not include** "(New; Corrected) and the September 14, 2009 amendment did not otherwise comply with the requirements set forth in 37 C.F.R. § 121. Therefore, the amendment failed to comply with the status identifier requirements set forth in 37 C.F.R. § 121(c).

The instant petition alleges the September 14, 2009 amendment complied with all the requirements of 37 C.F.R. § 1.121 except the requirement pertaining to claim status identifiers. The petition also appears to assert "(New; Corrected)" is one of the alternative status identifiers identified in the M.P.E.P.

As stated in the two prior decisions, the alternative status identifiers in the M.P.E.P. do <u>not</u> include the identifier "(New; Corrected)". Therefore, the September 14, 2009 amendment did not comply with 37 C.F.R. § 1.121.

Since the September 14, 2009 amendment did not comply with 37 C.F.R. § 121, the amendment was not a proper reply to the outstanding final Office action and the application is abandoned.

The September 14, 2009 amendment is clearly abandoned because the amendment failed to comply with the requirements set forth in 37 C.F.R. § 1.121. Therefore, the Office does not need to determine and address the extent to which the application is abandoned for other reasons as well or determine if the petition should be dismissed as untimely due to delay in the submission of the March 7, 2011 petition.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.[1] Document Code "PET.OP" should be used if the request is filed electronically.

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

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

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

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Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

23 AUG 2010

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO IL 60606

| | | |
|---|---|---|
| In re Application of: | : | |
| BLALOCK, Travis, N., et al. | : | DECISION ON PETITION |
| U.S. Application No.: 11/160,914 | : | (37 CFR 1.78(a)(3) and (a)(6)) |
| Filing Date: July 14, 2005 | : | |
| Attorney Docket No.: 06-425-D | : | |
| For: ULTRASONIC TRANSDUCER | : | |
| DRIVE | : | |

This is a decision on the "Petition under 37 CFR 1.181 and 1.78 To Accept An Unintentionally Delayed Priority Claim" filed July 12, 2010, treated herein under 37 CFR 1.78(a)(3) and (a)(6). Applicants have paid the required petition fee.

The petition is **GRANTED**.

37 CFR 1.78(a)(3) applies where an applicant seeks to add a delayed claim of benefit under 35 U.S.C. 120 and 365(c) to a prior-filed international application designating the United States; 37 CFR 1.78(a)(6) applies where an applicant seeks to add a delayed claim of priority to a prior-filed U.S. provisional application. Applicant here is seeking to add priority claims directed to the prior-filed international application (PCT/US2004/000888) and U.S. provisional applications (60/440,020, 60/439,990, and 60/440,262) identified in the concurrently filed amendment. Accordingly, the present petition is properly considered under both 37 CFR 1.78(a)(3) and (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). The present non-provisional 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 periods 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 under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by the following:

**(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 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)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

The present petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) and (a)(6) in that: (1) proper references to the prior-filed international application and provisional applications have been included in the amendment to the first sentence of the specification filed July 12, 2010; (2) applicant has submitted payment of the required surcharge; and (3) the petition includes a proper statement of unintentional delay. Accordingly, having found that the petition for acceptance of the unintentionally delayed claims 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 (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 (a)(6) should <u>not</u> 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 application, all other requirements under 35 U.S.C. 120 and 119(e) and 37 CFR 1.78(a)(1), (a)(2), (a)(5), and (a)(6) must be met. Similarly, the fact that the Filing Receipt accompanying this decision on petition will include 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 claims to the prior-filed international and provisional applications, accompanies this decision on petition.

Any questions concerning this decision may be directed to Richard M. Ross at (571) 272-3296. 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 3768 for further examination and for appropriate consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. 120 and 119(e) to the prior-filed international and provisional applications.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration

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 |
|---|---|---|---|---|---|---|
| 11/160,914 | 07/14/2005 | 3768 | 1015 | 06-425-D | 41 | 3 |

**CONFIRMATION NO. 1913**

**CORRECTED FILING RECEIPT**

20306
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

*OC000000043094890*

Date Mailed: 08/23/2010

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)**

Travis N. Blalock, Charlottesville, VA;
William F. Walker, Barboursville, VA;
John A. Hossack, Charlottesville, VA;

**Assignment For Published Patent Application**

UNIVERSITY OF VIRGINIA PATENT FOUNDATION, Charlottesville, VA

**Power of Attorney:** The patent practitioners associated with Customer Number 020306

**Domestic Priority data as claimed by applicant**

This application is a CON of PCT/US04/00888 01/14/2004
which claims benefit of 60/439,990 01/14/2003
and claims benefit of 60/440,020 01/14/2003
and claims benefit of 60/440,262 01/15/2003

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 07/22/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/160,914**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**** SMALL ENTITY ****

**Title**

ULTRASONIC TRANSDUCER DRIVE

**Preliminary Class**

600

## 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

30 AUG 2010

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20306
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. Wacker Drive
32nd Floor
Chicago, IL 60606

| | | |
|---|---|---|
| In re Application of<br>BLALOCK *et al*<br>Application No.: 11/160,915<br>Filing Date: July 14, 2005<br>Attorney Docket No.: 06-426-B<br>For: ULTRASOUND IMAGING BEAM-FORMER APPARATUS AND METHOD | : | **DECISION** |

This is a decision on the renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed July 12, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §§120, 365(c) and 119(e) for the benefit of prior-filed applications.

The renewed petition is hereby **GRANTED** as follows:

This is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6). The nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed international and provisional applications are submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Items (2) and (3) were previously completed. Regarding item (1), applicants provided a reference that properly states the relationship of the prior-filed international application to the subject application required by 37 CFR 1.78(a)(3). This reference is acceptable.

All items of 37 CFR 1.78(a)(3) are now complete.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) and (a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §119(e), §120 and 37 CFR 1.78(a)(1), (a)(2), (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 the instant application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed international and provisional applications, accompanies this decision on petition.

Any questions concerning this decision may be directed to James Thomson at (571) 272-3302. 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 3768 for appropriate action on the amendment filed July 12, 2010, including consideration by the examiner of applicants' entitlement to claim benefit of priority under 35 U.S.C. § 120 and § 119(e) to the prior-filed international application and provisional applications.

Boris Milef
Legal Examiner
Office of PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 11/160,915 | 07/14/2005 | 3768 | 1890 | 06-426-B | 72 | 4 |

**CONFIRMATION NO. 1914**

**CORRECTED FILING RECEIPT**

20306
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32ND FLOOR
CHICAGO, IL 60606

*OC000000043256022*

Date Mailed: 08/27/2010

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)**

Travis N. Blalock, Charlottesville, VA;
William F. Walker, Barboursville, VA;
John A. Hossack, Charlottesville, VA;

**Assignment For Published Patent Application**

UNIVERSITY OF VIRGINIA PATENT FOUNDATION, Charlottesville, VA

**Power of Attorney:** The patent practitioners associated with Customer Number 020306

**Domestic Priority data as claimed by applicant**

This application is a CON of PCT/US04/00887 01/14/2004
which claims benefit of 60/440,020 01/14/2003
and claims benefit of 60/439,990 01/14/2003
and claims benefit of 60/440,262 01/15/2003

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 08/31/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/160,915**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**** SMALL ENTITY ****

**Title**

ULTRASOUND IMAGING BEAM-FORMER APPARATUS AND METHOD

**Preliminary Class**

600

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

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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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JAN 04 2011
OFFICE OF PETITIONS

WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202

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| In re Patent of Bialecki et al. | : | |
| Patent No. 7,753,877 | : | |
| Issue Date: July 13, 2010 | : | DECISION ON REQUEST |
| Application No. 11/161,551 | : | FOR RECONSIDERATION OF |
| Filing Date: August 8, 2005 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. MDXVA-97US7 | : | |

This is a decision on the petition filed under 37 C.F.R. § 1.705(d) on July 19, 2010, which requests the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by eight hundred twenty-six (826) days.

The request for reconsideration of the patent term adjustment indicated on the patent is **dismissed**.

The instant patent issued on July 13, 2010, with a revised patent term adjustment of 831 days. The petition was timely filed within two months of the issue date of the patent. The petition contends the correct patent term adjustment is 826 days, not 831 days.

Delay Under 37 C.F.R. § 1.703(a) ("A Delay")

The period of A Delay is 588 days and is not in dispute. The period of A Delay consists of:

1. 570 days of delay under 37 C.F.R. § 1.703(a)(1), and
2. 18 days of delay under 37 C.F.R. § 1.703(a)(2).

Delay Under 37 C.F.R. § 1.703(b) ("B Delay")

The application was filed August 8, 2005, and issued as a patent on July 13, 2010.

The number of days beginning August 9, 2008, the day after the date three years after the filing date, and ending July 13, 2010, the date the patent issued, is 704 days.

Pursuant to 37 C.F.R. § 1.703(b)(1), the period of B Delay does not include the period of time consumed by continued examination. Patentees state the number of days to be excluded under

37 C.F.R. § 1.703(b)(1) is 183 days. However, Patentees do not appear to include the actual date the request for continued examination ("RCE") was filed in the period of time to be excluded.

A request for continued examination ("RCE") was filed January 11, 2010, and the patent issued July 13, 2010. The period of time beginning January 11, 2010, and ending July 13, 2010, is 184 days. Therefore, the period of time to be excluded under 37 C.F.R. § 1.703(b)(1) is 184 days, not 183 days.

Pursuant to 37 C.F.R. § 1.702(b)(4), the period of B Delay does not include "[a]ny time consumed by review by the Board of Patent Appeals and Interferences or a Federal court." Patentees state the number of days to be excluded under 37 C.F.R. § 1.703(b)(4) is 57 days. However, Patentees do not appear to include the actual date the notice of appeal was filed in the period of time to be excluded.

A Notice of Appeal was filed December 23, 2008, and the Office issued a non-final Office action on February 18, 2009. The period of time beginning December 23, 2008, and ending February 18, 2009, is 58 days. Therefore, the period of time to be excluded under 37 C.F.R. § 1.703(b)(4) is 58 days, not 57 days.

The correct period of B Delay in this case is 462 days, which is 704 days reduced by 184 days pursuant to 37 C.F.R. § 1.703(b)(1) and reduced 58 days pursuant to 37 C.F.R. § 1.703(b)(1)

## Overlap Between A Delay and B Delay

Pursuant to Office policy, for purposes of determining overlap between A Delay and B Delay, the period of B Delay is the time period beginning October 6, 2008, the day after the date three years and 58 days after the filing date, and ending January 10, 2010, the day before the date the RCE was filed. In other words, any days of A Delay falling within the time period beginning October 6, 2008, and ending January 10, 2010, overlap with the period of B Delay.

The 18-day period of delay under 37 C.F.R. § 1.703(a)(2) includes a 11-day period beginning September 29, 2008, and ending October 16, 2008. Therefore, 11 days of A Delay overlap with the period of B Delay.

## Delay Under 37 C.F.R. § 1.704 ("Applicant Delay")

The period of Applicant Delay is 208 days and is not in dispute.

## Conclusion

The period of A Delay is 588 days.
The period of B Delay is 462 days.
The periods of A Delay and B Delay overlap by 11 days.
The period of Applicant Delay is 208 days.

In view of the facts above, the proper patent term adjustment is 831 days, which is the sum of 588 days of A Delay and 462 days of B Delay reduced by 11 days of overlap and 208 days of Applicant Delay. The patent set forth a patent term adjustment determination of 831 days. Therefore, the patent term adjustment determination set forth on the patent will not be changed.

Submission of the $200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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NOV 09 2010

OFFICE OF PETITIONS

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

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| In re Application of | : | |
| Attieh AL-GHAMDI, et al | : | |
| Application No. 11/161,613 | : | DECISION ON PETITION |
| Filed: August 9, 2005 | : | |
| Docket No. 075-232 | : | |

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed October 22, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, March 9, 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 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 an amendment, (2) the petition fee of $810; and (3) the required statement of unintentional delay.

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

All other inquiries should be directed to the Technology Center at (571) 272-2800.

This application is being referred to Technology Center AU 2828 for appropriate action by the Examiner in the normal course of business.

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

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**STRIKER, STRIKER & STENBY**
**103 EAST NECK ROAD**
**HUNTINGTON NY 11743**

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NOV 15 2010
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| | | |
|---|---|---|
| In re Application of | : | |
| Hans-Peter Miller et al. | : | |
| Application No. 11/161,855 | : | ON PETITION |
| Filed: August 19, 2005 | : | |
| Attorney Docket No. 3444 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 24, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of February 5, 2008. 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 May 6, 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, and the submission required by 37 CFR 1.114; (2) the petition fee; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6842.

This application is being referred to Technology Center AU2831for 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.

Carl Friedman
Petitions Examiner
Office of Petitions

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In re Patent No. 7196371
Issue Date: March 27,2007
Application No. 11161994
Filed: August 25,2005
Attorney Docket No. 15357-US-PA

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

This is a decision on the electronic petition, filed April 6,2012 ,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 April 6,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

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) |
|---|---|---|---|---|
| 7,196,371 | 2007-03-27 | 11/161,994 | 2005-08-25 | LKSP0155USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-06 |
| Name | Winston Hsu | Registration Number | 41526 |

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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BANNER & WITCOFF, LTD
ATTORNEYS FOR CLIENT NUMBER 007131
10 SOUTH WACKER DR.
SUITE 3000
CHICAGO IL 60606

**MAILED**

AUG 06 2010

OFFICE OF PETITIONS

In re Application
Thomas D. Avazian et al.
Application No. 11/162,066
Filed: August 26, 2005
Attorney Docket No. 007131.00063

: 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 filed July 23, 2010. Applicant requests that the determination of patent term adjustment be corrected from 531 to 995 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

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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.

| Issue Classification | Application/Control No. | Applicant(s)/Patent under Reexamination | |
|---|---|---|---|
| | 11/162,142 | KRIKSUNOV ET AL. | |
| | Examiner | Art Unit | |
| | FRANK W. LU | 1634 | |

# ISSUE CLASSIFICATION

| ORIGINAL | | CROSS REFERENCE(S) | | | | | | | |
|---|---|---|---|---|---|---|---|---|---|
| CLASS | SUBCLASS | CLASS | SUBCLASS (ONE SUBCLASS PER BLOCK) | | | | | | |
| 435 | 6 | 435 | 7.1 | 91.1 | 91.2 | 458 | | | |
| INTERNATIONAL CLASSIFICATION | | 424 | 1.29 | | | | | | |
| C 1 2 Q | 1/68 | | | | | | | | |
| G 0 1 N | 33/53 | | | | | | | | |
| C 1 2 P | 19/34 | | | | | | | | |
| C 1 2 N | 15/88 | | | | | | | | |
| A 6 1 K | 51/00 | | | !! | | | | | |

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|---|---|---|
| (Assistant Examiner) (Date) | /Frank W Lu/ 5/23/2011 | Total Claims Allowed: 17 |
| (Legal Instruments Examiner) (Date) | (Primary Examiner) (Date) | O.G. Print Claim(s): 1 / O.G. Print Fig.: 6 |

☐ 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 | 12 | 31 | | 61 | | 91 | | 121 | | 151 | | 181 |
| | 2 | 13 | 32 | | 62 | | 92 | | 122 | | 152 | | 182 |
| | 3 | 14 | 33 | | 63 | | 93 | | 123 | | 153 | | 183 |
| | 4 | 15 | 34 | | 64 | | 94 | | 124 | | 154 | | 184 |
| | 5 | 16 | 35 | | 65 | | 95 | | 125 | | 155 | | 185 |
| | 6 | 17 | 36 | | 66 | | 96 | | 126 | | 156 | | 186 |
| | 7 | | 37 | | 67 | | 97 | | 127 | | 157 | | 187 |
| | 8 | | 38 | | 68 | | 98 | | 128 | | 158 | | 188 |
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| | 15 | | 45 | | 75 | | 105 | | 135 | | 165 | | 195 |
| | 16 | | 46 | | 76 | | 106 | | 136 | | 166 | | 196 |
| | 17 | | 47 | | 77 | | 107 | | 137 | | 167 | | 197 |
| | 18 | | 48 | | 78 | | 108 | | 138 | | 168 | | 198 |
| 1 | 19 | | 49 | | 79 | | 109 | | 139 | | 169 | | 199 |
| 2 | 20 | | 50 | | 80 | | 110 | | 140 | | 170 | | 200 |
| 3 | 21 | | 51 | | 81 | | 111 | | 141 | | 171 | | 201 |
| 4 | 22 | | 52 | | 82 | | 112 | | 142 | | 172 | | 202 |
| 5 | 23 | | 53 | | 83 | | 113 | | 143 | | 173 | | 203 |
| 6 | 24 | | 54 | | 84 | | 114 | | 144 | | 174 | | 204 |
| 7 | 25 | | 55 | | 85 | | 115 | | 145 | | 175 | | 205 |
| 8 | 26 | | 56 | | 86 | | 116 | | 146 | | 176 | | 206 |
| 9 | 27 | | 57 | | 87 | | 117 | | 147 | | 177 | | 207 |
| 10 | 28 | | 58 | | 88 | | 118 | | 148 | | 178 | | 208 |
| | 29 | | 59 | | 89 | | 119 | | 149 | | 179 | | 209 |
| 11 | 30 | | 60 | | 90 | | 120 | | 150 | | 180 | | 210 |

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SCIENTIFIC ATLANTA, A CISCO COMPANY
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

MAILED
MAR 24 2011
OFFICE OF PETITIONS

In re Application of :
William E. Wall et al :
Application No. 11/162,232 :
Filed: September 2, 2005 :
Attorney Docket No. MULTIROOM POINT OF DEPLOYMENT MODULE

ON PETITION

This is a decision on the petition, filed March 23, 2011 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on February 28, 2011 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 2424 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

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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 Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

# UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 7200040
Issue Date: April 3,2007
Application No. 11162365
Filed: September 8,2005
Attorney Docket No. 15354-US-PA

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

This is a decision on the electronic petition, filed April 6,2012 ,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 April 6,2012 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

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) |
|---|---|---|---|---|
| 7,200,040 | 2007-04-03 | 11/162,365 | 2005-09-08 | LKSP0156USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-06 |
| Name | Winston Hsu | Registration Number | 41526 |

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 24 2011
OFFICE OF PETITIONS

**SCHLUMBERGER/BHGL**
**UTAH OFFICE**
**222 SOUTH MAIN STREET**
**SUITE 1930**
**SALT LAKE CITY 84101**

| | | |
|---|---|---|
| In re Patent No. 7,252,174 | : | |
| Issue Date: August 7, 2007 | : | |
| Application No. 11/162,505 | : | NOTICE |
| Filed: September 3, 2005 | : | |
| Attorney Docket No. 85.0039 | : | |

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 C. Goodwyn at (571) 272-6735.

Thurman K. Page
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 07/31/2010. 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: 0370.0752C | |
| Application Number: 11/162,619 | Filing Date (or 371(b) or (f) Date): September 16, 2005 |
| Patent Number: 7,664,139 | Issue Date: February 16, 2010 |
| First Named Inventor: Gilberto Loprieno | |
| Title: Method & Apparatus for Using Stuffing Bytes Over a G.709 Signal to Carry Multiple Streams | |

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 /Thomas J. Frame/ | Date August 4, 2010 |
| Name (Print/Typed) Thomas J. Frame | Registration Number 47,232 |

***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.

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EDELL, SHAPIRO & FINNAN, LLC
1901 RESEARCH BOULEVARD
SUITE 400
ROCKVILLE, MD 20850

Mail Date: 08/11/2010

| | | |
|---|---|---|
| **Applicant** | : Gilberto Loprieno | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7664139 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/162,619 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/16/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1184** 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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**SHOWWAY YEH**
**21845 HERMOSA AVE.**
**CUPERTINO CA 95014**

MAILED
JUN 14 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of<br>Showway Yeh<br>Application No. 11/162,620<br>Filed: September 16, 2005 | :<br>:<br>:<br>:<br>: | DECISION ON PETITION |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 10, 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 Drawing Inconsistency With Specification mailed April 2, 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 May 3, 2010. The Notice of Abandonment was mailed June 16, 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 to the specification, (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 the Office of Data Management for appropriate action by n the reply received.

/Terri Johnson/
Terri Johnson
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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**BENNETT JONES LLP**
**C/O MS ROSEANN CALDWELL**
**4500 BANKERS HALL EAST**
**855-2ND STREET, SW**
**CALGARY AB T2P 4K7 CA CANADA**

MAILED

JAN 31 2011

OFFICE OF PETITIONS

In re Application of :
**GEORGE J. CYMERMAN et al** :
Application No. 11/162,819 : DECISION ON PETITION
Filed: September 23, 2005 :
Attorney Docket No. 53707-108 :

This is a decision on the petition, filed January 28, 2011, under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely reply on or before September 7, 2010, as required by the final rejection mailed June 7, 2010.

Petitioner asserts that the Request for Continued Examination (RCE) was timely filed since extensions of time were filed December 6, 2010 with said RCE. A review of the file records indicates that the RCE and extension of time have now been located and scanned into the file. The Office regrets the error and delay in withdrawing the abandonment.

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 Thurman K. Page at (571) 272-0602.

The application is being forwarded to Technology Center Art Unit 3725 for processing of the RCE and action in its regular turn.

Thurman K. Page
Thurman K. Page
Petitions Examiner
Office of Petitions

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MAILED
JUN 21 2011
OFFICE OF PETITIONS

NUTTER MCCLENNEN & FISH LLP
SEAPORT WEST
155 SEAPORT BOULEVARD
BOSTON MA 02210-2604

In re Application of :
Borgstrom, et al. :
Application No. 11/162,873 : DECISION ON APPLICATION
Filed: September 27, 2005 : FOR PATENT TERM ADJUSTMENT
Attorney Docket No. **101896-0364** :

This is in response to the "Application for Patent Term Adjustment Pursuant to 37 CFR 1.705(b)" filed May 26, 2011. Applicants requests that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from nine one thousand, one hundred and thirty-two (1,132) days to one thousand, eighty-four (1,084) days.

The application for patent term adjustment is **GRANTED.**

The Office has updated the PALM and PAIR screens to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand, eighty-four (1,084) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On March 2, 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 is 1,132 days. On May 26, 2011, applicant submitted the instant petition. Applicant maintains that the patent term adjustment indicated on the Determination of Patent Term Adjustment is incorrect and that the patent term adjustment at the time of the mailing of the Notice of Allowance should be 1,084 days.

Applicants' argument has been considered and is well taken. On November 18, 2010, applicants submitted a supplemental reply or paper in the form of an Information Disclosure Statement (IDS) after filing a reply to the final Office action on October 1,

2010. The record does not support a conclusion that the examiner expressly requested the filing of the IDS. Further, a review of the IDS, filed November 18, 2010, reveals that applicant did not include a statement under 37 CFR 1.704(d).[1] Thus, applicant failed to engage in reasonable efforts to conclude prosecution of the application. Accordingly, the period of adjustment should have been reduced by 48 days pursuant to 37 CFR 1.704(c)(8), counting the number of days beginning on the day after the date the initial reply was filed, October 2, 2010, and ending on the date that the IDS was filed, November 18, 2010. Accordingly, a period of reduction of 48 days is being entered.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is 1,084 days.

The $200.00 fee set forth under 37 CFR 1.18(e) will be charged to deposit account 14-1449.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

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

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[1] Pursuant to 37 CFR § 1.704(d):

> 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.

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

/Kenya A. McLaughlin/

Kenya A. McLaughlin
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*: 11162873 Search | Explanation of PTA Calculation | Explanation of PTE Calculation

## PTA Calculations for Application: 11162873

| | | | |
|---|---|---|---|
| Application Filing Date | 09/27/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 1174 |
| A Delays | 1174 | PTO Manual Adjustment | -48 |
| B Delays | 0 | Applicant Delay (APPL) | 42 |
| C Delays | 0 | Total PTA (days) | 1084 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 103 | 06/13/2011 | | P028 | Adjustment of PTA Calculation by PTO | | 48 | 0 |
| 91 | 03/02/2011 | 02/01/2011 | MN/=. | Mail Notice of Allowance | 29 | | 79 |
| 90 | 02/26/2011 | | IREV | Issue Revision Completed | | | 0 |
| 89 | 02/26/2011 | | DVER | Document Verification | | | 0 |
| 88 | 02/26/2011 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 87 | 02/26/2011 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 86 | 02/25/2011 | | EX.A | Examiner's Amendment Communication | | | 0 |
| 85 | 02/25/2011 | | CNTA | Allowability Notice | | | 0 |
| 84 | 02/25/2011 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 82 | 11/18/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 81 | 11/18/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 80 | 10/05/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 79 | 10/01/2010 | 09/01/2010 | A... | Response after Non-Final Action | | 30 | 70 |
| 78 | 10/01/2010 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 77 | 09/28/2010 | | EML_NTR | Email Notification | | | 0 |
| 76 | 09/28/2010 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 75 | 09/16/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 83 | 07/12/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 74 | 07/12/2010 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 73 | 07/12/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 72 | 06/01/2010 | | ELC_RVW | Electronic Review | | | 0 |
| 71 | 06/01/2010 | | EML_NTF | Email Notification | | | 0 |
| 70 | 06/01/2010 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 69 | 05/24/2010 | | CTNF | Non-Final Rejection | | | 0 |
| 52 | 03/11/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 66 | 02/24/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 54 | 02/24/2010 | | RCAP | Reference capture on IDS | | | 0 |
| 53 | 02/24/2010 | 02/12/2010 | EIDS. | Electronic Information Disclosure Statement | | 12 | 51 |
| 49 | 02/24/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 51 | 02/12/2010 | | ELC. | Response to Election / Restriction Filed | | | 0 |
| 65 | 01/29/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 64 | 01/29/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 50 | 01/29/2010 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 48 | 01/29/2010 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 47 | 01/29/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 46 | 01/29/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 45 | 01/15/2010 | | ELC_RVW | Electronic Review | | | 0 |
| 44 | 01/15/2010 | | EML_NTF | Email Notification | | | 0 |
| 43 | 01/15/2010 | 11/27/2006 | MCTRS | Mail Restriction Requirement | 1145 | | 0.5 |
| 42 | 01/13/2010 | | CTRS | Restriction/Election Requirement | | | 0 |
| 63 | 08/28/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 41 | 08/28/2009 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 38 | 08/28/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 62 | 07/28/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 40 | 07/28/2009 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 37 | 07/28/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 61 | 07/02/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 39 | 07/02/2009 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 36 | 07/02/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 60 | 11/21/2008 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 35 | 11/21/2008 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 34 | 11/21/2008 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 59 | 07/17/2008 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 33 | 07/17/2008 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 32 | 07/17/2008 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |

| | | | | |
|---|---|---|---|---|
| 58 | 01/28/2008 | IDSC | Information Disclosure Statement considered | 0 |
| 31 | 01/28/2008 | RCAP | Reference capture on IDS | 0 |
| 30 | 01/28/2008 | M844 | Information Disclosure Statement (IDS) Filed | 0 |
| 28 | 01/28/2008 | WIDS | Information Disclosure Statement (IDS) Filed | 0 |
| 26 | 12/03/2007 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 57 | 10/24/2007 | IDSC | Information Disclosure Statement considered | 0 |
| 25 | 10/24/2007 | RCAP | Reference capture on IDS | 0 |
| 24 | 10/24/2007 | M844 | Information Disclosure Statement (IDS) Filed | 0 |
| 22 | 10/24/2007 | WIDS | Information Disclosure Statement (IDS) Filed | 0 |
| 21 | 10/17/2007 | W525 | Withdraw Flagged for 5/25 | 0 |
| 20 | 10/16/2007 | F525 | Flagged for 5/25 | 0 |
| 19 | 10/01/2007 | TI1050 | Transfer Inquiry to GAU | 0 |
| 56 | 05/17/2007 | IDSC | Information Disclosure Statement considered | 0 |
| 17 | 05/17/2007 | RCAP | Reference capture on IDS | 0 |
| 16 | 05/17/2007 | EIDS. | Electronic Information Disclosure Statement | 0 |
| 15 | 05/17/2007 | WIDS | Information Disclosure Statement (IDS) Filed | 0 |
| 14 | 03/14/2006 | TSSCOMP | IFW TSS Processing by Tech Center Complete | 0 |
| 55 | 01/03/2006 | IDSC | Information Disclosure Statement considered | 0 |
| 13 | 01/03/2006 | RCAP | Reference capture on IDS | 0 |
| 12.7 | 01/03/2006 | M844 | Information Disclosure Statement (IDS) Filed | 0 |
| 12 | 01/03/2006 | WIDS | Information Disclosure Statement (IDS) Filed | 0 |
| 11 | 12/27/2005 | OIPE | Application Dispatched from OIPE | 0 |
| 10 | 12/27/2005 | COMP | Application Is Now Complete | 0 |
| 9 | 12/14/2005 | FLFEE | Payment of additional filing fee/Preexam | 0 |
| 5 | 12/14/2005 | OATHDECL | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | 0 |
| 4 | 10/11/2005 | INCD | Notice Mailed--Application Incomplete--Filing Date Assigned | 0 |
| 3 | 10/04/2005 | L194 | Cleared by OIPE CSR | 0 |
| 2 | 09/28/2005 | SCAN | IFW Scan & PACR Auto Security Review | 0 |
| 1 | 09/27/2005 | IEXX | Initial Exam Team nn | 0 |
| 0.5 | 09/27/2005 | EFILE | Filing date | 0 |

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/162,879 | 09/27/2005 | Robert P. Morris | I344/US | 3878 |

49277 7590 09/13/2011
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| HARRELL, ROBERT B |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2442 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 09/13/2011 | 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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SEP 13 2011

DIRECTOR OFFICE
TECHNOLOGY CENTER 2400

SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh NC 27607

*In re* Application of: MORRIS
Appl. No.: 11/162879
Filed: September 27, 2005
For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR VERIFYING AN IDENTITY OF A SERVICE REQUESTER USING PRESENCE INFORMATION**

DECISION ON PETITION
UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on August 23, 2011.

The petition is **GRANTED**.

Pursuant to applicant's request filed on August 23, 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of six (6) months. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Chau Nguyen whose telephone number is (571) 272-3126.

/Chau Nguyen/

Chau Nguyen
Quality Assurance Specialist
Technology Center 2400
Network, Multiplexing, Cable and Security

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Jeffrey Clift
571 Wethersfield Place
Melbourne, FL 32940

MAILED
DEC 13 2010
OFFICE OF PETITIONS

In re Application of
Jeffrey C. Clift, et. al.
Application No. 11/162,926
Filed: September 28, 2005
Attorney Docket No. N/A

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181 (no fee), filed August 17, 2010, requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

This application was held abandoned for failure to reply to the nonfinal Office action mailed September 18, 2009, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on June 30, 2010.

Petitioner asserts "A change of address was submitted on April 26, 2007 and stamped as "received" as shown below...Subsequent to this, there was an office action mailed to the original address more than 2 years later that was never received."

A review of the written record discloses that petitioner filed a change of correspondence address on April 26, 2007. However, since the change of correspondence address was signed by one of two inventors, the requested change of correspondence address for the above-identified application was not updated.

37 CFR 1.33(b) states, Amendments and other papers filed in the application must be signed by:

> (1) An attorney or agent of record appointed in compliance with § 1.34(b);
>
> (2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);
>
> (3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest;

> (4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undivided part interest; or
>
> (5) **All of the applicants (§§ 1.42. 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73.**

In view of the above, personnel at the USPTO was correct for not accepting the change of correspondence address submitted on April 26, 2007[1].

Petitioner further argues, "We believe it would have been expected and appropriate to notify us regarding the rejection of the change of address..."

While the undersigned sympathies with petitioner, it should be noted that the Office will attempt to notify applicants of deficiencies in communications filed in the Office to allow for a timely correction; however, the Office has no obligation to notify parties of any deficiencies within a manner to permit a timely correction.

In view of the above, it is strongly recommended that petitioner file a petition to revive under 37 CFR 1.137(b) and pay the petition fee of $810. 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). A blank petition under 37 CFR 1.137(b) is enclosed for petitioner's convenience.

It is noted that a proper change of correspondence address still has not been filed for the application. 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 correspondence address given in change of address filed on April 26, 2007. Thereafter, all future communications from the Office will be mailed solely to the address of record.

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.

---

[1] To complete petitioner's records, a courtesy copy of the Office action mailed September 18, 2009 is enclosed.

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) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Enclosures: Privacy Act Statement
Petition under 37 CFR 1.137(b) – Form No. PTO/SB/64 and
A copy of the nonfinal Office action mailed September 18, 2009

cc: Jeffrey Clift
6381 Portofino Lane
Melbourne, FL 32940

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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**Brown, Winick, Graves, Gross, Baskerville and Schoenebaum, P.L.C**
**666 Grand Ave**
**Suite 2000**
**Des Moines IA 50309**

MAILED

SEP 19 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| John E. Prevost et al. | : | |
| Application No. 11/162,945 | : | DECISION ON PETITION |
| Filed: September 28, 2005 | : | |
| Attorney Docket No. 8482.018 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 12, 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 final Office action mailed, November 18, 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 February 19, 2011. A Notice of Abandonment was mailed on June 22, 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 $810, 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 1651 for appropriate action by the Examiner in the normal course of business on the reply received August 12, 2011.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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) |
|---|---|---|---|---|
| 7,208,796 | 2007-04-24 | 11/163,223 | 2005-10-11 | LKSP0158USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-06 |
| Name | Winston Hsu | Registration Number | 41526 |

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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In re Patent No. 7208796
Issue Date: April 24,2007
Application No. 11163223
Filed: October 11,2005
Attorney Docket No. 15602-US-PA

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

This is a decision on the electronic petition, filed April 6,2012 ,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 April 6,2012 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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Dr. Chung Chang
7 Marlboro RD.
Lexington MA 02421

MAILED
SEP 30 2010
OFFICE OF PETITIONS

In re Application of :
Chung CHANG, et al. :
Application No. 11/163,385 : ON PETITION
Filed: October 17, 2005 :
Attorney Docket No. :

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

The petition is **DISMISSED.**

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

The above-identified application became abandoned for failure to properly submit the issue and publication fee in a timely manner in reply to the Notice of Allowance/Allowability mailed January 11, 2010, which set a statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on April 12, 2010.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding issue fee or any portion thereof; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks items (2) and (3).

The required petition fee of $270 required under 37 CFR 1.17(l) has not been submitted. Only $130 has been submitted. The fee is a requirement of the statutes and cannot be waived. See 35 U.S.C. 41(a)(7). Accordingly, the petition will not be further treated on its merits.

The statement required in item (3) has not been signed by all of the applicants for patent, an assignee of the entire interest and such assignee has taken action in the application in accordance with 37 CFR 3.71, or a patent attorney or patent agent registered to practice before the office.

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

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

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

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

Telephone inquiries concerning this decision should be directed to David Bucci at (571) 272-7099.

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

MAILED

JAN 21 2011

OFFICE OF PETITIONS

**Dr. Chung Chang**
**7 Marlboro Road**
**Lexington, Massachusetts 02421**

| | | |
|---|---|---|
| In re Application of | : | |
| Chung CHANG et al. | : | DECISION GRANTING PETITION |
| Application No. 11/163,385 | : | UNDER 37 CFR 1.137(b) |
| Filed: 17 October 2005 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed 29 November 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to Notice of Allowance/Allowability mailed 11 January 2010("Allowance"), which set a statutory period for reply of three (3) months. The application thus became abandoned on 12 April 2010, and a Notice of Abandonment was mailed 29 April 2010.

The petition satisfies the conditions for revival pursuant to 37 CFR 1.137(b) by including (1) a reply in the form of payments of the Issue Fee ($755.00) and Publication fee ($300), performed on 22 March 2010, (2) a petition fee of $810.00, and (3) a statement of unintentional delay. The reply to the outstanding Office action is accepted as having been unintentionally delayed.

General inquiries relating to this decision should be directed to Robert DeWitty, Petitions Examiner, Office of Petitions (571-272-6051), or, if unavailable, the undersigned at 571-272-7099.

The application file will be referred to the Office of Data Management.

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
www.uspto.gov

Erich A Wilson
906 North 2770 west
Provo, UT 84601

MAILED
FEB 14 2011
OFFICE OF PETITIONS

In re Application of
Wilson
Application No. 11/163,528
Filed: October 21, 2005
For: FLUID FLOW CHANNELS IN BLADELESS COMPRESSORS, TURBINES AND PUMPS

DECISION ON PETITION

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

The petition is **GRANTED**.

This application became abandoned for failure to timely submit a proper reply to the Notice of Non-Compliant Amendment (37 CFR 1.121) mailed on July 18, 2008. The Notice set an extendable one-month reply period of August 18, 2008. An untimely request for extension of time with insufficient fees was submitted on October 8, 2008. A Notice of Abandonment was mailed on January 29, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $810.00, and (3) 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). As such since a request for extension of time and appropriate fee were not timely.

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

This application is being referred to Technology Center AU 3745 for appropriate action by the Examiner in the normal course of business on the reply received

Charlema Grant
Petitions Attorney
Office of Petitions

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Alexandria, VA 22313-1450
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LAW OFFICES OF MIKIO ISHIMARU
333 W. EL CAMINO REAL
SUITE 330
SUNNYVALE CA 94087

**MAILED**

APR 14 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Kim et al | : | |
| Application No. 11/163558 | : | DECISION |
| Filing or 371(c) Date: 10/22/2005 | : | ON PETITION |
| Attorney Docket Number: 27-111 | : | |

This is a decision on the renewed Petition to Revive Patent Application Unintentionally Abandoned Under 37 CFR 1.137(b), filed March 16, 2011, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due, mailed December 15, 2010. The Notice set a non-extendable three (3) month period for reply. No reply having been received, the application became abandoned March 16, 2011.

Applicant files the present renewed petition and the issue and publication fees.

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 and the publication fee; (2) the petition fee; and (3) a proper statement of unintentional delay.

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

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

/DLW/

Derek L. Woods
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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333 W. EL CAMINO REAL
SUITE 330
SUNNYVALE CA 94087

MAILED
APR 18 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kim et al. | : | |
| Application No. 11/163558 | : | ON REQUEST FOR |
| Filing or 371(c) Date: 10/22/2005 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket Number: | : | |
| 27-111 | : | |

This is a decision on the "REQUEST FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed March 16, 2011. Applicants petition for reconsideration of the patent term adjustment calculation to 123 days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction based upon an assertion that the Office erred in calculating an adjustment of 31 days, which led to subsequent errors in calculating the patent term adjustment. The request is properly treated under 37 C.F.R. § 1.705(b).

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 calculating an adjustment of 31 days, which led to subsequent errors in calculating the patent term adjustment, is **GRANTED to the EXTENT INDICATED**.

On December 15, 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 zero (0) days.

On March 16, 2011, applicants timely submitted the instant application for patent term adjustment[1]. Applicants request that the Determination of Patent Term Adjustment be corrected from zero (0) days, as indicated on the Determination of PTA mailed December 15, 2010, to an adjustment of 123 days. Applicants aver that the Office erred in calculating erred in calculating an adjustment of 31, which led to subsequent errors in calculating the patent term adjustment.

As to the assertion that the Office erred in calculating an adjustment of 31, which led to subsequent errors in calculating the patent term adjustment, the Determination of Patent Term

[1] PALM records show that the Issue Fee payment was received in the Office on March 16, 2011.

Adjustment under 35 U.S.C. 154(b) mailed December 15, 2010 indicates a patent term of zero (0) days.

The instant request for reconsideration of patent term adjustment indicates that the Office erred in calculating an adjustment of 31 days in connection with the mailing of a non-final Office action on June 4, 2007, fourteen months and 164 days after the date on which the application was filed. Applicants provide that a Restriction Requirement was mailed December 26, 2007. Applicants filed a response to the Restriction Requirement on January 4, 2008; however, the Office entered the response as having been filed on January 4, 2007, which led to subsequent errors in calculating the patent term adjustment.

A review of a summary of relevant dates attached as Exhibit A filed with the present petition also reveals that Applicants have calculated a reduction of 10 days in connection with the filing of a Request for Continued Examination ("RCE") filed October 5, 2009, in response to a final Office action, mailed June 9, 2009.

Applicants do not contest a reduction of 31 days in connection with the filing of a response to a non-final Office action on October 5, 2007, three months and 31 days after the mailing of the non-final Office action mailed June 4, 2007, as shown on Exhibit A.

As to the assertion that the Office erred in calculating a reduction of 31 days in connection with the mailing of a non-final Office action on June 4, 2007, fourteen months and 164 days after the date on which the application was filed, a review of Office records confirms that the application was filed on October 22, 2005. The Office agrees that the Office failed 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 was filed, and the entry of a period of adjustment of 164 days is appropriate.

As to the reduction in connection with the filing of a RCE, filed October 5, 2009, in response to a final Office action, mailed June 9, 2009, a review of Office records reveals that the RCE was filed on October 4, 2009, in response to the final Office action, mailed June 9, 2009. Pursuant to 37 CFR 1.704(b), a reduction of 25 days, beginning on the day after the date that is three months after the date of mailing of the final Office action, September 10, 2009, and ending on the date the reply was filed, October 4, 2009, was properly assessed applicants.

A further review of Office records confirms that the Office mailed a non-final Office action on December 9, 2009. Applicants filed a response to the Office action on March 10, 2010. Pursuant to 37 CFR 1.704(b), a reduction of one (1) day, beginning on the day after the date that is three months after the date of mailing of the non-final Office action, March 10, 2010, and ending on the date the reply was filed, March 10, 2010, was properly assessed applicants.

In view thereof, the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance is one hundred seven (107) days (adjustment of 164 days less reductions of 57 days), subject to any terminal disclaimer.

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 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

# Patent Term Adjustments

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

Application Number*: 11163558 Search  Explanation of PTA Calculation  Explanation of PTE Calculation

## PTA Calculations for Application: 11163558

| | | | |
|---|---|---|---|
| Application Filing Date | 10/22/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 31 |
| A Delays | 31 | PTO Manual Adjustment | 133 |
| B Delays | 0 | Applicant Delay (APPL) | 57 |
| C Delays | 0 | Total PTA (days) | 107 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 119 | 04/18/2011 | | P02B | Adjustment of PTA Calculation by PTO | 26 | | 0 |
| 118 | 04/18/2011 | | P02B | Adjustment of PTA Calculation by PTO | 107 | | 0 |
| 105 | 12/15/2010 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 104 | 12/14/2010 | | IREV | Issue Revision Completed | | | 0 |
| 103 | 12/14/2010 | | DVER | Document Verification | | | 0 |
| 102 | 12/14/2010 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 101 | 12/14/2010 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 100 | 12/14/2010 | | EX.A | Examiner's Amendment Communication | | | 0 |
| 99 | 12/14/2010 | | CNTA | Allowability Notice | | | 0 |
| 95 | 12/08/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 92 | 12/08/2010 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 94 | 12/07/2010 | | AMPR | RCE- AF Processed | | | 0 |
| 93 | 12/07/2010 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 91 | 12/07/2010 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 90 | 12/02/2010 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 89 | 12/01/2010 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 88 | 11/29/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 87 | 11/24/2010 | | A.NE | Amendment after Final Rejection | | | 0 |
| 86 | 09/20/2010 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 85 | 09/16/2010 | | CTFR | Final Rejection | | | 0 |
| 84 | 09/11/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 81 | 09/11/2010 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 83 | 09/09/2010 | | AMPR | RCE- AF Processed | | | 0 |
| 82 | 09/09/2010 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 80 | 09/09/2010 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 79 | 08/20/2010 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 78 | 08/19/2010 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 77 | 08/17/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 76 | 08/16/2010 | | A.NE | Amendment after Final Rejection | | | 0 |
| 75 | 06/16/2010 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 74 | 06/15/2010 | | CTFR | Final Rejection | | | 0 |
| 72 | 04/01/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 71 | 03/10/2010 | 03/09/2010 | A... | Response after Non-Final Action | | 1 | 70 |
| 70 | 12/09/2009 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 69 | 12/07/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 68 | 10/09/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 66 | 10/09/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 64 | 10/09/2009 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 67 | 10/04/2009 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 65 | 10/04/2009 | 09/09/2009 | RCEX | Request for Continued Examination (RCE) | | 25 | 56 |
| 63 | 10/04/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 62 | 10/04/2009 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 61 | 09/25/2009 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 60 | 09/24/2009 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 58 | 08/10/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 57 | 08/07/2009 | | A.NE | Amendment after Final Rejection | | | 0 |
| 56 | 06/09/2009 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 55 | 06/08/2009 | | CTFR | Final Rejection | | | 0 |
| 54 | 04/03/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 53 | 03/19/2009 | | A... | Response after Non-Final Action | | | 0 |
| 52 | 12/19/2008 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 51 | 12/18/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 46 | 11/18/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 44 | 11/18/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 42 | 11/18/2008 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 45 | 11/12/2008 | | AMPR | RCE- AF Processed | | | 0 |
| 43 | 11/12/2008 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 41 | 11/12/2008 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 40 | 10/31/2008 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 39 | 10/29/2008 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 38 | 10/24/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 37 | 10/15/2008 | | A.NE | Amendment after Final Rejection | | | 0 |
| 36 | 08/15/2008 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 35 | 08/14/2008 | | CTFR | Final Rejection | | | 0 |
| 34 | 06/04/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 33 | 05/07/2008 | | A... | Response after Non-Final Action | | | 0 |
| 32 | 02/07/2008 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 31 | 01/30/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 28 | 01/22/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 26 | 12/26/2007 | | MCTRS | Mail Restriction Requirement | | | 0 |
| 25 | 12/20/2007 | | CTRS | Restriction/Election Requirement | | | 0 |
| 23 | 10/12/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 24 | 10/05/2007 | | C602 | Oath or Declaration Filed (Including Supplemental) | | | 0 |
| 22 | 10/05/2007 | 09/04/2007 | A... | Response after Non-Final Action | | 31 | 17 |
| 21 | 10/05/2007 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 20 | 09/26/2007 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 19 | 09/20/2007 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 18 | 07/30/2007 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 17 | 06/04/2007 | 05/04/2007 | MCTNF | Mail Non-Final Rejection | 31 | | 27 |
| 16 | 05/29/2007 | | CTNF | Non-Final Rejection | | | 0 |
| 15 | 04/26/2007 | | PG-ISSUE | PG-Pub Issue Notification | | | 0 |
| 13 | 03/22/2007 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 27 | 01/04/2007 | | ELC. | Response to Election / Restriction Filed | | | 0 |
| 12 | 11/14/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 11 | 02/11/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 10 | 11/28/2005 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 8 | 11/18/2005 | | WROIPE | Application Return from OIPE | | | 0 |
| 7 | 11/18/2005 | | COMP | Application Is Now Complete | | | 0 |
| 6 | 11/18/2005 | | ROIPE | Application Return TO OIPE | | | 0 |
| 5 | 11/18/2005 | | OIPE | Application Dispatched from OIPE | | | 0 |
| 4 | 11/18/2005 | | COMP | Application Is Now Complete | | | 0 |
| 3 | 11/14/2005 | | L194 | Cleared by OIPE CSR | | | 0 |
| 2 | 11/09/2005 | | SCAN | IFW Scan & PACR Auto Security Review | | | 0 |
| 14 | 10/22/2005 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 9.7 | 10/22/2005 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 9 | 10/22/2005 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 1 | 10/22/2005 | | IEXX | Initial Exam Team nn | | | 0 |
| 0.5 | 10/22/2005 | | EFILE | Filing date | | | 0 |

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United States Patent and Trademark Office
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In re Patent No. 7262096
Issue Date: August 28,2007
Application No. 11163818
Filed: October 31,2005
Attorney Docket No. 12090-US-PA-1

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

This is a decision on the electronic petition, filed September 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 September 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.

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) |
|---|---|---|---|---|
| 7,262,096 | 2007-08-28 | 11/163,818 | 2005-10-31 | LKSP0079USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2011-09-23 |
| Name | Winston Hsu | Registration Number | 41526 |

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
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Alexandria, VA 22313-1450
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MAR 26 2012
OFFICE OF PETITIONS

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

| | | |
|---|---|---|
| In re Application of | : | |
| Ludwig et al. | : | DECISION ON REQUEST |
| Patent Number: 8,075,591 | : | FOR RECONSIDERATION OF |
| Issue Date: 12/13/2011 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/163963 | : | and |
| Filing or 371(c) Date: 11/04/2005 | : | NOTICE OF INTENT TO ISSUE |
| Attorney Docket Number: 007131.00306 | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on February 13, 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 eight hundred seventy-seven (877) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by eight hundred seventy-seven (877) days is **GRANTED**.

Regarding Applicant's request for a refund, Applicant is advised that the fee is a prerequisite prior to treatment on the merits of any application for patent term adjustment. 35 U.S.C. 41(d) authorizes the Office to establish a fee to recover the estimated average cost of treating applications for patent term adjustment (as well as a fee for treating a request for reinstatement of patent term adjustment), and the cost of treating an application for patent term adjustment is about the same regardless of whether the Office's initial determination of patent term adjustment indicated in the notice of allowance is correct. Even when the application for patent term adjustment is correct, refunding the fee would require the Office to raise the fee set forth in § 1.18(e) (to enable the Office to recover the same aggregate amount); and (2) add further complication to a review process that must take place in a limited period of time. The request for a refund is, therefore, dismissed. See, Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 56,366, 53,374 (September 18, 2000), 1239 Off. Gaz. Pat. Office 14 (October 3, 2000).

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

The application is being forwarded to the Certificate of 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 **eight hundred seventy-seven (877) 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 : 8,075,591 B2

DATED : **December 13, 2011**

INVENTOR(S) : Ludwig 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 809 days.

Delete the phrase "by 809 days" and insert – by 877 days--

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

FORD GLOBAL TECHNOLOGIES, LLC
FAIRLANE PLAZA SOUTH, SUITE 800
330 TOWN CENTER DRIVE
DEARBORN, MI 48126

Mail Date: 09/14/2010

| | | |
|---|---|---|
| **Applicant** | : Bernd Steiner | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7654238 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/163,975 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/04/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **729** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. 7268055
Issue Date: September 11,2007
Application No. 11163980
Filed: November 7,2005
Attorney Docket No. 16007-US-PA

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

This is a decision on the electronic petition, filed September 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 September 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.

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) |
|---|---|---|---|---|
| 7,268,055 | 2007-09-11 | 11/163,980 | 2005-11-07 | LKSP0081USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2011-09-23 |
| Name | Winston Hsu | Registration Number | 41526 |

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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In re Patent No. 7102193
Issue Date: September 5,2006
Application No. 11164063
Filed: November 9,2005
Attorney Docket No. 16319-US-PA

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

This is a decision on the electronic petition, filed April 9,2012 ,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 April 9,2012 .
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) |
|---|---|---|---|---|
| 7,102,193 | 2006-09-05 | 11/164,063 | 2005-11-09 | LKSP0136USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-09 |
| Name | Winston Hsu | Registration Number | 41526 |

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

# Privacy Act Statement

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1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP**
**600 GALLERIA PARKWAY, S.E.**
**STE 1500**
**ATLANTA, GA 30339-5994**

MAILED

NOV 02 2010

OFFICE OF PETITIONS

In re Application of :
Chou et al. :
Application No. 11/164,065 : DECISION ON PETITION
Filed: November 9, 2005 :
Attorney Docket No. 251812-1840 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 11, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to file a reply within the meaning of 37 CFR 1.113 to the final Office action of February 2, 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). 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 May 3, 2010. A Notice of Abandonment was mailed September 16, 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 of $540 and Appeal Brief and fee of $540, (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) 272-6059.

This application is being referred to Technology Center 2611 for further examination on the merits.

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) |
|---|---|---|---|---|
| 7,226,851 | 2007-06-05 | 11/164,134 | 2005-11-11 | LKSP0161USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-09 |
| Name | Winston Hsu | Registration Number | 41526 |

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

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 7226851
Issue Date: June 5,2007
Application No. 11164134
Filed: November 11,2005
Attorney Docket No. 16117-US-PA

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

This is a decision on the electronic petition, filed April 9,2012 ,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 April 9,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**DANIEL B. SCHEIN, PH.D., ESQ., INC.**
**P. O. BOX 68128**
**Virginia Beach VA 23471**

MAILED

AUG 10 2011

OFFICE OF PETITIONS

In re Application of :
Shamika Abhijit Gune :
Application No. 11/164,163 :
Filed: January 20, 2006 :
Attorney Docket No. 12014-2 :

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 25, 2011, 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 non-final Office action mailed April 26, 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 July 27, 2010. A Notice of Abandonment was mailed on January 6, 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 $810, 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 1782 for appropriate action by the Examiner in the normal course of business on the reply received July 25, 2011.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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) |
|---|---|---|---|---|
| 7,148,107 | 2006-12-12 | 11/164,211 | 2005-11-15 | LKSP0143USA |

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 | /Winston Hsu/ | Date (YYYY-MM-DD) | 2012-04-03 |
| Name | Winston Hsu | Registration Number | 41526 |

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

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. 7148107
Issue Date: December 12,2006
Application No. 11164211
Filed: November 15,2005
Attorney Docket No. 16315-US-PA

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

This is a decision on the electronic petition, filed April 3,2012 ,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 April 3,2012 . 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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MAR 10 2011

OFFICE OF PETITIONS

APEX JURIS, PLLC
12733 LAKE CITY WAY NORTHEAST
SEATTLE, WA 98125

In re Application of
Marty L.Williams
Application No. 11/164,732
Filed: December 2, 2005
Attorney Docket No.: 10.18.09.USP

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 25, 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 mailed August 21, 2009. A Notice of Abandonment was mailed on March 4, 2010. On January 25, 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 a Request for Continued Examination (RCE), including the fee of $405 and the submission required by 37 CFR 1.114; (2) the petition fee of $810; and (3) an adequate statement of unintentional delay[1].

Extensions of time under 37 CFR 1.136 are available only if asked for prior to or within the response period set by statute. In no case, however, may an applicant respond later than the maximum time period set by statute. The extension of time submitted January 25, 2011 was filed when the provisions of 37 CFR 1.136 could no longer be used. Therefore, this application became abandoned when the unextended time for response had expired. Since no extension of time fees are due on a petition for revival, the $555 extension fees submitted after abandonment are being credited to counsel's credit card.

[1] 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. While 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, 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 is being referred to Technology Center AU 1655 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) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

/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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**INTERNATIONAL BUSINESS MACHINES CORPORATION**
**DEPT 18G**
**Bbldg 321-482**
**2070 ROUTE 52**
**HOPEWELL JUNCTION NY 12533**

MAILED
AUG 25 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jeffrey P. Gifford et al | : | |
| Application No. 11/164,793 | : | DECISION ON PETITION |
| Filed: December 6, 2005 | : | |
| Attorney Docket No. FIS920050302US1 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 27, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal Office action mailed March 19, 2009, 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 3652 for appropriate action by the Examiner in the normal course of business on the reply received May 27, 2010.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

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SEP 28 2010

OFFICE OF PETITIONS

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI, L.L.P.
20333 SH 249 6th Floor
HOUSTON TX 77070

| | | |
|---|---|---|
| In re Patent No. 7,720,567 | : | DECISION ON REQUEST |
| Doke et al. | : | FOR |
| Issue Date: May 18, 2010 | : | RECONSIDERATION OF |
| Application No. 11/164,909 | : | PATENT TERM ADJUSTMENT |
| Filed: December 9, 2005 | : | and |
| Atty Docket No. 642-0002US | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition which is being treated as a petition pursuant to 37 C.F.R. § 1.705(d), filed on June 14, 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 six hundred and ninety-seven (697) 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 and fifty-six (556) days is **GRANTED to the extent indicated herein**.

Patentee has indicated that this patent is not subject to a terminal disclaimer.[1]

This patent issued on May 18, 2010, with a patent term adjustment of 602 days.

The Office has determined that the patent term adjustment for the above-identified patent is **556 days**.

[1] Petition, page 2.

The Office agrees with Patentee that this patent issued three years and 525 days after the filing of the application. However, the B-delay does not total 525 days. A notice of appeal was filed on August 11, 2009, and a notice of allowance was mailed on December 29, 2009. The 141 days of the over three year period consumed by appellate review, beginning on August 11, 2009 and ending on December 29, 2009, is not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii).

Furthermore, two periods of examination delay which overlap with the over three year period are not included in the B-delay.

Pursuant to 37 C.F.R. § 1.703(a)(2), the following will result in an adjustment to the patent term:

> The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

A response to a non-final office action was received on November 14, 2008, and a final office action was mailed four months and 58 days later on May 11, 2009. Thus, a 58-day reduction is warranted, pursuant to 37 C.F.R. § 1.703(a)(2). It is noted that this 58-day adjustment was not included in the Office calculations (line 61).

Similarly, a notice of appeal was received on August 11, 2009, and a notice of allowance was mailed four months and 18 days later on December 29, 2009. Thus, an 18-day reduction is warranted, pursuant to 37 C.F.R. § 1.703(a)(2). It is noted that this 18-day adjustment was not included in the PAIR calculations (line 73).

Therefore, the period of examination delay totals 415 (322 + 17 + 58 + 18) days, not 339 days.

It follows that the period of B-delay totals 308 (525 minus 141 days that are excluded minus 76 (58 + 18) days of overlap) days, not 525 days.

The Office agrees with Patentee that the period of applicant delay totals 167 days.

As such, the patent term adjustment is increased by 556 (415 days of examination delay plus 308 "B-delay" minus 167 days of Applicant delay) days, not 697 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 **five hundred and fifty-six (556) 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 : 7,720,567 B2

DATED : **May 18, 2010** **DRAFT**

INVENTOR(S) : Doke 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 602 days

Delete the phrase "by 602 days" and insert – by 556 days--

# UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/164,987 | 12/13/2005 | Robert P. Morris | I371/US | 5986 |

49277 7590 03/08/2011
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| GREGG, MARY M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3694 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/08/2011 | 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAR - 8 2011

Scenera Research, LLC
5400 Trinty Road
Suite 303
Raleigh, NC 27607

| | | |
|---|---|---|
| In re application of | : | **DECISION ON PETITION** |
| Robert P. Morris | : | **FOR SECOND SUSPENSION** |
| Application No. 11/164,987 | : | **OF ACTION UNDER** |
| Filed: December 13, 2005 | : | **37 CFR 1.103 (a)** |
| For: METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR AUTHORIZING A SERVICE REQUEST BASED ON ACCOUNT-HOLDER-CONFIGURED AUTHORIZATION RULES | | |

This letter is responsive to the petition for a second suspension of action under 37 CFR 1.103(a) received on November 2, 2010.

The petition for suspension of action under 37 CFR 1.103(a) is **GRANTED**.

A grantable petition for suspension of action under 37 CFR 1.103(a) requires:

1) A showing of good and sufficient cause for suspension of action, and
2) The fee set forth in 37 CFR 1.17(g), unless such cause is the fault of the Office.

Applicant filed a petition on March 9, 2010, to suspend action by the examiner until a challenge to the petitioner's ownership of the subject matter of this application could be decided. A decision granting a 6 month suspension was mailed May 11, 2010. In the latest petition filed November 2, 2010, the applicant requests an additional 6 month suspension "to allow time for the court to consider the Petitioner's declaratory judgment claim".

There being ongoing litigation to decide the petitioner's ownership of the subject matter of this application, it is deemed that this constitutes a good and sufficient reason why a second suspension should be granted, and thus applicants' request for an additional period of suspension is reasonable and will be **GRANTED**. However, in order to correspond with other requests for suspension filed in other applications by this applicant on similar grounds, the request is granted for a period of three (3) months.

Action by the Office on this application is suspended under 37 CFR 1.103(a) for a period of three (3) months from the date of this letter. At the end of this period applicant is required to notify the examiner and request commencement of prosecution or a further suspension. See MPEP 709. If applicant wishes to commence prosecution earlier than the expiration of the 3 month period, the examiner should be so notified.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

The period for suspension will be three (3) months from the date of this letter.

Any questions surrounding this decision should be directed to Quality Assurance Specialist Steven Meyers at (571) 272-6611.

Wynn Coggins, Director
Technology Center 3600
(571) 272-5350

snm: 3/7/11

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MAR 14 2011

SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh NC 27607

| | | |
|---|---|---|
| In re Application of | : | |
| Robert P. Morris | : | SUA SPONTE DECISION |
| Application No. 11/164,987 | : | ON VACATING OFFICE |
| Filed: December 13, 2005 | : | ACTION |
| Attorney Docket No.: I371US | : | |
| For: Methods, Systems, and Computer program products for authorizing a service request based on account-holder-configured authorization rules | | |

A sua sponte decision of the above-noted application file is being provided. It has been determined that certain errors on the part of the Office have occurred. In particular, it has been determined that the office action mailed February 17, 2011 was mailed in error. The purpose of this communication is to correct this error and clarify the record.

A review of the record reveals that a second letter requesting suspension of action was filed on November 2, 2010. Therefore, the Office action mailed February 17, 2011 should not have been mailed and is hereby VACATED. A decision on the second letter requesting suspension of action will be made shortly.

Wynn Coggins, Director
Technology Center 3600
(571) 272-5350

Jt/snm: 3/10/11

SM

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/164,987 | 12/13/2005 | Robert P. Morris | I371/US | 5986 |

49277 7590 06/23/2011
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| GREGG, MARY M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3694 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/23/2011 | 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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JUN 2 3 2011

Scenera Research, LLC
5400 Trinty Road
Suite 303
Raleigh, NC 27607

| | | |
|---|---|---|
| In re application of | : | **DECISION ON PETITION** |
| Robert P. Morris | : | **FOR SECOND SUSPENSION** |
| Application No. 11/164,987 | : | **OF ACTION UNDER** |
| Filed: December 13, 2005 | : | **37 CFR 1.103 (a)** |

For: METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR AUTHORIZING A SERVICE REQUEST BASED ON ACCOUNT-HOLDER-CONFIGURED AUTHORIZATION RULES

This letter is responsive to the petition for a third suspension of action under 37 CFR 1.103(a) received on June 9, 2011.

The petition for suspension of action under 37 CFR 1.103(a) is **GRANTED**.

A grantable petition for suspension of action under 37 CFR 1.103(a) requires:

1) A showing of good and sufficient cause for suspension of action, and
2) The fee set forth in 37 CFR 1.17(g), unless such cause is the fault of the Office.

Applicant filed a petition on November 2, 2010, to suspend action by the examiner until a challenge to the petitioner's ownership of the subject matter of this application could be decided. A decision granting a 3 month suspension was mailed March 8, 2011. In the latest petition filed June 9, 2011, the applicant requests an additional 6 month suspension "to allow time for the court to consider the Petitioner's declaratory judgment claim".

There being ongoing litigation to decide the petitioner's ownership of the subject matter of this application, it is deemed that this constitutes a good and sufficient reason why a second suspension should be granted, and thus applicants' request for an additional period of suspension is reasonable and will be **GRANTED**. However, in order to correspond with other requests for suspension filed in other applications by this applicant on similar grounds, the request is granted for a period of three (3) months.

Action by the Office on this application is suspended under 37 CFR 1.103(a) for a period of three (3) months from the date of this letter. At the end of this period applicant is required to notify the examiner and request commencement of prosecution or a further suspension. See MPEP 709. If applicant wishes to commence prosecution earlier than the expiration of the 3 month period, the examiner should be so notified.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

The period for suspension will be three (3) months from the date of this letter.

Any questions surrounding this decision should be directed to Quality Assurance Specialist Steven Meyers at (571) 272-6611.

Wynn Coggins, Director
Technology Center 3600
(571) 272-5350

snm: 6/17/11

SM

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/164,987 | 12/13/2005 | Robert P. Morris | I371/US | 5986 |

49277 7590 09/29/2011
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| GREGG, MARY M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3694 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 09/29/2011 | 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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SEP 2 9 2011

Scenera Research, LLC
5400 Trinty Road
Suite 303
Raleigh, NC 27607

| | | |
|---|---|---|
| In re application of<br>Robert P. Morris<br>Application No. 11/164,987<br>Filed: December 13, 2005<br>For: METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR AUTHORIZING A SERVICE REQUEST BASED ON ACCOUNT-HOLDER-CONFIGURED AUTHORIZATION RULES | :<br>:<br>:<br>: | **DECISION ON PETITION FOR SECOND SUSPENSION OF ACTION UNDER 37 CFR 1.103 (a)** |

This letter is responsive to the petition for a third suspension of action under 37 CFR 1.103(a) received on September 22, 2011.

The petition for suspension of action under 37 CFR 1.103(a) is **GRANTED**.

A grantable petition for suspension of action under 37 CFR 1.103(a) requires:

1) A showing of good and sufficient cause for suspension of action, and
2) The fee set forth in 37 CFR 1.17(g), unless such cause is the fault of the Office.

Applicant filed the first in a series of petitions on November 2, 2010, to suspend action by the examiner until a challenge to the petitioner's ownership of the subject matter of this application could be decided. A decision granting a 3 month suspension was mailed March 8, 2011. In the latest petition filed September 22, 2011, the applicant requests an additional 6 month suspension "to allow time for the court to consider the Petitioner's declaratory judgment claim".

There being ongoing litigation to decide the petitioner's ownership of the subject matter of this application, it is deemed that this constitutes a good and sufficient reason why a second suspension should be granted, and thus applicants' request for an additional period of suspension is reasonable and will be **GRANTED**. However, in order to correspond with other requests for suspension filed in other applications by this applicant on similar grounds, the request is granted for a period of three (3) months.

Action by the Office on this application is suspended under 37 CFR 1.103(a) for a period of three (3) months from the date of this letter. At the end of this period applicant is required to notify the examiner and request commencement of prosecution or a further suspension. See MPEP 709. If applicant wishes to commence prosecution earlier than the expiration of the 3 month period, the examiner should be so notified.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

The period for suspension will be three (3) months from the date of this letter.

Any questions surrounding this decision should be directed to Quality Assurance Specialist Steven Meyers at (571) 272-6611.

Wynn Coggins, Director
Technology Center 3600
(571) 272-5350

snm: 9/26/11

SM

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/164,987 | 12/13/2005 | Robert P. Morris | I371/US | 5986 |

49277 7590 01/04/2012
SCENERA RESEARCH, LLC
5400 Trinity Road
Suite 303
Raleigh, NC 27607

| EXAMINER |
|---|
| GREGG, MARY M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3694 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/04/2012 | 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 - 4 2012

Scenera Research, LLC
5400 Trinty Road
Suite 303
Raleigh, NC 27607

| | | |
|---|---|---|
| In re application of | : | **DECISION ON PETITION** |
| Robert P. Morris | : | **FOR SECOND SUSPENSION** |
| Application No. 11/164,987 | : | **OF ACTION UNDER** |
| Filed: December 13, 2005 | : | **37 CFR 1.103 (a)** |

For: METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR AUTHORIZING A SERVICE REQUEST BASED ON ACCOUNT-HOLDER-CONFIGURED AUTHORIZATION RULES

This letter is responsive to the petition for a fifth suspension of action under 37 CFR 1.103(a) received on December 21, 2011.

The petition for suspension of action under 37 CFR 1.103(a) is **GRANTED**.

A grantable petition for suspension of action under 37 CFR 1.103(a) requires:

1) A showing of good and sufficient cause for suspension of action, and
2) The fee set forth in 37 CFR 1.17(g), unless such cause is the fault of the Office.

Applicant filed the first in a series of petitions on November 2, 2010, to suspend action by the examiner until a challenge to the petitioner's ownership of the subject matter of this application could be decided. Formal decisions granting a 3 month suspension were mailed March 8, 2011, June 23, 2011 and September 29, 2011. In the latest petition filed December 21, 2011, the applicant requests an additional 6 month suspension "to allow time for the court to address the issues raised regarding ownership".

There being ongoing litigation to decide the petitioner's ownership of the subject matter of this application, it is deemed that this constitutes a good and sufficient reason why a second suspension should be granted, and thus applicants' request for an additional period of suspension is reasonable and will be **GRANTED**. However, in order to

correspond with other requests for suspension filed in other applications by this applicant on similar grounds, the request is granted for a period of three (3) months.

Action by the Office on this application is suspended under 37 CFR 1.103(a) for a period of three (3) months from the date of this letter. At the end of this period applicant is required to notify the examiner and request commencement of prosecution or a further suspension. See MPEP 709. If applicant wishes to commence prosecution earlier than the expiration of the 3 month period, the examiner should be so notified.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

The period for suspension will be three (3) months from the date of this letter.

Any questions surrounding this decision should be directed to Quality Assurance Specialist Steven Meyers at (571) 272-6611.

Wynn Coggins, Director
Technology Center 3600
(571) 272-5350

snm: 12/23/11

SM

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : May 3, 2011

TO SPE OF : ART UNIT 2191

SUBJECT : Request for Certificate of Correction for Appl. No. 11/165004 patent No.:7853934B2

C of C mailroom date:--04-29-11

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

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

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

**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:** _____

SPE

2191

Art Unit

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**FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP**
**901 NEW YORK AVENUE, NW**
**WASHINGTON DC 20001-4413**

MAILED
OCT 15 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Steffen Gutmann, et al. | : | |
| Application No. 11/165,047 | : | DECISION GRANTING PETITION |
| Filed: June 24, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 09812.0007-00000 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, October 12, 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 17, 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 Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 3664 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Terri Johnson/
Terri Johnson
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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MARY ELIZABETH BUSH
QUALLION LLC
P.O. BOX 923127
SYLMAR CA 91392-3127

**MAILED**

SEP 08 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of<br>Manabu Tanaka, et al.<br>Application No. 11/165,406<br>Filed: June 22, 2005<br>Attorney Docket No. Q232-US1 | :<br>:<br>:<br>:<br>: | DECISION ON PETITION |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 1, 2010, 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 reply within the meaning of 37 CFR 1.113 to the final Office action of November 5, 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 (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). *See* MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does not *prima facie* place the application in condition for allowance, 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 Advisory Action***.

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

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. Beach 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. Beach desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

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

By Mail: Mail Stop PETITION
Commissioner for Patents
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) 272-3213.

Cheryl Gibson-Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

Enclosure: Advisory Action

| Advisory Action Before the Filing of an Appeal Brief | Application No. 11/165,406 | Applicant(s) TANAKA ET AL. | |
|---|---|---|---|
| | Examiner /Laura S. Weiner/ | Art Unit 1795 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 01 July 2010 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 6 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: ___.

/Laura S Weiner/
Primary Examiner
Art Unit: 1795

Continuation of 11. does NOT place the application in condition for allowance because: the amendment after final filed 7-1-2010 fails to overcome all rejections cited in the final office action filed 11-5-09 and therefore does not put the case in condition for allowance.

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MARY ELIZABETH BUSH
QUALLION LLC
P.O. BOX 923127
SYLMAR CA 91392-3127

MAILED
JAN 11 2011
OFFICE OF PETITIONS

In re Application of
Manabu Tanaka, et al.
Application No. 11/165,406
Filed: June 22, 2005
Attorney Docket No. Q232-US1

DECISION ON PETITION

This is a renewed decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 28, 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, mailed November 5, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned at midnight February 5, 2010.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3213.

This application is being referred to Technology Center AU 1795 for processing of the RCE in accordance with 37 CFR 1.114.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

Receipt date: 07/20/2010 APPROVED: /Y.F./ 11165615 - GAU: 2858

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 2858

| | | |
|---|---|---|
| Appl. No. | : | 11/165,615 |
| Confirmation No. | : | 3822 |
| Applicant | : | Todd W. Johnson, et al. |
| Filed | : | June 22, 2005 |
| Title | : | Battery Pack |
| TC/A.U. | : | 2858 |
| Examiner | : | Fantu, Yalkew |
| U.S. Patent No. | : | 7,714,538 |
| Issued | : | May 11, 2010 |

**REQUEST FOR CERTIFICATE OF CORRECTION**

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

Sir:

It is hereby requested that a Certificate of Correction be issued with respect to Patent No. 7,714,538, granted May 11, 2010, in accordance with the Certificate of Correction form attached hereto.

The front page of the '538 patent was printed without a complete listing of the associated priority applications. The missing information is provided on the Certificate of Correction form. These errors were incurred through the fault of the Office as will be disclosed by the records of files in the Office.

No fees are believed due in connection with this submission. However, in the event fees are due, please charge Deposit Account 13-3080.

Respectfully submitted,

/carlo m. cotrone/

Carlo M. Cotrone
Reg. No. 48,715

Attorney Docket No. 066042-9690-00

Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Suite 3300
Milwaukee, Wisconsin 53202-4108
414.271.6560

Approved for use through 08/31/2010. 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.

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

PATENT NO: 7,714,538 Page 1 of 2

APPLICATION NO: 11/165,615

ISSUE DATE May 11, 2010

INVENTOR: Todd W. Johnson, et al

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

(60) Related U.S. Application Data should be supplemented to also list the following:

Continuation-in-part of application No. 11/139,020, filed May 24, 2005, now U.S. Patent No. 7,425,816
which claims benefit of 60/574,278, filed May 24, 2004
and claims benefit of 60/574,616, filed May 25, 2004
and claims benefit of 60/582,138, filed Jun 22, 2004
and claims benefit of 60/582,728, filed on Jun 24, 2004
and claims benefit of 60/582,730, filed Jun 24, 2004
and claims benefit of 60/612,352, filed Sep 22, 2004
and claims benefit of 60/626,013, filed Nov 5, 2004
and claims benefit of 60/626,230, filed Nov 9, 2004
and claims benefit of 60/643,396, filed Jan 12, 2005;
Continuation-in-part of application No. 11/138,070, filed May 24, 2005, now U.S. Patent No. 7,589,500
which claims benefit of 60/574,278, filed May 24, 2004
and claims benefit of 60/574,616, filed May 25, 2004
and claims benefit of 60/582,138, filed Jun 22, 2004
and claims benefit of 60/582,728, filed Jun 24, 2004
and claims benefit of 60/582,730, filed Jun 24, 2004
and claims benefit of 60/612,352, filed Sep 22, 2004
and claims benefit of 60/626,013, filed Nov 5, 2004
and claims benefit of 60/626,230, filed Nov 9, 2004
and claims benefit of 60/643,396, filed Jan 12, 2005;
Continuation-in-part of application No. 10/721,800, filed Nov 24, 2003, now U.S. Patent No. 7,253,585
which claims benefit of 60/428,356, filed Nov 22, 2002
and claims benefit of 60/428,358, filed Nov 22, 2002
and claims benefit of 60/428,450, filed Nov 22, 2002
and claims benefit of 60/428,452, filed Nov 22, 2002
and claims benefit of 60/440,692, filed Jan 17, 2003
and claims benefit of 60/440,693, filed Jan 17, 2003
and claims benefit of 60/523,712, filed Nov 19, 2003
and claims benefit of 60/523,716, filed Nov 19, 2003;

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. 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 1.14. This collection is estimated to take 1.0 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. **SEND TO: Attention Certificate of Corrections Branch, 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.

Continuation-in-part of application No. 10/719,680, filed Nov 20, 2003, now U.S. Patent No. 7,176,654
which claims benefit of 60/428,358, filed Nov 22, 2002
and claims benefit of 60/428,450, filed Nov 22, 2002
and claims benefit of 60/428,452, filed Nov 22, 2002
and claims benefit of 60/440,692, filed Jan 17, 2003
and claims benefit of 60/440,693, filed Jan 17, 2003
and claims benefit of 60/523,716, filed Nov 19, 2003
and claims benefit of 60/523,712, filed Nov 19, 2003; and
Continuation-in-part of application No. 10/720,027, filed Nov 20, 2003, now U.S. Patent No. 7,157,882
which claims benefit of 60/428,358, filed Nov 22, 2002
and claims benefit of 60/428,450, filed Nov 22, 2002
and claims benefit of 60/428,452, filed Nov 22, 2002
and claims benefit of 60/440,692, filed Jan 17, 2003
and claims benefit of 60/440,693, filed Jan 17, 2003
and claims benefit of 60/523,716, filed Nov 19, 2003
and claims benefit of 60/523,712, filed Nov 19, 2003.

MAILING ADDRESS OF SENDER:
Carlo M. Cotrone
Michael Best & Friedrich LLP
100 East Wisconsin Avenue, Suite 3300
Milwaukee, WI 53202-4108

PATENT NO. 7,714,538

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 8/3/10 Paper No.: 7

TO SPE OF : ART UNIT 2858

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/165615 Patent No.: 7714538 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:** The requested changes/corrections as shown in the attached certificate of correction have been reviewed to include all changes.

/Patrick Assouad/ SPE AU2858 8/23/10

RECEIVED
CENTRAL FAX CENTER
MAR 2 1 2011

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/18/11

TO SPE OF : ART UNIT 2614 11/165624 T.W.

SUBJECT : Request for Certificate of Correction for Appl. No.: 11165264 Patent No.: 7729303

CofC mailroom date: 03/10/11

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**
**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 : Ahmad Matar Art unit: 2614



PAGE 1/1 * RCVD AT 3/21/2011 2:44:10 PM [Eastern Daylight Time] * SVR:W-PTOFAX-001/18 * DNIS:2709990 * CSID:703 308 5403 * DURATION (mm-ss):00-56

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450

MAILED

MAR 08 2011

OFFICE OF PETITIONS

**Mr. David B. Waller & Associates**
**5677 Oberlin Drive**
**Suite 214**
**San Diego, California 92191**

| | | |
|---|---|---|
| In re Application of | : | |
| Gregory CARRON | : | DECISION GRANTING PETITION |
| Application No. 11/165,764 | : | UNDER 37 CFR 1.137(b) |
| Filed: 23 June 2005 | : | |
| Atty Docket No. CAR.001.P | | |

This is a decision on the petition under 37 CFR 1.137(b), filed 28 May 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 Requirement for Restriction mailed 2 October 2008 ("outstanding Office action"), which set a reply period of 1 month. No reply was sent, following three months' extensions of time. The Application thus became abandoned on 3 January 2008, with notification subsequently sent on 24 June 2009.

The Petition satisfies the conditions for revival pursuant to 37 CFR 1.137(b) by including (1) a reply in the form of a Response to the outstanding Office action, (2) a petition fee of $810.00, and (3) a Statement of unintentional delay. The reply to the outstanding Office action is accepted as having been unintentionally delayed.

The three months' extensions of time submitted with the Petition are hereby refunded.

The file does not indicate a change of address has been properly submitted, although the address given on the petition differs from the address of record. 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 only to the address of record.

Petitioner has appointed a representative to conduct all business before the Patent and Trademark Office (Office). The Office will not engage in dual correspondence with petitioner and petitioner's representative. Accordingly, petitioner must conduct all future

correspondence with this Office through the representative of record. If petitioner no longer wishes to be represented by the representative of record, then a revocation of the power of attorney or authorization of agent must be submitted. A correspondence address must be included on the correspondence instructing the Office where all future communications should be mailed.

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 $555.00 extension of time fee submitted with the petition on 28 May 2010 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

General inquiries relating to this decision should be directed to Robert DeWitty, Petitions Examiner, Office of Petitions (571-272-6051).

The application file will be referred to Technology Center Art Unit 3781 for further action on the filed Response.

David Buccei
Petitions Examiner
Office of Petitions

cc: Mr. Gregory Carron
8070 La Jolla Shores Drive
Box 479
La Jolla, California 92037

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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Johnathan P. O'Brien, Ph.D
Honigman, Miller Schwartz and Cohn LLP
350 East Michigan Avenue
Suite 300
Kalamazoo, MI 49007

MAILED
MAY 02 2011
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,495,103, Hadida-Ruah et al Issue Date: February 24,2009 Application No. 11/165,818 Filed: June 24,2005 Attorney Docket 223306/04-125US/125627 Title: Modulations of ATP-Binding Cassette Transporters | 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 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 six hundred and ninety-five (695) 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 six hundred and ninety-five (695) 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

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,495,103

DATED : **February 24, 2009** **DRAFT**

INVENTOR(S) : Hadida-Ruah 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 450 days

Delete the phrase "by 450 days" and insert – by 695 days--

# Patent Term Adjustments

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

Application Number*: 11165818 Search | Explanation of PTA Calculation | Explanation of PTE Calculation

## PTA Calculations for Application: 11165818

| | | | |
|---|---|---|---|
| Application Filing Date | 06/24/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | 02/24/2009 | Non-Overlapping USPTO Delays: | 509 |
| A Delays | 509 | PTO Manual Adjustment | 245 |
| B Delays | 0 | Applicant Delay (APPL) | 59 |
| C Delays | 0 | Total PTA (days) | 695 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 50 | 05/02/2011 | | P028 | Adjustment of PTA Calculation by PTO | 245 | | 0 |
| 42 | 02/24/2009 | | PTAC | Patent Issue Date Used in PTA Calculation | | | 0 |
| 42.5 | 02/04/2009 | 06/24/2008 | PTA36M | PTA 36 Months | 0 | | 0 |
| 41 | 01/15/2009 | | EFDC | Export to Final Data Capture | | | 0 |
| 40 | 01/14/2009 | | D1935 | Dispatch to FDC | | | 0 |
| 39 | 01/13/2009 | | PILS | Application Is Considered Ready for Issue | | | 0 |
| 38 | 01/09/2009 | | N084 | Issue Fee Payment Verified | | | 0 |
| 37 | 01/09/2009 | | IFEE | Issue Fee Payment Received | | | 0 |
| 36 | 12/29/2008 | | FIDC | Finished Initial Data Capture | | | 0 |
| 35 | 10/14/2008 | | EIDC | Export to Initial Data Capture | | | 0 |
| 34 | 10/10/2008 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 33 | 10/09/2008 | | IREV | Issue Revision Completed | | | 0 |
| 32 | 10/09/2008 | | DVER | Document Verification | | | 0 |
| 31 | 10/09/2008 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 30 | 10/06/2008 | | CNTA | Allowability Notice | | | 0 |
| 29 | 09/29/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 28 | 09/02/2008 | 07/30/2008 | A... | Response after Non-Final Action | | 34 | 26 |
| 27 | 09/02/2008 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 26 | 04/30/2008 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 25 | 04/28/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 19 | 03/08/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 18 | 02/15/2008 | | ELC. | Response to Election / Restriction Filed | | | 0 |
| 17 | 01/15/2008 | 08/24/2006 | MCTRS | Mail Restriction Requirement | 509 | | -1 |
| 16 | 01/11/2008 | | CTRS | Restriction/Election Requirement | | | 0 |
| 24 | 10/25/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 23 | 10/25/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 15 | 10/25/2007 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 14 | 10/25/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 13 | 10/25/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 12 | 02/21/2006 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 11 | 02/21/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 9 | 12/30/2005 | | COMP | Application Is Now Complete | | | 0 |
| 10 | 12/29/2005 | | OIPE | Application Dispatched from OIPE | | | 0 |
| 8 | 12/21/2005 | 11/26/2005 | ADDFLFEE | Additional Application Filing Fees | | 25 | 6 |
| 7 | 12/21/2005 | | OATHDECL | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | | | 0 |
| 6 | 08/26/2005 | | INCD | Notice Mailed--Application Incomplete--Filing Date Assigned | | | 0 |
| 5 | 08/24/2005 | | L128 | Cleared by L&R (LARS) | | | 0 |
| 4 | 08/08/2005 | | INCD | Notice Mailed--Application Incomplete--Filing Date Assigned | | | 0 |
| 3 | 07/06/2005 | | L198 | Referred to Level 2 (LARS) by OIPE CSR | | | 0 |
| 2 | 07/01/2005 | | SCAN | IFW Scan & PACR Auto Security Review | | | 0 |
| 1 | 06/24/2005 | | IEXX | Initial Exam Team nn | | | 0 |

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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AFSHIN ZAND
PO BOX 877
PLEASANTON CA 94566

MAILED

AUG 08 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of<br>Afshin Zand<br>Application No. 11/165,921<br>Filed: June 25, 2005<br>Title: Method and System for Miniature Passive RFID Tags and Readers | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the petition under 37 CFR 1.137(b), filed July 20, 2011, to revive the above-identified application.

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

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

The instant petition is not signed, and as such, will not be considered on the merits. Accordingly, on renewed petition, petitioner must submit a petition containing either a handwritten or S-signature.

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

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

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AFSHIN ZAND
PO BOX 877
PLEASANTON CA 94566

MAILED
AUG 22 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of<br>Afshin Zand<br>Application No. 11/165,921<br>Filed: June 25, 2005<br>Title: Method and System for Miniature Passive RFID Tags and Readers | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the renewed petition to revive under 37 CFR 1.137(b), filed August 10, 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 December 20, 2010. This Office action set a shortened statutory period for reply of three (3) months. No reply having been received, the application became abandoned on March 21, 2011. The Office mailed a Notice of Abandonment on July 18, 2011. In response, applicant filed a petition to revive under 37 CFR 1.137(b) on July 20, 2011. However, because the petition was not signed, the petition was dismissed in a decision mailed on August 8, 2011.

With the instant petition, applicant has submitted a signed petition, making the proper statement of unintentional delay. The petition fee and the required reply (an Amendment) were previously filed on July 20, 2011.

The application is being forwarded to Group Art Unit 2612 for consideration of the Amendment, filed July 20, 2011.

Telephone inquiries concerning 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

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

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FEB 17 2011

OFFICE OF PETITIONS

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

| | | |
|---|---|---|
| In re Patent No. 7,207,948 | : | |
| Issue Date: April 24, 2007 | : | |
| Application No. 11/165,956 | : | NOTICE |
| Filed: June 24, 2005 | : | |
| Attorney Docket No. | : | |
| 3483.0130004/DKSC/CMR | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 on October 22, 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

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

**DEERE & COMPANY**
**ONE JOHN DEERE PLACE**
**MOLINE IL 61265**

**MAILED**
APR 19 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Mariano G. TORRES et al. | : | |
| Application No. 11/165,968 | : | DECISION ON PETITION |
| Filed: June 24, 2005 | : | |
| Attorney Docket No. **17130-US** | : | |

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

The petition is **DENIED**.

## BACKGROUND

The above-identified application was filed June 24, 2005. A request for its express abandonment under 37 CFR 1.138 was filed on April 7, 2008. The express abandonment was recognized in the Notice of Abandonment mailed on April 14, 2008. Accordingly, the above-identified application became abandoned on April 14, 2008.

Petitions filed May 7, 2008, and on April 27, 2008, seeking revival of the instant application, were dismissed in decisions mailed February 27, 2009, and May 21, 2010, respectively. The instant petition was filed on August 13, 2010, seeking "favorable" reconsideration of the previous decisions. Petitioner asserts that the Notice of Express Abandonment was prepared and filed in error, and should have been prepared and filed for then co-pending application Serial No. 11/374,405, with the error allegedly arising from a mix up in attorney docket numbers. In this regard, petitioner's correction of the reference to application Serial No. 11/574,405 (in the previously filed petitions) is acknowledged.

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 Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). This petition lacks item (3).

## STATUTE, REGULATION, AND EXAMINING PROCEDURE

**35 USC § (6)(a) provides, in part, that**:

> The Commissioner ..... may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

**Public Law 97-247, § 3, 96 Stat. 317 (1982)**, which revised patent and trademark fees, 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." Specifically, **35 U.S.C. § 41(a)(7) provides that the Commissioner shall charge**:

> On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, $1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $500.

**§ 1.137 Revival of abandoned application, terminated or limited reexamination prosecution, or lapsed patent**.

> (b) *Unintentional*. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
> (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

**§ 1.138 Express abandonment.**

(a) An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.
(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1), (b)(3), or (b)(4) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent, not of record, who acts in a representative capacity under the provisions of § 1.34(a) when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

**MPEP 711.01 states**:

The applicant (acquiesced in by an assignee of record), or the attorney/agent of record, if any, can sign an express abandonment. It is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the desires and best interests of the applicant prior to signing a letter of express abandonment of a patent application. Moreover, special care should be taken to ensure that the appropriate application is correctly identified in the letter of abandonment.

## OPINION

A thorough review of USPTO records shows that: (1) petitioner filed in the above-identified application, on April 7, 2008, a petition for express abandonment under 37 CFR 1.138; (2) the Office recognized the express abandonment in the above-identified application on April 14, 2008; (3) in application No. 11/374,405, the Office received a letter of express abandonment on May 23, 2008, and the abandonment was recognized on May 30, 2008.

As an initial matter, it is noted that petitioner was notified by the Office of the abandoned status of this application on April 14, 2008. However, no petition to revive this application was filed until May 07, 2008. That is, while petitioner may not have been aware of the abandoned status of this application until a file audit, petitioner was notified of the abandoned status of this application on April 14, 2008.

The reference in the instant petition to the declaration by inventor Smemo, filed April 27, 2009, has been noted. However, the statement by inventor Smemo that the filing of the amendment on March 28, 2008, is indicative of the intent to continue prosecution is not relevant to the question of whether the instant application was unintentionally abandoned. Instead, it is the intentional action of the petitioner in filing the request for express abandonment on April 7, 2008, that is relevant. The USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the consequences of those actions or inactions are

binding. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

The showing of record raises questions as to whether the abandonment of this application was unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b).

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

A standard principle of statutory construction is: *expression unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Law 97-247 a specific scheme for the revival of abandoned applications (i.e., the specific situations under which PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., 37 CFR 1.182 or 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Director's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 133, and 151. See Morganroth v. Quigg, 885 F.2nd 843, 847, 12 USPQ2d 1125, 1128 (fed. Cir. 1989) (the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

Finally, that the provisions under which an applicant may expressly abandon an application are solely a creation of the rules of practice does not affect the status of an application in which an applicant has filed and the Office has recognized a declaration of abandonment as an application that is abandoned within the meaning of 35 U.S.C. §§ 41(a)(7) and 120. The status of an application is one of three conditions: (1) pending, (2) patented, or (3) abandoned. See In re Morganroth, 6 USPQ2d, 1802, 1803 (Comm'r Pats. 1988). In addition, under 35 U.S.C. §120, proceedings in an application are concluded in three ways: (1) the application may issue as a patent, (2) the application may become abandoned, (3) proceedings in the application may be

terminated. When the applicant files and the PTO recognizes a written declaration that the applicant seeks to discontinue prosecution, proceedings in that application are terminated no later than the date of such recognition. Where proceedings in an application are terminated in a manner which does not result in an allowance of the application, such application is no longer pending, but is abandoned. Cf. MPEP §§ 1214.06 & 1216.01.

Thus, while the patent statute does not provide for express abandonment of an application, an application becomes abandoned within the meaning of 35 U.S.C. §§ 41(a)(7) and 120 by operation of the filing by the applicant and upon recognition by the PTO of a written declaration that the applicant seeks to discontinue prosecution in (or expressly abandon) an application. That is, while Office need not have promulgated rules and procedures for the acceptance of a written declaration of express abandonment, by doing so, an application will become abandoned within the meaning of 35 U.S.C. §§ 41(a)(7) and 120 upon recognition of a written declaration of express abandonment.

Therefore, any petition that the above-identified application be revived or otherwise restored to pending status must be authorized by 35 U.S.C. §§ 41(a)(7), 111, 133, or 151 and pursuant to their impending regulation (37 CFR 1.137).

35 U.S.C. §§ 111 or 151 obviously do not apply in instances in which an applicant has filed a letter of express abandonment. In addition, 35 U.S.C. §133 authorizes the Commissioner to revive an application abandoned for failure to prosecute in instances in which it is shown to the satisfaction of the Commissioner that the delay in prosecution was unavoidable. 35 U.S.C. §133 does not authorize the Commissioner to revive an application abandoned by express or formal abandonment. See Ex parte Hirth, 1908 Dec. Comm'r Pat. 240 (1908). Thus, in instances in which an applicant has filed a letter of express abandonment, the revival of such an application must be under and authorized by 35 U.S.C. § 41(a)(7), in that the filing of such a letter of express abandonment must have unintentional for the Office to be authorized to revive the application.

As this application was intentionally abandoned, a course of action deliberately chosen by the petitioner, the abandonment of this application cannot be reasonably considered to have been unintentional within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.137(b). Accordingly, petitioner cannot meet his burden of proving to the satisfaction of the Director that above-identified application was "an unintentionally abandoned application" within the meaning of 35 U.S.C. § 41(c)(1). See In re Application of G, 11 USPQ2d at 1380. The revival of an intentionally abandoned application, as this application was, is antithetical to the meaning and intent of the statute and regulation.

## DECISION

For the above-stated reasons, this application will not be revived, and this application remains abandoned. The petition to revive the instant application is **denied**.

This is a **final agency action** within the meaning of 5 U.S.C. § 704. The Director will undertake no further reconsideration or review of this matter.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272-4914.

Anthony Knight
Director,
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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2318 MILL ROAD, SUITE 1010
ALEXANDRIA, VA 22314

MAILED

FEB 28 2011

OFFICE OF PETITIONS

In re Application of :
Mitsuaki Fukuda et al :
Application No. 11/166,189 :
Filed: June 27, 2005 :
Attorney Docket No. 04-52927

ON PETITION

This is a decision on the petition, filed February 24, 2011 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 January 26, 2011 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 2624 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

**PATENT NO.:** 7,375,538



**DATED:** May 20, 2008

**INVENTOR(S):** M. NOZOE 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 TITLE PAGE
Please correct (12) to read as follows:
(12) United States Patent
Nozoe et al.

Please correct (75) Inventor: to read as follows:
(75) Inventor: Mari Nozoe, Hino (JP);
Mitsuo Suga, Koshigaya (JP);
Yoichiro Neo, Kokubunji (JP);
Hidetoshi Nishiyama, Kokubunji (JP)

/HUY Q PHAN/
Supervisory Patent Examiner.Art Unit 2858

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/18/11

TO SPE OF : ART UNIT 3729

SUBJECT : Request for Certificate of Correction for Appl. No.: 11166264 Patent No.: 7877863

CofC mailroom date: 03/07/11

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 (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:** None

/Derris H. Banks/ — SPE

3729 — Art Unit

# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/166,298 | 06/24/2005 | Robert P. Loce | A4079USNP/XERZ200886US01 | 4901 |

62095 7590 08/10/2011
FAY SHARPE / XEROX - ROCHESTER
1228 EUCLID AVENUE, 5TH FLOOR
THE HALLE BUILDING
CLEVELAND, OH 44115

| EXAMINER |
|---|
| NGUYEN, ALLEN H |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2625 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/10/2011 | 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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TECHNOLOGY CENTER 2600

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1228 EUCLID AVENUE, 5TH FLOOR
THE HALLE BUILDING
CLEVELAND OH 44115

In re Application of:
**LOCE, ROBERT P.** et al.
Application Serial No.: **11/166,298**
Filed: **June 24, 2005**
For: **WATERMARKING**
Attorney Docket No.: **A4079USNP/XERZ200886US01**

DECISION
ON PETITION

This is a decision on the petition to review the finality of the Office action, filed June 16, 2011, pursuant to 37 CFR § 1.181.

Petitioner alleges, "that contrary to MPEP §707.07(f), the Office action of May 16, 2011 is incomplete in that it includes repeated rejections without taking note of and answering the substance of all of Applicants arguments. Additionally, due in part to this incompleteness, the clear issues that MPEP §706.07 indicates should be developed between the Examiner and Applicant were not developed before the final rejection."

Petitioner cites thirteen instances of arguments made in the response filed on January 12, 2011 that were allegedly unanswered in the final action of May 16, 2011. Petitioner further alleges that the rejection of dependent claim 2 in said final action improperly raised new grounds of rejection that were not necessitated by amendment or submission of an Information Disclosure Statement.

Petitioner seeks the withdrawal of the finality of the Office action of June 16, 2011.

## BACKGROUND

On October 13, 2010, a non-final Office action was mailed rejecting claims 1-3, 9, 10 and 13-24 under 35 USC 103(a) as obvious in view of prior art. The rejections of all independent claims and some dependent claims relied on US 5,291,243 to Heckman et al. in view of US 6,950,194 to Sandstrom. The rejections of some dependent claims further relied on additional references and Official Notice. Claims 4-8 and 11 were rejected as indefinite under 35 USC 112, 2nd paragraph.

On January 12, 2011, applicant filed a response to the non-final office action, referred to in the petition as "Amendment E". In the response applicant canceled claim 9 and incorporated its limitations into all the independent claims and amended dependent claim 19. In said response applicant made remarks and arguments (pp. 10-36) regarding the rejections.

On May 16, 2011, a final Office action was mailed maintaining the rejections made under 35 USC 112, 2nd paragraph and rejecting claims 1-3, 10 and 13-24 under 35 USC 103(a) with reliance on the same references, with the exception that the rejection of amended dependent

claim 19 relied on a newly-introduced reference to teach the feature introduced in the amendment. The final action included response to applicant's arguments (pp. 2-16).

REGULATIONS AND PRACTICE

**MPEP §706.07 [R-3] Final Rejection**, states in part:

> Before final rejection is in order a clear issue should be developed between the examiner and applicant.

**MPEP 706.07(a) [R-6] Final Rejection, When Proper on Second Action** states in part:

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

**MPEP 707.07 Completeness and Clarity of Examiner's Action** states:

> 37 CFR 1.104. Nature of examination.
>
> (b) Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

**MPEP 707.07(f) [R-3] Answer All Material Traversed** states in part:

> In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application. ... Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

OPINION

A review of the file record shows, in the non-final office action of October 13, 2010, claim 2 was rejected under 35 USC 103(a) as unpatentable over US 5,291,243 to Heckman et al. in view of US 6,950,194 to Sandstrom. In the final Office action of May 16, 2011, claim 2, while amended in scope due to the amendment of its parent, claim 1, was rejected with reliance on the same references. Petitioner bases the allegation of improper new grounds on the citation in Heckman of figure 2, reference numerals 90 and 92 in the response to arguments made in the final action since these reference numerals were not cited in the rejection. It is clear from a review of the reference that the passages and figure references cited in the rejections of claim 2with respect to Heckman relate to actions that are performed by the structure depicted in figure 2. Therefore the

clarification of the rejection by the examiner by referring to other parts of the reference in responding to applicant's arguments does not constitute improper new grounds of rejection in a final Office action.
A review of the filed record also shows that not all of applicant's substantive arguments have been answered. One instance in particular is applicant's arguments with respect to the obviousness modifications of the system taught by Heckman rendering it inoperable based on Heckman's inherent reliance on single-pass printing. A second instance is with respect to the specific requirements in the claims of images being rendered at a density at which human sensitivity to density differences is low. Therefore, in accordance with MPEP 707.07 and MPEP 707.07(f) the final office action mailed September 01, 2010 is incomplete.

Accordingly, the petition to withdraw finality is **GRANTED**.

The record shows an Amendment after Final has been filed on June 16, 2011 and a subsequent Advisory action was mailed on July 13, 2011. As a result of the petition decision, the Examiner's final office action on May 16, 2011 and the Advisory action on July 13, 2011 are withdrawn. The application is being forwarded to examiner in order to mail out a complete office action that answers the substance of all of applicant's arguments in applicant's response filed on January 12, 2011 and also to answer the substance of any additional arguments in applicant's response filed on June 16, 2011.

Any inquiry regarding this decision should be directed to Daniel Swerdlow, Quality Assurance Specialist, at (571) 272-7531.

Wanda L. Walker

Wanda L. Walker, Director
Technology Center 2600
Communications

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Paper No.

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

MAILED

FEB 15 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,522,144 | : | DECISION ON REQUEST |
| Kang et al. | : | FOR |
| Issue Date: April 21, 2009 | : | RECONSIDERATION OF |
| Application No. 11/166,307 | : | PATENT TERM ADJUSTMENT |
| Filed: June 24, 2005 | : | and |
| Atty Docket No. 12580-4173 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on June 22, 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 seventy-one **(971)** 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 eight hundred seventy-five **(875)** days.

The Office agrees that the period of Office delay pursuant to 37 CFR 1.702(b) is 278 days. However, a review of the record also reveals a basis for entry of another period of applicant delay, pursuant to 37 CFR 1.704(c)(8). Specifically, after filing an amendment on October 3, 2008, on January 7, 2009, applicant filed a paper entitled record of interview. The application record does not support a conclusion that the filing of this paper was expressly requested by the examiner. Accordingly, entry of a period of reduction of 96 days for the period beginning on October 4, 2008 and ending on January 7, 2009 is warranted.

In view thereof, the patent term adjustment indicated on the patent should be 871 days (687 + 6 + 278 - 96).

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 eight hundred seventy-five **(875)** 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 : 7,522,144 B2

DATED : **April 21, 2009** **DRAFT**

INVENTOR(S) : Kang 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 693 days

Delete the phrase "by 693 days" and insert – by 875 days--

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Jeffrey T. Haley
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Bellevue, WA 98005

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FEB 04 2011

OFFICE OF PETITIONS

In re Application of :
Jonah Peskin, et. al. :
Application No. 11/166,319 : ON PETITION
Filed: June 24, 2005 :
Attorney Docket No.1852-001-05 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 24, 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 March 31, 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 $405 fee; (2) the petition fee of $810; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 2172 for processing of the RCE.

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

Andrea Smith
Petitions Examiner
Office of Petitions

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RYAN KROMHOLZ & MANION, S.C.
POST OFFICE BOX 26618
MILWAUKEE WI 53226

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NOV 15 2010

**OFFICE OF PETITIONS**

In re Application of
Lee Bolduc
Application No. 11/166,411
Filed: June 24, 2005
Attorney Docket No. **9494.17965-PROV FOR DIV**

DECISION ON PETITION

This is a decision on the petition, filed June 21, 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 of December 3, 2009, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on June 10, 2010.

Petitioner contends that the Notice of Abandonment was mailed in error since a timely reply (Amendment) was received by the office on June 7, 2010, with a three (3) month extension of time and a certificate of mailing dated June 2, 2010. A review of the application file record confirms the receipt of this reply with a certificate of mailing dated June 2, 2010 and the fee for a three (3) month extension of time, on June 7, 2010. Thus, the application is not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby **VACATED** and the holding of abandonment **WITHDRAWN**.

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 Patrick J. Fleis 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. Fleis desires to be acknowledged as the attorney of record in this file, the appropriate power of attorney documents must be submitted.

Telephone inquires concerning this decision should be directed to JoAnne Burke at 571-272-4584.

This application is being referred to Technology Center AU 3734 for appropriate action in the normal course of business on the reply received June 7, 2010.

Ramesh Krishnamurthy

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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CHICAGO IL 60661

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OCT 01 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Sumant Ranganathan, et al. | : | |
| Application No. 11/166,632 | : | DECISION GRANTING PETITION |
| Filed: June 24, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 15851US02 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed September 29, 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 15, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries regarding the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2116 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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CHICAGO IL 60661

MAILED

OCT 21 2010

OFFICE OF PETITIONS

In re Application of :
Ranganathan et al. :
Application No. 11/166,632 :
Filed: June 24, 2005 :
Atty Docket No. 15851US02 :

LETTER REGARDING
PATENT TERM ADJUSTMENT

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 September 15, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is two hundred fifty-seven (257) days, not ninety-three (93) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

On June 25, 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 93 days.

However, prior to a decision on the instant petition being rendered, on September 29, 2010, applicants filed a petition to withdraw from issue along with a request for continued examination (RCE) and Information Disclosure Statement (IDS). By decision mailed October 1, 2010, the withdrawal from issue was granted. Prosecution was reopened.

In view thereof, a decision is being **held in abeyance** until after the mailing of any new Notice of Allowance and the filing or resubmission of any application for patent term adjustment under 37 CFR 1.705(b). A new determination of patent term adjustment will accompany any new Notice of Allowance and will

include any further adjustments or reductions accrued to date. Applicants must submit a timely application for patent term adjustment in response to any new Notice of Allowance. An application for patent term adjustment under 37 CFR 1.705(b) is properly filed after the mailing of the Notice of Allowance on which the application issues and prior to payment of the issue fee or a request for reapplication of the issue fee in response to that Notice.

Technology Center AU 2116 has been advised of this decision. The application is, thereby, forwarded to the Technology Center for consideration of the RCE by the examiner.

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

MAILED
FEB 28 2011
OFFICE OF PETITIONS

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500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

| | | |
|---|---|---|
| In re Application of | : | |
| Ranganathan, et al. | : | |
| Application No. 11/166,632 | : | ON APPLICATION FOR |
| Filed: June 24, 2005 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 15851US02 | : | |

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 January 13, 2011. Applicants submit that the patent term adjustment to be indicated on the patent is two hundred fifty-seven (257) days, not ninety-three (93) 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.

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 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 have requested review and correction of the patent term adjustment, the petition is **granted as indicated herein.** A review of the patent term adjustment to date has revealed other causes for reductions under 37 CFR 1.704(c)(10).

The first Notice of Allowance was mailed on June 25, 2010. The issue fee was paid on September 15, 2010. A Request for Continued Examination (RCE), IDS, and petition to withdraw from issue were filed after payment of the issue fee on September 29, 2010.

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[1] 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.

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;

The additional period of reduction is 27 days, counting the number of days beginning on September 29, 2010, the date of filing of the RCE and IDS, and ending on October 25, 2010, the date of mailing of the new Notice of Allowance in response. (The reduction associated with the filing of the petition to withdraw from issue is subsumed in the 27 day reduction, as it runs from September 29, 2010 to October 1, 2010.)

The Office has updated the PAIR screen by entering the additional period of delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

In view thereof, the correct patent term adjustment at the time of mailing of the notice of allowance is **sixty-six (66) days** (421 days of Office delay - 355 (90+91+58+89+27) days of Applicant delay).

The $200.00 fee set forth in 37 CFR 1.18(e) was submitted on September 15, 2010. No additional fees are required for this petition under 37 CFR 1.705(b), as the first petition was held in abeyance. Accordingly, deposit account no. 13-0017 will be refunded the $200.00 petition fee submitted with the present petition.

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 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 at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of updated PAIR screen

Patent eBusiness

- Electronic Filing
- Patent Application Information (PAIR)
- Patent Ownership
- Fees
- Supplemental Resources & Support

Patent Information

- Patent Guidance and General Info
- Codes, Rules & Manuals
- Employee & Office Directories
- Resources & Public Notices

Patent Searches

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- Search Patents & Applications
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- Reports

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11/166,632 MULTI-VOLTAGE MULTI-BATTERY POWER MANAGEMENT UNIT

Select New Case | Application Data | Transaction History | Image File Wrapper | Patent Term Adjustments | Continuity Data | Published Documents | Address & Attorney/Agent

## Patent Term Adjustment

| | | | |
|---|---|---|---|
| Filing or 371(c) Date: | 06-24-2005 | Overlapping Days Between {A and B} or {A and C}: | 0 |
| Issue Date of Patent: | - | Non-Overlapping USPTO Delays: | 421 |
| A Delays: | 421 | PTO Manual Adjustments: | -27 |
| B Delays: | 0 | Applicant Delays: | 328 |
| C Delays: | 0 | Total PTA Adjustments: | 66 |

**Patent Term Adjustment History** **Explanation Of Calculations**

| Number | Date | Contents Description | PTO (Days) | APPL (Days) | Start |
|---|---|---|---|---|---|
| 75 | 02-28-2011 | Adjustment of PTA Calculation by PTO | | 27 | 0 |
| 70 | 10-25-2010 | Mail Notice of Allowance | | | 0 |
| 69 | 10-23-2010 | Issue Revision Completed | | | 0 |
| 68 | 10-23-2010 | Document Verification | | | 0 |
| 67 | 10-23-2010 | Notice of Allowance Data Verification Completed | | | 0 |
| 66 | 10-23-2010 | Allowability Notice | | | 0 |
| 64 | 09-29-2010 | Information Disclosure Statement considered | | | 0 |
| 63 | 10-21-2010 | Mail-Petition Decision - Dismissed | | | 0 |
| 62 | 10-21-2010 | Petition Decision - Dismissed | | | 0 |
| 61 | 09-29-2010 | Electronic Information Disclosure Statement | | | 0 |
| 60 | 09-29-2010 | Request for Continued Examination (RCE) | | | 0 |
| 59 | 10-07-2010 | Disposal for a RCE / CPA / R129 | | | 0 |
| 58 | 10-01-2010 | Mail-Record Petition Decision of Granted to Withdraw from Issue | | | 0 |
| 57 | 10-01-2010 | Record Petition Decision of Granted to Withdraw from Issue | | | 0 |
| 56 | 09-29-2010 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 55 | 09-29-2010 | Petition Entered | | | 0 |
| 54 | 09-29-2010 | Workflow - Request for RCE - Begin | | | 0 |
| 53 | 09-15-2010 | Petition Entered | | | 0 |
| 52 | 09-17-2010 | Application Is Considered Ready for Issue | | | 0 |
| 51 | 09-15-2010 | Issue Fee Payment Verified | | | 0 |

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|---|---|---|---|---|
| 50 | 09-15-2010 | Issue Fee Payment Received | | 0 |
| 49 | 08-17-2010 | Finished Initial Data Capture | | 0 |
| 48 | 06-30-2010 | Export to Initial Data Capture | | 0 |
| 47 | 06-25-2010 | Mail Notice of Allowance | | 0 |
| 46 | 06-24-2010 | Issue Revision Completed | | 0 |
| 45 | 06-24-2010 | Document Verification | | 0 |
| 44 | 06-24-2010 | Notice of Allowance Data Verification Completed | | 0 |
| 43 | 06-24-2010 | Case Docketed to Examiner in GAU | | 0 |
| 42 | 06-18-2010 | Allowability Notice | | 0 |
| 39 | 04-19-2010 | Date Forwarded to Examiner | | 0 |
| 38 | 04-01-2010 | Response after Non-Final Action | 89 | 36 |
| 37 | 04-01-2010 | Request for Extension of Time - Granted | | 0 |
| 36 | 10-02-2009 | Mail Non-Final Rejection | | 0 |
| 35 | 10-01-2009 | Non-Final Rejection | | 0 |
| 34 | 09-01-2009 | Date Forwarded to Examiner | | 0 |
| 33 | 07-17-2009 | Response after Non-Final Action | 58 | 31 |
| 32 | 07-17-2009 | Request for Extension of Time - Granted | | 0 |
| 31 | 02-20-2009 | Mail Non-Final Rejection | | 0 |
| 30 | 02-17-2009 | Non-Final Rejection | | 0 |
| 29 | 12-10-2008 | Date Forwarded to Examiner | | 0 |
| 28 | 12-05-2008 | Amendment Submitted/Entered with Filing of CPA/RCE | | 0 |
| 27 | 12-10-2008 | Date Forwarded to Examiner | | 0 |
| 26 | 12-05-2008 | Request for Continued Examination (RCE) | 91 | 22 |
| 25 | 12-10-2008 | Disposal for a RCE / CPA / R129 | | 0 |
| 24 | 12-05-2008 | Request for Extension of Time - Granted | | 0 |
| 23 | 12-05-2008 | Workflow - Request for RCE - Begin | | 0 |
| 22 | 06-05-2008 | Mail Final Rejection (PTOL - 326) | | 0 |
| 21 | 06-04-2008 | Final Rejection | | 0 |
| 20 | 05-12-2008 | Paralegal TD Accepted | | 0 |
| 19 | 05-12-2008 | Paralegal TD Accepted | | 0 |
| 18 | 04-18-2008 | Terminal Disclaimer Filed | 0 | 13 |

| | | | | | |
|---|---|---|---|---|---|
| 17 | 04-18-2008 | Terminal Disclaimer Filed | | | 0 |
| 16 | 04-18-2008 | terminal disclaimer fee paid | | | 0 |
| 15 | 04-18-2008 | terminal disclaimer fee paid | | | 0 |
| 14 | 05-10-2008 | Date Forwarded to Examiner | | | 0 |
| 13 | 04-18-2008 | Response after Non-Final Action | | 90 | 10 |
| 12 | 04-18-2008 | Request for Extension of Time - Granted | | | 0 |
| 11 | 01-16-2008 | Case Docketed to Examiner in GAU | | | 0 |
| 10 | 10-19-2007 | Mail Non-Final Rejection | 421 | | -1 |
| 9 | 10-15-2007 | Non-Final Rejection | | | 0 |
| 8 | 08-03-2007 | Case Docketed to Examiner in GAU | | | 0 |
| 7 | 12-19-2005 | IFW TSS Processing by Tech Center Complete | | | 0 |
| 6 | 12-19-2005 | Case Docketed to Examiner in GAU | | | 0 |
| 5 | 07-19-2005 | Application Dispatched from OIPE | | | 0 |
| 4 | 07-19-2005 | Application Is Now Complete | | | 0 |
| 3 | 07-12-2005 | Cleared by OIPE CSR | | | 0 |
| 2 | 07-07-2005 | IFW Scan & PACR Auto Security Review | | | 0 |
| 1 | 06-24-2005 | Initial Exam Team nn | | | 0 |

*If you need help:*

- *Call the Patent Electronic Business Center at (866) 217-9197 (toll free) or e-mail EBC@uspto.gov for specific questions about Patent Application Information Retrieval (PAIR).*
- *Send general questions about USPTO programs to the USPTO Contact Center (UCC) .*
- *If you experience technical difficulties or problems with this application, please report them via e-mail to Electronic Business Support or call 1 800-786-9199.*

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OFFICE OF PETITIONS

**Ramirez & Smith**
**P.O. Box 341179**
**Austin TX 78734**

| | | |
|---|---|---|
| In re Application of | : | |
| Patrick Barclay DRAGANI | : | DECISION GRANTING PETITION |
| Application No. 11/166,695 | : | UNDER 37 CFR 1.137(b) |
| Filed: June 25, 2005 | : | |
| Atty. Docket No.: GE.0051 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed March 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 final Office action mailed September 3, 2010, which set a shortened statutory period for reply of three (3) months. The application thus became abandoned on December 4, 2010, and a Notice of Abandonment was mailed March 17, 2011.

The petition satisfies the conditions for revival pursuant to 37 CFR 1.137(b) by including (1) a reply in the form of a Request for Continued Examination (RCE), RCE fee, and response to t he outstanding Office action, (2) a petition fee of $1620, and (3) a statement of unintentional delay. The reply to the outstanding Office action is accepted as having been unintentionally delayed.

Telephone inquiries relating to this decision should be directed to Robert DeWitty, Petitions Examiner, Office of Petitions (571-272-8427).

The application file will be referred to Technology Center Art Unit 3626 for further action on the filed Response.

Ramesh Krishnamurthy

for David Bucci
Petitions Examiner
Office of Petitions

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STAMFORD CT 06901-2682

**MAILED**

FEB 22 2011

**OFFICE OF PETITIONS**

In re Application
Mitchell Wortzman et al.
Application No. 11/166,817
Filed: June 24, 2005
Attorney Docket No.
0004553USU/4195

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705 filed May 6, 2010. Applicant requests that the initial determination of Patent Term Adjustment of 149 days under 35 U.S.C. 154(b) be corrected to 489 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 2, 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 forty-nine days. Applicants submit the instant application for patent term adjustment requesting that the initial determination of Patent Term Adjustment under 35 U.S.C. 154(b) be further adjusted under 37 CFR 1.702. [1]

The Office initially determined a patent term adjustment of one hundred forty-nine (149) days based on an adjustment for PTO delay of five hundred thirteen days (513) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) and (a)(2) and three hundred sixty-four days for applicant delay pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b). Applicant contends however that the patent issuing from this application is entitled to more days of patent term adjustment based on Office delay and applicant delay.

Applicant disputes the period of adjustment for Office failure to mail a first action under 35 U.S.C. 132. Applicant calculates the period of delay pursuant to 37 CFR 1.702(a)(1), 14 months from August 25, 2006 and ending on October 11, 2007, the date the restriction requirement was mailed, instead of the period beginning on August 24, 2006, which is correctly indicated. Thus, as indicated, the delay pursuant to 37 CFR 1.702(a)(1) is correctly indicated as 413 days, not 412 days.

Applicant also asserts that the Office incorrectly calculated a period of delay accorded the Applicant for a response filed March 13, 2009 to a Final Office Action mailed

[1] PALM records indicate that the Issue Fee was received in the Office on My 6, 2010.

November 13, 2008. Applicant argues that the period of delay for the filing of the Patent Term Adjustment should be reduced in the amount of twenty-six days for applicant delay for the filing of a response on February 13, 2009, instead of twenty-eight days as calculated by the Office. Under the same reasoning above, the period of delay begins February 13, 2009 to March 13, 2009, instead of the period beginning on February 14, 2009, which is correctly indicated. Thus, as indicated, the delay pursuant to 37 CFR 1.704(b) is correctly indicated as 28 days, not 26 days.

With respect to Applicant's argument that in response to a non-final Office Action dated October 29, 2007, Applicants filed a response under 37 CFR § 1.111, plus an extension of time, on February 4, 2008 and that under 37 CFR 704(b), the filing of the February 4, 2008 response should effect a reduction of adjustment of 6 days, Applicant has incorrectly noted the dates. The non-Final Office Action was not mailed October 29, 2007 and instead was mailed November 6, 2007 and as the response with a one month extension of time was filed February 4, 2008, within three months of the Office Action, no reduction for Applicant delay is warranted and none has been accorded.

Applicant registers a similar argument in calculating the period for the response filed after the omission. Applicant argues that to cure the non-compliant filing of February 4, 2008, Applicants filed on July 14, 2008 a response under § 1.111, which response was entered by the Examiner. Under Rule 704(c)(7), a reduction of the period of adjustment runs from February 5, 2008 to July 14, 2008, which is a reduction of adjustment of 160 days. Applicant's arguments have been considered but have not been found to be persuasive. At the outset the response was filed July 17, 2008 and not July 14, 2008 and therefore, the period of delay is from February 4, 2008 to July 17, 2008 and is 164 days, as indicated and not 160 days as argued by Applicant.

Finally, Applicant argues that as the response filed February 4, 2008 under 37 CFR § 1.111, was found incomplete by the Examiner, and as the Office mailed a Notice of Non-Compliant amendment on June 13, 2008, in response thereof, pursuant to 37 CFR § 703(a)(2), 8 days of Examination delay should have been accorded for the period June 5, 2008 to June 13, 2008. Applicant's argument is persuasive. The failure to mail the Notice of Non-Compliant amendment in this case resulted in 8 days of USPTO delay.

In view thereof, the determination of Patent Term Adjustment at the time of the mailing of the notice of allowance should have been 157 days (413 plus 92 plus 8 plus 8 days attributable to examination delay minus 364 applicant delay) rather than 149 days listed on the notice of allowance.

The Office acknowledges the authorization to charge 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) to deposit account no. 01-0467.

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 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

Application Number*: 11166817 Search Explanation of PTA Calculation Explanation of PTE Calculation

## PTA Calculations for Application: 11166817

| | | | |
|---|---|---|---|
| Application Filing Date | 06/24/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 513 |
| A Delays | 513 | PTO Manual Adjustment | 8 |
| B Delays | 0 | Applicant Delay (APPL) | 364 |
| C Delays | 0 | Total PTA (days) | 157 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 181 | 02/16/2011 | | P028 | Adjustment of PTA Calculation by PTO | 8 | | 0 |
| 171 | 04/02/2010 | 03/25/2010 | MN/=. | Mail Notice of Allowance | 8 | | 153 |
| 170 | 03/30/2010 | | IREV | Issue Revision Completed | | | 0 |
| 169 | 03/30/2010 | | DVER | Document Verification | | | 0 |
| 168 | 03/30/2010 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 167 | 03/30/2010 | | CNTA | Notice of Allowability | | | 0 |
| 163 | 01/27/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 159 | 01/27/2010 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 157 | 01/27/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 162 | 01/13/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 158 | 01/13/2010 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 156 | 01/13/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 152 | 12/10/2009 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 151 | 12/10/2009 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 166 | 11/25/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 161 | 11/25/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 155 | 11/25/2009 | | LET. | Miscellaneous Incoming Letter | | | 0 |
| 154 | 11/25/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 153 | 11/25/2009 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 150 | 11/25/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 149 | 11/25/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 148 | 11/25/2009 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 147 | 11/19/2009 | | FIDC | Finished Initial Data Capture | | | 0 |
| 139 | 10/16/2009 | | EIDC | Export to Initial Data Capture | | | 0 |
| 138 | 10/13/2009 | 07/13/2009 | MN/=. | Mail Notice of Allowance | 92 | | 102 |
| 137 | 10/09/2009 | | IREV | Issue Revision Completed | | | 0 |
| 136 | 10/09/2009 | | DVER | Document Verification | | | 0 |
| 135 | 10/02/2009 | | ACRE | Allowed Case Returned to the Examiner for Clerical Processing | | | 0 |
| 134 | 10/01/2009 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 133 | 10/01/2009 | | CNTA | Notice of Allowability | | | 0 |
| 127 | 09/17/2009 | | P574 | Paralegal TD Accepted | | | 0 |
| 126 | 09/17/2009 | | P574 | Paralegal TD Accepted | | | 0 |
| 125 | 09/17/2009 | | P574 | Paralegal TD Accepted | | | 0 |
| 124 | 09/17/2009 | | P574 | Paralegal TD Accepted | | | 0 |
| 123 | 09/17/2009 | | P574 | Paralegal TD Accepted | | | 0 |
| 122 | 09/17/2009 | | P574 | Paralegal TD Accepted | | | 0 |
| 121 | 09/03/2009 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 119 | 09/02/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 120 | 08/28/2009 | 03/13/2009 | DIST | Terminal Disclaimer Filed | | 168 | 102 |
| 118 | 08/28/2009 | | SA.. | Supplemental Response | | | 0 |
| 128 | 08/10/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 115 | 08/10/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 111 | 08/10/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 117 | 07/09/2009 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 108 | 05/13/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 107 | 04/30/2009 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 105 | 04/16/2009 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 104 | 04/14/2009 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 106 | 04/13/2009 | | LET. | Miscellaneous Incoming Letter | | | 0 |
| 103 | 03/24/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 101 | 03/24/2009 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 102 | 03/13/2009 | 02/13/2009 | RCEX | Request for Continued Examination (RCE) | | 28 | 92 |

| | | | | | | | |
|---|---|---|---|---|---|---|---|
| 100 | 03/13/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 99 | 03/13/2009 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 98 | 03/11/2009 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 97 | 03/10/2009 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 110 | 02/24/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 95 | 02/24/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 94 | 02/24/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 93 | 02/17/2009 | | A.NE | Amendment after Final Rejection | | | 0 |
| 92 | 11/13/2008 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 91 | 11/10/2008 | | CTFR | Final Rejection | | | 0 |
| 89 | 08/20/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 87 | 07/28/2008 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 86 | 07/23/2008 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 88 | 07/17/2008 | 02/04/2008 | A... | Response after Non-Final Action | | 164 | 62 |
| 80 | 06/13/2008 | | NINA | Mail Notice of Informal or Non-Responsive Amendment | | | 0 |
| 74 | 05/20/2008 | | PA.. | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 73 | 05/14/2008 | | C.AD | Correspondence Address Change | | | 0 |
| 71 | 04/15/2008 | | EML_NTR | Email Notification | | | 0 |
| 70 | 04/15/2008 | | PA.. | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 78 | 02/29/2008 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 69 | 02/29/2008 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 63 | 02/12/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 77 | 02/04/2008 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 65 | 02/04/2008 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 64 | 02/04/2008 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 62.1 | 02/04/2008 | | A.I. | Informal or Non-Responsive Amendment after Examiner Action | | | 0 |
| 62 | 02/04/2008 | | A... | Response after Non-Final Action | | | 0 |
| 61 | 02/04/2008 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 72 | 01/04/2008 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 60 | 01/04/2008 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 59 | 11/27/2007 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 57 | 11/08/2007 | | ELC_RVW | Electronic Review | | | 0 |
| 56 | 11/07/2007 | | EML_NTF | Email Notification | | | 0 |
| 55 | 11/06/2007 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 54 | 10/29/2007 | | CTNF | Non-Final Rejection | | | 0 |
| 45 | 10/17/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 43 | 10/17/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 44 | 10/15/2007 | 10/11/2007 | SA.. | Supplemental Response | | 4 | 42 |
| 41 | 10/12/2007 | | ELC_RVW | Electronic Review | | | 0 |
| 42 | 10/11/2007 | | ELC. | Response to Election / Restriction Filed | | | 0 |
| 40 | 10/11/2007 | | EML_NTF | Email Notification | | | 0 |
| 39 | 10/11/2007 | 08/24/2006 | MCTRS | Mail Restriction Requirement | 413 | | -1 |
| 38 | 10/01/2007 | | CTRS | Requirement for Restriction / Election | | | 0 |
| 37 | 09/27/2007 | | PG-ISSUE | PG-Pub Issue Notification | | | 0 |
| 34 | 09/14/2007 | | MP003 | Mail-Record Petition Decision of Granted to Make Special | | | 0 |
| 33 | 08/24/2007 | | PET. | Petition Entered | | | 0 |
| 32 | 07/13/2007 | | A.PE | Preliminary Amendment | | | 0 |
| 53 | 07/10/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 31 | 07/10/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 52 | 07/05/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 30 | 07/05/2007 | | RCAP | Reference capture on IDS | | | 0 |
| 29 | 07/05/2007 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 28 | 07/05/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 51 | 05/31/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 27 | 05/31/2007 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 26 | 05/31/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 22 | 03/16/2007 | | C.AD | Correspondence Address Change | | | 0 |
| 50 | 03/12/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 25 | 03/12/2007 | | A.PE | Preliminary Amendment | | | 0 |
| 24 | 03/12/2007 | | RCAP | Reference capture on IDS | | | 0 |
| 23.7 | 03/12/2007 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 23 | 03/12/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 21 | 02/26/2007 | | LET. | Miscellaneous Incoming Letter | | | 0 |
| 20 | 12/28/2006 | | PG-ISSUE | PG-Pub Issue Notification | | | 0 |
| 49 | 05/30/2006 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 19 | 05/30/2006 | | RCAP | Reference capture on IDS | | | 0 |
| 18.7 | 05/30/2006 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 18 | 05/30/2006 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 17 | 11/03/2005 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 16 | 11/03/2005 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 48 | 10/11/2005 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 15 | 10/11/2005 | | RCAP | Reference capture on IDS | | | 0 |
| 14.7 | 10/11/2005 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 14 | 10/11/2005 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 47 | 09/14/2005 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 12 | 09/14/2005 | | RCAP | Reference capture on IDS | | | 0 |
| 11.7 | 09/14/2005 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 11 | 09/14/2005 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 10 | 08/24/2005 | | L128 | Cleared by L&R (LARS) | | | 0 |
| 8 | 08/08/2005 | | COMP | Application Is Now Complete | | | 0 |
| 9 | 08/05/2005 | | WROIPE | Application Return from OIPE | | | 0 |
| 7 | 08/05/2005 | | ROIPE | Application Return TO OIPE | | | 0 |
| 5 | 08/05/2005 | | COMP | Application Is Now Complete | | | 0 |
| 6 | 08/04/2005 | | OIPE | Application Dispatched from OIPE | | | 0 |
| 4 | 07/08/2005 | | L198 | Referred to Level 2 (LARS) by OIPE CSR | | | 0 |
| 3 | 07/08/2005 | | CLSS | CASE CLASSIFIED BY OIPE | | | 0 |
| 2 | 07/07/2005 | | SCAN | IFW Scan & PACR Auto Security Review | | | 0 |
| 1 | 06/24/2005 | | IEXX | Initial Exam Team nn | | | 0 |

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P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

| | |
|---|---|
| In re Application of | : DECISION ON APPLICATION FOR |
| Cherian et al. | : PATENT TERM ADJUSTMENT |
| Application No. 11/166,893 | : |
| Filed: June 24, 2005 | : |
| Dkt. No.: 12144-0015001 | : |
| For: PRESERVING SESSIONS IN A | : |
| WIRELESS NETWORK | : |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)," filed December 7, 2011. Applicants submit that the correct patent term adjustment to be indicated on the patent is four hundred eighty-two (482) days, not five hundred forty-seven (547) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

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 482 days is **GRANTED**.

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

Applicants contend an additional reduction of a total of 67 days is warranted for the submission of a supplemental response in the form of information disclosure statements submitted on July 6, 2010 and August 31, 2010.

A review shows that the 67 day reduction for the submission of the information disclosure statements on July 6, 2010 and August 31, 2010 was warranted. 37 CFR §1.704(c)(8) provides that a period of reduction is entered for:

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:

(8) 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;

Further, a review of the IDS filed, confirms that patentees did not include a statement under 37 CFR 1.704(d). In this instance, the 67 day delay is calculated beginning on June 26, 2010 the day after the submission of the response to the Office action on June 25, 2010 and ends on August 31, 2010 the day the supplemental reply, in this instance the IDS was submitted. A 67 day reduction will be entered.

In addition, applicants dispute the 2 day reduction for the submission of a reply, in this instance a Request for Continued Examination (RCE), on June 20, 2011. Applicants state that as intended by 35 U.S.C. §54(b)(2)(c)(ii), the three-month date should be calculated from June 20, 2011, instead of June 18, 2011 as June 18, 2010 falls on a weekend. As such the response submitted on June 20, 2011 should be calculated as 0 days, not 2 days.

Applicants' argument is convincing. Accordingly, the period of reduction of 2 days will be removed.

Applicants' delay as of the mailing of the Notice of Allowance total is 230 days. Office delay as of the mailing of the Notice of Allowance total is 712 days.

In view thereof, the correct determination of PTA at the time of the mailing of the notice of allowance is four hundred eighty-two **(482)** 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 application file 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 the undersigned at (571) 272-3215.

Charlema Grant
Attorney Advisor
Office of Petitions
Enclosure: Copy of REVISED PALM Screen

# Patent Term Adjustments

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

Application Number*: 11166893 Search Explanation of PTA Calculation Explanation of PTE Calculation

## PTA Calculations for Application: 11166893

| | | | |
|---|---|---|---|
| Application Filing Date | 06/24/2005 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 712 |
| A Delays | 712 | PTO Manual Adjustment | -65 |
| B Delays | 0 | Applicant Delay (APPL) | 165 |
| C Delays | 0 | Total PTA (days) | 482 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 181 | 12/14/2011 | | P028 | Adjustment of PTA Calculation by PTO | 2 | | 0 |
| 180 | 12/14/2011 | | P028 | Adjustment of PTA Calculation by PTO | | 67 | 0 |
| 170 | 09/08/2011 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 169 | 09/03/2011 | | OAR | Office Action Review | | | 0 |
| 168 | 09/03/2011 | | OAR | Office Action Review | | | 0 |
| 167 | 09/03/2011 | | IREV | Issue Revision Completed | | | 0 |
| 166 | 09/01/2011 | | OAR | Office Action Review | | | 0 |
| 165 | 09/01/2011 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 164 | 09/01/2011 | | ACRE | Allowed Case Returned to the Examiner for Clerical Processing | | | 0 |
| 163 | 09/01/2011 | | DVER | Document Verification | | | 0 |
| 162 | 08/26/2011 | | CNTA | Allowability Notice | | | 0 |
| 156 | 06/22/2011 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 161 | 06/20/2011 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 159 | 06/20/2011 | | RCAP | Reference capture on IDS | | | 0 |
| 158 | 06/20/2011 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 157 | 06/20/2011 | 06/18/2011 | RCEX | Request for Continued Examination (RCE) | | 2 | 134 |
| 155 | 06/20/2011 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 154 | 06/20/2011 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 160 | 06/15/2011 | | FIDC | Finished Initial Data Capture | | | 0 |
| 153 | 06/14/2011 | | TCPB | Printer Rush- No mailing | | | 0 |
| 152 | 06/13/2011 | | TCPB | Printer Rush- No mailing | | | 0 |
| 151 | 06/13/2011 | | TCPB | Printer Rush- No mailing | | | 0 |
| 150 | 06/10/2011 | | PUBTC | Pubs Case Remand to TC | | | 0 |
| 149 | 05/26/2011 | | QURF | Workflow - Query Request - Finish | | | 0 |
| 148 | 05/26/2011 | | TCPB | Printer Rush- No mailing | | | 0 |
| 147 | 05/26/2011 | | TCPB | Printer Rush- No mailing | | | 0 |
| 146 | 05/23/2011 | | PUBTC | Pubs Case Remand to TC | | | 0 |
| 145 | 05/20/2011 | | TCPB | Printer Rush- No mailing | | | 0 |
| 144 | 05/20/2011 | | TCPB | Printer Rush- No mailing | | | 0 |
| 143 | 05/11/2011 | | PUBTC | Pubs Case Remand to TC | | | 0 |
| 142 | 04/22/2011 | | EML_NTR | Email Notification | | | 0 |
| 141 | 04/22/2011 | | MM327 | Mail Miscellaneous Communication to Applicant | | | 0 |
| 140 | 04/20/2011 | | M327 | Miscellaneous Communication to Applicant - No Action Count | | | 0 |
| 139 | 03/22/2011 | | EIDC | Export to Initial Data Capture | | | 0 |
| 138 | 03/18/2011 | | ELC_RVW | Electronic Review | | | 0 |
| 137 | 03/18/2011 | | EML_NTR | Email Notification | | | 0 |
| 136 | 03/18/2011 | | EML_NTF | Email Notification | | | 0 |
| 135 | 03/18/2011 | | MEX.A | Mail Examiner's Amendment | | | 0 |
| 134 | 03/18/2011 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 133 | 03/16/2011 | | IREV | Issue Revision Completed | | | 0 |
| 132 | 03/10/2011 | | ACRE | Allowed Case Returned to the Examiner for Clerical Processing | | | 0 |
| 131 | 03/10/2011 | | DVER | Document Verification | | | 0 |
| 130 | 03/10/2011 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 129 | 03/08/2011 | | EX.A | Examiner's Amendment Communication | | | 0 |
| 128 | 03/08/2011 | | CNTA | Allowability Notice | | | 0 |
| 123 | 01/09/2011 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 124 | 01/03/2011 | | LET. | Miscellaneous Incoming Letter | | | 0 |
| 122 | 01/03/2011 | 12/02/2010 | A... | Response after Non-Final Action | | 32 | 110 |
| 121 | 01/03/2011 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 120 | 12/17/2010 | | EML_NTR | Email Notification | | | 0 |
| 119 | 12/17/2010 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 118 | 12/09/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 125 | 09/30/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 116 | 09/30/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 115 | 09/02/2010 | | ELC_RVW | Electronic Review | | | 0 |

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|---|---|---|---|---|---|---|---|
| 112 | 09/02/2010 | | EML_NTF | Email Notification | | | 0 |
| 110 | 09/02/2010 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 126 | 08/31/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 114 | 08/31/2010 | | RCAP | Reference capture on IDS | | | 0 |
| 113 | 08/31/2010 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 111 | 08/31/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 109 | 08/30/2010 | | CTNF | Non-Final Rejection | | | 0 |
| 107 | 07/06/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 106 | 07/06/2010 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 105 | 07/06/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 104 | 06/30/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 101 | 06/30/2010 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 98 | 06/30/2010 | | EML_NTR | Email Notification | | | 0 |
| 97 | 06/30/2010 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 108 | 06/25/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 103 | 06/25/2010 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 102 | 06/25/2010 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 100 | 06/25/2010 | | RCAP | Reference capture on IDS | | | 0 |
| 99 | 06/25/2010 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 96 | 06/25/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 94 | 06/25/2010 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 95 | 06/22/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 93 | 04/13/2010 | | LET. | Miscellaneous Incoming Letter | | | 0 |
| 92 | 03/25/2010 | | ELC_RVW | Electronic Review | | | 0 |
| 91 | 03/25/2010 | | EML_NTF | Email Notification | | | 0 |
| 90 | 03/25/2010 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 87 | 03/15/2010 | | CTFR | Final Rejection | | | 0 |
| 86 | 01/30/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 82 | 01/30/2010 | 12/01/2009 | M844 | Information Disclosure Statement (IDS) Filed | | 60 | 74 |
| 79 | 01/30/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 75 | 01/20/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 85 | 12/11/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 78 | 12/11/2009 | | RCAP | Reference capture on IDS | | | 0 |
| 77 | 12/11/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 72 | 12/11/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 71 | 12/08/2009 | | EML_NTR | Email Notification | | | 0 |
| 70 | 12/08/2009 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 76 | 12/01/2009 | | LET. | Miscellaneous Incoming Letter | | | 0 |
| 74 | 12/01/2009 | 11/04/2009 | A... | Response after Non-Final Action | | 27 | 64 |
| 73 | 12/01/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 69 | 11/23/2009 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 84 | 11/10/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 81 | 11/10/2009 | | RCAP | Reference capture on IDS | | | 0 |
| 80 | 11/10/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 68 | 11/10/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 89 | 09/21/2009 | | RCAP | Reference capture on IDS | | | 0 |
| 88 | 09/21/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 83 | 09/21/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 67 | 09/21/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 66 | 08/04/2009 | | ELC_RVW | Electronic Review | | | 0 |
| 65 | 08/04/2009 | | EML_NTF | Email Notification | | | 0 |
| 64 | 08/04/2009 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 63 | 07/21/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 62 | 06/18/2009 | | RCAP | Reference capture on IDS | | | 0 |
| 61 | 06/18/2009 | 06/03/2009 | M844 | Information Disclosure Statement (IDS) Filed | | 15 | 50 |
| 57 | 06/18/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 56 | 06/18/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 53 | 06/09/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 51 | 06/09/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 49 | 06/09/2009 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 58 | 06/05/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 54 | 06/05/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 48 | 06/05/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 60 | 06/03/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 59 | 06/03/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 52 | 06/03/2009 | | AMPR | RCE- AF Processed | | | 0 |
| 50 | 06/03/2009 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 47 | 06/03/2009 | | RCAP | Reference capture on IDS | | | 0 |
| 46 | 06/03/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 44 | 06/03/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 43 | 06/03/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 40 | 06/03/2009 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 39 | 05/07/2009 | | EML_NTR | Email Notification | | | 0 |
| 38 | 05/07/2009 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 37 | 05/05/2009 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 36 | 05/02/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 35 | 04/24/2009 | | A.NE | Amendment after Final Rejection | | | 0 |
| 34 | 03/05/2009 | | ELC_RVW | Electronic Review | | | 0 |
| 33 | 03/05/2009 | | EML_NTF | Email Notification | | | 0 |
| 32 | 03/05/2009 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 31 | 03/01/2009 | | CTFR | Final Rejection | | | 0 |
| 28 | 01/07/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 27 | 12/04/2008 | 11/05/2008 | A... | Response after Non-Final Action | | 29 | 24 |
| 26 | 12/04/2008 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 25 | 10/16/2008 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 24 | 08/05/2008 | 08/24/2006 | MCTNF | Mail Non-Final Rejection | 712 | | 0.5 |
| 23 | 08/04/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 19 | 03/24/2008 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 18 | 03/24/2008 | | RCAP | Reference capture on IDS | | | 0 |

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|---|---|---|---|---|
| 17 | 03/24/2008 | M844 | Information Disclosure Statement (IDS) Filed | 0 |
| 16 | 03/24/2008 | WIDS | Information Disclosure Statement (IDS) Filed | 0 |
| 15 | 03/13/2008 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 14 | 10/17/2007 | W525 | Withdraw Flagged for 5/25 | 0 |
| 13 | 10/15/2007 | F525 | Flagged for 5/25 | 0 |
| 12 | 12/28/2006 | PG-ISSUE | PG-Pub Issue Notification | 0 |
| 11 | 03/29/2006 | TSSCOMP | IFW TSS Processing by Tech Center Complete | 0 |
| 10 | 03/29/2006 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 8 | 09/22/2005 | OIPE | Application Dispatched from OIPE | 0 |
| 7 | 09/22/2005 | COMP | Application Is Now Complete | 0 |
| 20 | 09/14/2005 | IDSC | Information Disclosure Statement considered | 0 |
| 9.7 | 09/14/2005 | M844 | Information Disclosure Statement (IDS) Filed | 0 |
| 9 | 09/14/2005 | WIDS | Information Disclosure Statement (IDS) Filed | 0 |
| 6 | 09/14/2005 | ADDFLFEE | Additional Application Filing Fees | 0 |
| 5 | 09/14/2005 | OATHDECL | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | 0 |
| 4 | 07/19/2005 | INCD | Notice Mailed--Application Incomplete--Filing Date Assigned | 0 |
| 3 | 07/12/2005 | L194 | Cleared by OIPE CSR | 0 |
| 2 | 07/08/2005 | SCAN | IFW Scan & PACR Auto Security Review | 0 |
| 1 | 06/24/2005 | IEXX | Initial Exam Team nn | 0 |
| 0.5 | 06/24/2005 | EFILE | Filing date | 0 |

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**1900 K STREET, NW**
**WASHINGTON DC 20006**

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JUL 25 2011
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| | | |
|---|---|---|
| In re Application of | : | |
| Ji Young Ahn | : | |
| Application No. 11/166,918 | : | DECISION GRANTING PETITION |
| Filed: June 27, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 8734.419 US | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, July 21, 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 June 21, 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 Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 2883 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Terri Johnson/
Terri Johnson
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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10518 PHIL PLACE
CUPERTINO CA 95014

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| In re Patent of | : | |
| Madden et al. | : | |
| Application No. 11/166975 | : | DECISION |
| Filing or 371(c) Date: 06/24/2005 | : | ON PETITION |
| Attorney Docket Number: | : | |
| 036284-000003 | : | |

This is a corrected decision on the Petition to Withdraw Holding of Abandonment, filed October 20, 2011. The petition is properly treated under 37 CFR 1.181.

The petition is **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed December 11, 2007, wherein the Examiner rejected claims 1-10. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a).

Applicant filed a Notice of Appeal in response to the Office action on March 17, 2008, and Appeal Brief on April 28, 2008. The Examiner filed an Answer on June 24, 2008. The case was set before the Board of patent Appeals and interferences ("Board"), which affirmed the Examiner in a Decision mailed July 13, 2011.

The present petition

Applicant files the present petition and avers that a timely Request for Rehearing was filed, and acted upon by Board on October 20, 2011, and pursuant to 37 CFR 1.304 applicant has two (2) months after action on the request to file an appeal or commence a civil action. In view thereof, Applicant contends that Notice of Abandonment was issued prematurely.

Analysis and decision

A review of Office records confirms that Applicant filed a Request for Rehearing on September 13, 2011, and the Board acted on the request in a Decision mailed September 21, 2011.

In view of the above, the petition to withdraw the holding of abandonment is granted.

The application is being returned to Technology Center 2628 to withdraw the holding of abandonment and await applicant's reply to the Decision of the Board, mailed September 21, 2011[1].

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

/DLW/

Derek L. Woods
Attorney
Office of Petitions

[1] The MPEP 1214.06 further provides:

The time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the District of Columbia is the same for both tribunals, that is, 2 months, or 2 months with the extension provided by 37 CFR 1.304 in the event a request for rehearing is timely filed before the Board, or as extended by the Director. See MPEP § 1216. When the time for seeking court review (***plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner***) has passed without such review being sought, the examiner must take up the application for consideration. The situations which can arise will involve one or more of the following circumstances:

I. NO CLAIMS STAND ALLOWED
The proceedings in an application or ex parte reexamination proceeding are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files."

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MILWAUKEE WI 53202-5306

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OFFICE OF PETITIONS

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| In re Application of | : | |
| Hunter, et al. | : | |
| Application No. 11/167,068 | : | ON REQUEST FOR |
| Filed: June 24, 2005 | : | RECONSIDERATION OF |
| Attorney Docket Number: 037607-0334 | : | PATENT TERM ADJUSTMENT |

This is a decision on the petition under 37 CFR 1.705(b), filed June 3, 2010. Applicants believe that they should be accorded an additional PTA of 217 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 at the time of the mailing of the Notice of Allowance is **seven hundred thirty-two (732) days** (732 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.

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**Margaret Anderson**
**106 E. 6th Street, Suite 900**
**Austin TX 78701**

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

| | | |
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| In re Application of | : | |
| **ALEXANDER J. COHNE, ET AL.** | : | |
| Application No. 11/167,072 | : | DECISION ON PETITION |
| Filed: June 24, 2005 | : | TO WITHDRAW |
| Attorney Docket No. **QQ1-148US** | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed January 27, 2011.

The request is **NOT APPROVED**.

The request cannot be approved because the Office no longer accept address changes to a new practitioner/customer number or law firm filed with a request, absent the filing of a power of attorney to the new representative.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71* or, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

A courtesy copy of this decision is being mailed to the address on the request. However, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: LEE & HAYE, PLLC
601 W RIVERSIDE
SUITE 1400
SPOKANE, WA 99201

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**SCOTIA PLAZA**
**40 KING STREET WEST, SUITE 5800**
**TORONTO ON M5H 3S1 CA CANADA**

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AUG 04 2010

OFFICE OF PETITIONS

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| In re Application of | : | |
| Terry Cassaday | : | |
| Application No. 11/167,082 | : | DECISION ON PETITION |
| Filed: June 28, 2005 | : | |
| Attorney Docket No. 56836.46/ejag | : | |

This is a decision on the petition, filed June 14, 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 Requiring Excess Claims Fees mailed September 8, 2009, 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 October 9, 2009. A Notice of Abandonment was mailed March 25, 2010.

Petitioner asserts that the Notice dated September 8, 2009 was not received.

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

1. a statement from practitioner stating that the Notice 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 Notice was not received; and

3. a copy of the docket record where the nonreceived Notice 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. In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

This application is being referred to Technology Center AU 3735 for appropriate action in the normal course of business on the reply received June 14, 2010.

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

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 07/31/2010. 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: 03-0065 (8470-000106) | |
| Application Number: 11/167,458 | Filing Date (or 371(b) or (f) Date): June 27, 2005 |
| Patent Number: 7,658,387 | Issue Date: February 9, 2010 |
| First Named Inventor: PARK, Edward H. | |
| Title: REINFORCED ELASTOMERIC SEAL | |

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 | Date August 6, 2010 |
| Name (Print/Typed) David L. Suter | Registration Number 30692 |

***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 10 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

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PLYMOUTH, MI 48170-2455

Mail Date: 08/12/2010

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|---|---|---|
| **Applicant** | : Edward Hosung Park | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7658387 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/167,458 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/27/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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c/o CPA Global
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In re Application of
Solomon B. Trainin et al.
Application No. 11/167,491
Filed: June 27, 2005
Attorney Docket No. **P21728**

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 5, 2011, to revive the above-identified application.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, July 1, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 2, 2008.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee 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 JoAnne Burke at (571) 272-4584.

This application is being referred to Technology Center AU 2112 for appropriate action by the Examiner in the normal course of business on the reply received.

JoAnne Burke
Petitions Examiner
Office of Petitions

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**MCDERMOTT WILL & EMERY LLP**
**600 13TH STREET, N.W.**
**WASHINGTON, DC 20005-3096**

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**MAR 14 2011**
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| In re Application of | : | |
| **Seigo NAKAO**, et *al.* | : | |
| Application No. 11/167,577 | : | DECISION GRANTING PETITION |
| Filed: June 28, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. **065933-0178** | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 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 on February 4, 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 2463 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

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

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

| 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 | 11167577 |
| Filing Date | 28-Jun-2005 |
| First Named Inventor | Seigo Nakao |
| Art Unit | 2463 |
| Examiner Name | ANGEL BROCKMAN |
| Attorney Docket Number | 065933-0178 |
| Title | METHOD AND APPARATUS FOR TRANSMITTING SIGNALS, AND METHOD AND APPARATUS FOR RECEIVING THE SIGNALS |

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 | /Stephen A. Becker/ |
| Name | Stephen A. Becker |
| Registration Number | 26527 |

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 24,2011

In re Application of :

Seigo Nakao

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 11167577

Filed : 28-Jun-2005

Attorney Docket No : 065933-0178

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed May 24,2011 , 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 2463 for processing of the request for continuing examination under 37 CFR 1.114 .

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**STAINBROOK & STAINBROOK, LLP**
**412 AVIATION BOULEVARD**
**SUITE H**
**SANTA ROSA CA 95403**

MAILED
MAY 19 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gregory Gene Steiner | : | |
| Application No. 11/167,739 | : | DECISION ON PETITION |
| Filed: June 25, 2005 | : | |
| Attorney Docket No. 01193.P2US | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 11, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The 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 June 24, 2009. A three month extension of time under the provisions of 37 CFR 1.136(a) was obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 41.37(b). As no claim was allowed, the application became abandoned on August 25, 2009. See MPEP 1215.04. A Notice of Abandonment was mailed November 17, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of RCE (Request for Continued Examination), with the required fee of $405, (2) the petition fee of $810, 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 the Technology Center AU 1614 for appropriate action in the normal course of business for processing of the RCE received April 11, 2011.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : **01/12/11**

**TO SPE OF** : ART UNIT **3673**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **11167824** Patent No.: **7775566**

**CofC mailroom date:**
**12/29/10**

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**
[redacted]

*Lamonte Newsome*
**Certificates of Correction Branch**
**571-272-3421**

**Thank You For Your Assistance**

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

| | |
|---|---|
| **xApproved** | **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

/Peter M. Cuomo/ SPE AU 3673

SPE Art Unit

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**CASIMIR JONES, S.C.**
**2275 DEMING WAY, SUITE 310**
**MIDDLETON WI 53562**

**MAILED**
OCT 26 2011
**OFFICE OF PETITIONS**

In re Patent No. 7,727,719 :
Issued: June 1, 2010 :
Application No. 11/167,838 : ON PETITION
Filed: June 27, 2005 :
Attorney Docket No. UM-09965 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed September 23, 2011.

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

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

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

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

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

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

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**CASIMIR JONES, S.C.**
**2275 DEMING WAY, SUITE 310**
**MIDDLETON WI 53562**

**MAILED**
NOV 02 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,727,719 | : | |
| Application No. 11/167,838 | : | |
| Filed: June 27, 2005 | : | ON PETITION |
| Issued: June 1, 2010 | : | |
| Attorney Docket No. UM-09965 | : | |

This is a decision on the petition, filed October 5, 2011, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee on the issued patent.

The request is **DISMISSED.**

37 CFR 3.81(a) permits the patent to issue to the assignee, provided that, at the time the issue fee is paid the name and correct address of an assignee is provided. 37 CFR 3.81(b) permits the patent to issue in the name and correct address of an assignee if the assignment was submitted after payment of the issue fee ***but prior to issuance of a patent***. Patent and Trademark Office assignment records disclose that the most current assignment recorded September 14, 2011, Reel 026905 and Frame 0278 states the assignee's name as "THE UNITED STATES GOVERNMENT AS REPRESENTED BY THE DEPARTMENT OF VETERANS AFFAIRS". Therefore, the assignment recorded on September 14, 2011, is after the date of issuance of this patent.

Accordingly, since the assignment was not submitted for recordation until after issuance of this patent, issuance of a certificate of correction would not be proper. See MPEP Section 307.

Additionally, the required $130.00 surcharge fee will be charged to petitioner's deposit account as authorized October 5, 2011.

Inquiries 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

Commissioner for Patents
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P.O. Box 1450
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FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

MAILED
APR 25 2011
OFFICE OF PETITIONS

In re Patent of Stanfill et al.:
Patent No. 7,877,350 :
Issued: January 25, 2011 :
Application No. 11/167,902 : ON APPLICATION FOR
Filed: June 27, 2005 : PATENT TERM ADJUSTMENT
Atty Docket No. 07470-089001 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(d)," filed March 24, 2011. Patentees request 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 is **DISMISSED**.

Patentees argue that the Director erred in the calculation of patent term adjustment by subtracting from the period of B Delay a period of time that was not "consumed by continued examination of the application." The first Request for Continued Examination (RCE) was filed on August 7, 2008. On July 13, 2010, the Office mailed a Notice of Allowance. Patentees argue no continued examination took place during the 197 day period from July 13, 2010(the mailing date of the Notice of Allowance) until January 25, 2011 (the date the patent issued). Thus, patentee argues 197 days should have been added to the 40 days accorded by the Director for the B Delay period (beginning June 28, 2008 and ending on August 6, 2008, the day before the first RCE was filed).

Patentees' argument has been considered, but has not been found to be persuasive. 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)."

Per the language of 37 CFR 1.703(b)(1):

> (b) 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;

As stated above, the number of days beginning on the date a RCE was filed and ending on the issuance date of the patent are not included in the B Delay period. The maximum B Delay in this case is 40 days, which is the number of days beginning on June 28, 2008, the day after the date three years after application's the filing date, and ending on August 6, 2008, the day *before* the date the first RCE was filed. The filing of the first RCE cuts off accumulation of any additional period of adjustment for the over three year calculation. All days from the date the first RCE was filed to the date of issuance are not included, per 37 CFR 1.703(b)(1).

The patent term adjustment remains 216 days, which is the sum of 374 days of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") and 40 days of B Delay, reduced by 198 days of Applicant delay.

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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AUG 25 2011

OFFICE OF PETITIONS

FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

| | | |
|---|---|---|
| In re Patent of Stanfill et al. | : | FINAL AGENCY DECISION |
| Patent No. 7,877,350 | : | ON |
| Issue Date: January 25, 2011 | : | REQUEST FOR RECONSIDERATION |
| Application No. 11/167,902 | : | OF |
| Filed: June 27, 2005 | : | DECISION ON APPLICATION |
| Attny. docket no.: 07470-089001 | : | FOR |
| For: MANAGING METADATA FOR GRAPH-BASED COMPUTATIONS | : | PATENT TERM ADJUSTMENT |

This is a decision on the "RESPONSE TO DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT" filed June 27, 2011, requesting reconsideration of the decision of April 25, 2011, and requesting that the patent term adjustment determination under 35 U.S.C. § 154(b) in the decision of April 25, 2011, be changed from 216 days to 413 days.

Patentees request that the decision on this renewed request for reconsideration of patent term adjustment be deferred or delayed until a final decision has been rendered in Abbott Biotherapeutics Corp. v. Kappos. There is no specific regulatory provision for requesting that a petition under 37 CFR 1.705(d) be held in abeyance.

The request for reconsideration of the decision of April 25, 2011, is granted to the extent that the decision of April 25, 2011, has been reconsidered; however, the request for reconsideration is **DENIED** with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of 216 days indicated in the decision of April 25, 2011. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. 704 and for purposes of seeking judicial review. See MPEP §1002.02.

**BACKGROUND**

On January 25, 2011, the above-identified application matured into U.S. Patent No. 7,877,350, with a revised patent term adjustment of 216 days. On March 24, 2011, Patentees timely submitted a petition for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 413 days. On April 25, 2011, the Office mailed a decision indicating the patent term adjustment is 216 days and affording Patentees with a 30 day/1 month period to contest the decision. Patentees timely filed the present petition on June 27, 2011. Patentees maintain that the Office incorrectly calculated Office delay pursuant to 37 CFR 1.702(b). Patentees contend that the Office erred in subtracting from the "B delay" a period of time that was not "consumed by continued examination of the application." Specifically, Patentees argue that (after the filing of a request for continued examination) the Office mailed a Notice of Allowance on July 13, 2010, thereby closing examination of the application on that date. Thus, Patentees argue no continued examination took place during the 197 day period from July 13, 2010 (the mailing date of the Notice of Allowance) until January 25, 2011 (the date the patent was issued). As such, Patentees maintain that the "B delay" should include the 197 days and be increased from 40 to 237 days. Patentees conclude that the correct patent term adjustment is 413 days (the sum of 374 days of "A delay" and 237 days of "B delay" minus 198 days of Applicant delay).

**RELEVANT STATUTE AND REGULATIONS**

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including –

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(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), 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.

The implementing regulation, 37 CFR 1.702(b) provides that:

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);

(2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);

(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;

(4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

**OPINION**

Patentees' arguments have been considered, but not found persuasive. The Office calculated the period of "B delay" pursuant to 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.702(b)(1) as 40 days based on the application having been filed under 35 U.S.C. 111(a) on June 27, 2005 and the patent not having issued as of the day after the three year date, June 28, 2008, and a request for continued examination being filed on August 7, 2008. In other words, the 197-day period beginning on the date of mailing of the notice of allowance to the date of issuance of the patent was considered time consumed by continued examination of an application under 35 U.S.C. 132(b) and was not included in the "B delay."

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.

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

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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.

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.

Patentees' 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

[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

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.

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.

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more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

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 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

[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.

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 August 7, 2008, and the patent issued by virtue of that request on January 25, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on July 13, 2010 and ending on January 25, 2011 is not included in calculating Office delay.

**CONCLUSION**

Accordingly, the decision on application for patent term adjustment has been reconsidered and the request for additional patent term is **DENIED**.

The patent term adjustment remains 216 days, as indicated in the decision of April 25, 2011 and the issued patent.

Deposit account no. 06-1050 will be refunded the $200.00 petition fee submitted with the instant petition, as Patentees have previously paid the $200.00 petition fee on March 24, 2011.

Telephone inquiries specific to this matter should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.

Anthony Knight
Director, Office of Petitions

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FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

**MAILED**
DEC 07 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent of Stanfill et al. | : | |
| Patent No. 7,877,350 | : | |
| Issue Date: January 25, 2011 | : | FINAL AGENCY DECISION |
| Application No. 11/167,902 | : | ON REQUEST TO INVOKE THE |
| Filed: June 27, 2005 | : | SUPERVISORY AUTHORITY |
| Attny. docket no.: 07470-089001 | : | OF THE DIRECTOR |
| For: MANAGING METADATA FOR | : | |
| GRAPH-BASED COMPUTATIONS | : | |

This is a decision on the petition captioned," PETITION UNDER 37 C.F.R. § 1.181(a)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR," filed October 25, 2011, requesting that the Director review the Final Agency Decision on Request for Reconsideration of Decision on Application for Patent Term Adjustment ("Decision") mailed by the Office of Petitions on August 25, 2011.

The Decision maintains that the above-identified patent is entitled to two hundred sixteen (216) days of patent term adjustment ("PTA"). Patentees request that the Director review the decision and modify the PTA calculation to four hundred thirteen (413) days.

The decision of the Director of the Office of Petitions has been reviewed. However, because no error has been found in the decision, the petition under 37 CFR § 1.181 is **DENIED**.

The patent term adjustment remains 216 days, as indicated in the final agency action of August 25, 2011 and the issued patent.

Andrew Hirshfeld
Associate Commissioner for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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**KANG INTELLECTUAL PROPERTY LAW, LLC**
**214 ELM STREET, SUITE 106**
**WASHINGTON, MO 63090**

**MAILED**

**AUG 30 2010**

**OFFICE OF PETITIONS**

| | | |
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| In re Application of | : | |
| **Veit STOSSEL**, et *al.* | : | |
| Application No. 11/168,022 | : | DECISION ON REQUEST FOR |
| Filed: June 28, 2005 | : | REVOCATION OF POWER |
| Attorney Docket No. **41587-382** | : | OF ATTORNEY |

This is a decision on the Request to Revoke the attorney or agent of record under 37 C.F.R. § 1.36(a), filed December 17, 2009.

The request is **APPROVED**.

A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceeding of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant under § 3.71(b). Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth § 1.17(h). For the assignee to take action a proper statement under § 3.73(b) is required.

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

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

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

cc: **MICHAEL BEST & FRIEDRICH LLP**
**TWO PRUDENTIAL PLAZA**
**180 NORTH STETSON AVENUE, SUITE 2000**
**CHICAGO, IL 60601**

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United States Patent and Trademark Office
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**MICHAEL BEST & FRIEDRICH LLP**
**TWO PRUDENTIAL PLAZA**
**180 NORTH STETSON AVENUE, SUITE 2000**
**CHICAGO, IL 60601**

**MAILED**

**AUG 30 2010**

**OFFICE OF PETITIONS**

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|---|---|---|
| In re Application of | : | |
| **Veit STOSSEL**, et *al.* | : | |
| Application No. 11/168,022 | : | DECISION ON PETITION |
| Filed: June 28, 2005 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. **41587-382** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 17, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, December 8, 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 9, 2009.

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 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) an adequate statement of unintentional delay.

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

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 3656 for appropriate action by the Examiner in the normal course of business on the reply received December 17, 2009.

Thurman K. Page
Petitions Examiner
Office of Petitions

cc: **GENE B. KARTCHNER**
**LEGGETT & PLATT, INC.**
**NO. 1 LEGGET ROAD**
**CARTHAGE, MO 64836**

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**THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP**
**600 GALLERIA PARKWAY, S.E.**
**STE 1500**
**ATLANTA GA 30339-5994**

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OFFICE OF PETITIONS

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| In re Application of | : | |
| Ayazi et al. | : | |
| Application No. 11/168,066 | : | ON PETITION |
| Filed: June 28, 2005 | : | |
| Attorney Docket No. 062012-1940 (GT No. 3218) | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed August 3, 2010, to revive the above-identified application.

The petition is **GRANTED**.

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

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 2811 for further examination on the merits.

Liana Walsh

Liana Walsh
Petitions Examiner
Office of Petitions

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PETER G. CARROLL
MEDLEN & CARROLL, LLP
Suite 350
101 Howard Street
San Francisco CA 941

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OFFICE OF PETITIONS

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| In re Application of | : | |
| Handique et al. | : | |
| Application No.: 11/168144 | : | DECISION ON |
| Filing or 371(c) Date: 06/28/2005 | : | PETITION |
| Title of Invention: | : | |
| MOVING MICRODROPLETS | : | |

This is a decision in response to the Petition to Revive an Unavoidably Abandoned Application Under 37 CFR 1.137(a), filed October 13, 2011.

This Petition is hereby **dismissed**.

Any further petition 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 [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the Office communication, mailed February 16, 2011. The Notice set a one (1) month or 30 day period for reply, whichever was longer, from the mail date of the Office communication. Extensions of time were available under 37 CFR 1.136(a). No reply having been received, the application became abandoned on March 17, 2011. A Notice of Abandonment was mailed September 15, 2011.

The present petition

Applicants file the present petition and assert that the Office communication was not received. In support of Applicants' assertion, Applicants file a copy of their PTO Communications Logs as received for docketing, for the period between February 16, 2011 and March 16, 2011, to illustrate nonreceipt of the Office communication.

A Grantable Petition Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of

a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); **(2)** the petition fee as set forth in 37 CFR 1.17(l); **(3)** a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and **(4)** any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). Applicant lacks item **(3)**.

As to item **(3)**, a showing of non-receipt of an Office communication may form the basis for revival of an application based upon unavoidable delay.

Applicable Law, Rules and MPEP

The MPEP 711.03(c)A, provides in relevant part:

> The showing required to establish nonreceipt of an Office communication must include
>
> (1) a statement from the practitioner stating that the Office communication was not received by the practitioner at the correspondence address of record. 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.
>
> (2) a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.
>
> (3) a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. 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.

MPEP 711.03(c)

Analysis and conclusion

Regrettably the petition is not grantable at this time. To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office

action. In addition to the statement from practitioner (applicant) attesting to non-receipt of the Notice, **Applicant must provide 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 a copy of the file jacket and docket records where the nonreceived Notice would have been entered had it been received and docketed.** As stated above, a copy of the practitioner's (applicant's) record(s) required to show non-receipt of the Office action should include a copy of 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 (i.e. March 16, 2011) three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. **If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question**.

The petition is dismissed without prejudice. Applicant should file a Request for Reconsideration of Petition and include the necessary statements and/or copies of docket records and/or file jacket.

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

By mail: Director 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 concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

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Suite 350
101 Howard Street
San Francisco CA 94103

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| In re Application of | : | |
| Handique et al. | : | |
| Application No.: 11/168144 | : | DECISION ON |
| Filing or 371(c) Date: 06/28/2005 | : | PETITION |
| Title of Invention: | : | |
| MOVING MICRODROPLETS | : | |

This is a decision in response to the Renewed Petition under 37 CFR 1.137(a), for revival of an application for patent abandoned unavoidably, filed December 29, 2011, to revive the above-identified application.

This Petition is hereby granted.

The above-identified application became abandoned for failure to timely and properly reply to the Office communication, mailed February 16, 2011. The Office communication set a one (1) month period for reply. Extensions of time were available under 37 CFR 1.136(a).

No reply having been received, the application became abandoned on March 17, 2011. A Notice of Abandonment was mailed September 15, 2011.

The petition satisfies the requirements of 37 CFR 1.137(a) in that petitioner has supplied (1) the required reply; (2) the petition fee; and (3) a showing to the satisfaction of the Director that the entire delay was unavoidable.

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.

The application will be referred to Technology Center Art Unit 1773 for processing of the reply filed with the petition 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

CC: MEDLEN & CARROLL, LLP
Suite 340
703 Market Street
San Francisco CA 94103

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PEDERSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS MN 55402-2100

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FEB 10 2011

OFFICE OF PETITIONS

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| In re Application of | : | |
| Rossing et al. | : | |
| Application No. 11/168231 | : | DECISION |
| Filing or 371(c) Date: 06/27/2005 | : | ON PETITION |
| Attorney Docket Number: 3511.505US02 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 12, 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 13, 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). Accordingly, the date of abandonment of this application is October 14, 2010[1].

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), the RCE fee, and an Amendment filed October 13, 2010 as the submission required by 37 CFR 1.114; (2) the petition fee; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 3762 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted with the petition in accordance with 37 CFR 1.114.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

[1] Applicant filed an amendment in response to the Office action on October 13, 2010; however, the amendment failed to place the application in condition for allowance.

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**Zilka-Kotab, PC**
**P.O. Box 721120**
**San Jose, CA 95172-1120**

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OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Ryan S. Russell | : | |
| Application No. 11,168,241 | : | DECISION ON PETITION |
| Filed: June 27, 2005 | : | TO WITHDRAW |
| Attorney Docket No. NAI1P433/05.012.01 | : | 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 February 24, 2011.

The request is **moot because a revocation of power of attorney has been filed.**

A review of the file record indicates that the power of attorney to Zilka-Kotab, PC, has been revoked by the assignee of the patent application on March 28, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: McAfee-Wong Cabello, Lutsch Rutherford
& Brucculeri LLP
20333 Tomball Parkway, 6th Floor
Houston, TX 77070

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**AT&T Legal Department - CC**
**Attn: Patent Docketing**
**Room 2A-207**
**One AT&T Way**
**Bedminster NJ 07921**

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|---|---|---|
| In re Application of | : | |
| Jorey M. Pascasio Jr., et al. | : | |
| Application No. 11/168,248 | : | DECISION ON PETITION |
| Filed: June 27, 2005 | : | |
| Attorney Docket No. 8285/741 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 10, 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 September 1, 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 2, 2009. A Notice of Abandonment was mailed on April 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.

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 regarding this decision should be directed to the Kimberly Inabinet at (571) 272-4618.

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

This application is being referred to Technology Center AU 2465 for appropriate action by the Examiner in the normal course of business on the reply received August 10, 2010.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Xiaolei D. Sun
Wolff & Samson, P.C.,
One Boland Drive
West Orange, NJ 07052

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**NATH & ASSOCIATES**
**112 SOUTH WEST STREET**
**ALEXANDRIA, VA 22314**

| | | |
|---|---|---|
| In re Application of | : | |
| ZUGAZ FERNANDEZ | : | |
| Application No. 11/168,537 | : | ON PETITION |
| Filed: June 29, 2005 | : | |
| Attorney Docket No. 26846U | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 17, 2011.

The petition is **DISMISSED**.

The application became abandoned for failure to submit corrected drawings in a timely manner in reply to the Notice of Allowability (Notice), mailed December 10, 2007, which set a period for reply of three (3) months. Accordingly, this application became abandoned on March 11, 2008.

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

With respect to item (1): The drawing filed with the petition dated February 17, 2011, is not accepted by the examiner because it fails to show the structure where elements 2 and 3 are mounted. Please see the Notice dated December 10, 2007 and direct any questions to the Examiner at (575) 272-7058. In this regard, the petition cannot be accepted at this time as being in compliance with 37 CFR 1.137(b).

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

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**NATH & ASSOCIATES**
**112 SOUTH WEST STREET**
**ALEXANDRIA, VA 22314**

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JUN 17 2011
OFFICE OF PETITIONS

In re Application of :
ZUGAZ FERNANDEZ :
Application No. 11/168,537 : ON PETITION
Filed: June 29, 2005 :
Attorney Docket No. 26846U :

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed May 16, 2011.

The petition is **GRANTED**.

The application became abandoned for failure to submit corrected drawings in a timely manner in reply to the Notice of Allowability (Notice), mailed December 10, 2007, which set a period for reply of three (3) months. Accordingly, this application became abandoned on March 11, 2008. A Notice of Abandonment was mailed May 16, 2008.

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

The corrected drawings filed with the renewed petition on May 16, 2011, were accepted. The Amendment filed with the petition has been acknowledged.

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

The application is being referred to Technology Center AU 3673 for consideration of the Amendment.

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

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**THE NATH LAW GROUP**
**112 SOUTH WEST STREET**
**ALEXANDRIA VA 22314**

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AUG 29 2011

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| | | |
|---|---|---|
| In re Application of | : | |
| Zugaza Fernandez | : | |
| Application No. 11/168,537 | : | DECISION ON REQUEST FOR REFUND |
| Filed: June 29, 2005 | : | |
| Attorney Docket No. 26846U | : | |

This is a decision on the Request For Refund filed August 15, 2011.

The request is **GRANTED**.

Applicant files the above request for refund and states that "The request for refund of $810.00 is made for a refund of the petition fee which was paid as required by the Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b). Petitioner filed a Petition to Revive on February 17, 2011, with the petition fee of $810.00. Due to a dismissal of this petition, Petitioner filed a renewed Petition to Revive on May 16, 2011, along with an additional petition fee of $810.00. The renewed Petition was granted."

A review of Office finance records for the above-identified application show that a duplicate fee was indeed paid on May 16, 2011. Therefore, a total of $810.00 is being refunded to petitioner's credit card account as it is the method in which the fee was paid.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON TX 77057-2631

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|---|---|
| In re Application of | : |
| Dodge | : DECISION ON PETITION |
| Application No. 11/168,783 | : |
| Filed: June 28, 2005 | : |
| Atty. Dkt. No.: ITO.0609US (P21862) | : |

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed March 6, 2012.

The Notice mailed March 5, 2012 indicates that the application is abandoned as a consequence of the decision mailed February 28, 2012 by the Board of Patent Appeals and Interferences (Board).

As the two month time period for applicant to take action subsequent to the decision by the Board of Patent Appeals and Interferences, the Notice of Abandonment mailed March 5, 2012 was prematurely mailed. In accordance with 37 CFR 41.54, this application will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the proceeding may require, to carry into effect the Board decision.

In view thereof, the holding of abandonment is hereby WITHDRAWN and the Notice of Abandonment is VACATED.

Accordingly, the petition to withdraw the holding of abandonment under 37 CFR 1.181 is hereby GRANTED.

The application file is being forwarded to the Group Art Unit 2893 to await further action by applicant.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Attorney Advisor
Office of Petitions

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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

| | | |
|---|---|---|
| In re Application of | : | |
| Robert M. Nickerson, et al. | : | |
| Application No. 11/168,784 | : | DECISION ON PETITION |
| Filed: June 28, 2005 | : | |
| Attorney Docket No.: ITL.1291US (P21730) | : | |

This is a decision on the petition, filed June 22, 2011, under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

A review of the record discloses that the application was held abandoned for a failure to take appropriate action in a timely manner after the decision of May 11, 2011 by the Board of Patent Appeals and Interferences. A Notice of Abandonment was mailed on May 23, 2011. On June 22, 2011, the present petition was filed, wherein petitioner argues that the Notice of Abandonment issued is error. Petitioner explains that in view of the decision by the Board on May 11, 2011, petitioner had until July 11, 2011 to appeal to the Court of Appeals or request reconsideration. The present petition includes a request for reconsideration.

A review of the record confirms that petitioner is correct. In view of 37 CFR 1.304, petitioner had two (2) months to respond to the decision by the Board. The Office concedes that the Notice of Abandonment was mailed in error. Accordingly, the Notice of Abandonment mailed May 23, 2011 is hereby vacated.

The application is being referred to the Technology Center technical support staff of Art Unit 2826 for withdrawing the holding of abandonment and for appropriate action by the Examiner in the normal course of business on the response filed June 22, 2011.

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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PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH NJ 07033-0530

| | | |
|---|---|---|
| In re Patent No. 7,763,613 | : | DECISION ON REQUEST |
| Josien | : | FOR |
| Issue Date: July 27, 2010 | : | RECONSIDERATION OF |
| Application No. 11/168,797 | : | PATENT TERM ADJUSTMENT |
| Filed: June 28, 2005 | : | and |
| Atty Docket No. CN06156US01 | : | 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 September 27, 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 nine hundred and fifteen (915) 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 and sixty-five (965) days is **GRANTED to the extent indicated herein.**

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

Application no. 11/168,797 matured into U.S. patent no. 7,763,613 on July 27, 2010, with a patent term adjustment of 916 days.

The Office agrees with Patentee's assertion that the over three year period begins on June 29, 2008.

The period of examination delay totals 566 days (417 + 19 + 130).[1]

The period of applicant delay totals 186 (58 + 58 + 70) days. The Office calculated the period of delay that is associated with the filing of the Rule 1.48 petition on November 19, 2009 to be 120 days, pursuant to 37 C.F.R. § 1.704(c)(10)(ii), as the period was calculated as terminating with the issuance of this patent. This was erroneous, as the period should have been calculated as terminating with the mailing of the communication of January 27, 2010. It follows that the period of patent term reduction should be 70 (not 120) days, pursuant to 37 C.F.R. § 1.704(c)(10)(i).

The 120-day reduction has been removed, and a reduction of 70 days has been entered.

The period of exclusion due to the appellate process totals 25 days: a notice of appeal was filed on July 31, 2009, and a notice of allowance was mailed on August 24, 2009. The 25 days of the over three year period consumed by appellate review, beginning on July 31, 2009 and ending on August 24, 2009, are not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii).

The period of overlap totals 149 (19 + 130) days.

As such, the period of B-delay totals 585 (759 over three years minus 25 excluded period minus 149 overlap) days.

It follows that the patent term adjustment is 965 (566 examination delay plus 585 B-delay minus 186 applicant delay) 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 **nine hundred and sixty-five (965)** days.

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[1] It is noted that the PAIR calculations do not show the 19-day adjustment that is associated with the mailing of the office communication on November 14, 2008 or the 130-day adjustment that is associated with the issuance of this patent.

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 : 7,763,613 B2

DATED : **July 27, 2010** **DRAFT**

INVENTOR(S) : Josien

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 916 days

Delete the phrase "by 916 days" and insert – by 965 days--

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P.O. BOX 10395
CHICAGO, IL 60610

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| | | |
|---|---|---|
| In re Patent of Oh | : | DECISION ON REQUEST |
| Patent No. 7,573,443 | : | FOR RECONSIDERATION OF |
| Issue Date: August 11, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/168,951 | : | |
| Filing Date: June 28, 2005 | : | |
| Attorney Docket No. 12972-5187 | : | |

This decision is in response to the "Second Request for Reconsideration of Patent Term Adjustment" filed May 20, 2010, stating the correct patent term adjustment is nine hundred ten (910) days.

The request for reconsideration of the patent term adjustment is **GRANTED**.

The patent issued August 4, 2009. The patent term adjustment indicated in the patent was 675 days.

A request for reconsideration of the patent term adjustment under 37 C.F.R. § 1.705(d) was filed October 5, 2009.

A "Request for Recalculation of Patent Term Adjustment in View of *Wyeth*" was filed February 1, 2010.

On March 8, 2010, the Office issued a decision in response to the October 5, 2009 request. The decision stated a certificate of correction would be issued indicating the term of the patent is extended or adjusted by nine hundred ten (910) days.

On April 13, 2010, the Office issued a certificate of correction indicating the term of the patent is extended or adjusted by nine hundred ten (910) days.

On April 21, 2010, the Office issued a decision in response to the February 1, 2010 request. The decision indicated the Office would be issuing a certificate of correction indicating the term of the patent is extended or adjusted by one thousand one hundred sixty (1,160) days.

The instant request was filed May 20, 2010, and asserts the correct number of days of patent term adjustment is 910 days.

The Office agrees the patent term adjustment is 910 days.

As previously noted, the Office issued a certificate of correction indicating the term of the patent is extended or adjusted by 910 days on April 13, 2010.

The Certificates of Correction Branch will be informed of the instant decision to ensure a certificate of correction indicating a patent term adjustment of 1,160 days is *not* be issued pursuant to the decision mailed April 21, 2010, because the patent term adjustment is 910 days as stated in the certificate of correction issued April 13, 2010.

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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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

| | |
|---|---|
| In re Patent No. 7,483,087 | : DECISION ON REQUEST |
| Jin, et al. | : FOR |
| Issue Date: January 27, 2009 | : RECONSIDERATION OF |
| Application No. 11/169,042 | : PATENT TERM ADJUSTMENT |
| Filed: June 28, 2005 | : and |
| Atty Docket No. **10125-4191** | : NOTICE OF INTENT TO ISSUE |
| | : CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on March 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 eight hundred eighty-two (882) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by eight hundred eighty-two (882) days is **GRANTED.**

Deposit account 23-1925 will be charged $200.00 for the fee set forth in 37 CFR 1.18(e). No additional fees are required.

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 Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by eight hundred eighty-two (882) 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 : 7,483,087 B2

DATED : Jan. 27, 2009

INVENTOR(S) : Jin, 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 (669) days

Delete the phrase "by 669 days" and insert – by 882 days--

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FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

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|---|---|
| In re Patent No. 7,865,684<br>Michaylov et al.<br>Issue Date: January 4, 2011<br>Application No. 11/169,074<br>Filed: June 27, 2005<br>Attorney Docket No. 07470-085001<br>Title: MANAGING MESSAGE QUEUES | DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT |

This is a decision on the petition filed on March 4, 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 hundred sixty-four (164) days.

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

The above-identified application matured into U.S. Pat. No. 7,865,684 on January 4, 2011. The patent issued with a patent term adjustment of 33 days. The instant application for patent term adjustment was timely filed in accordance with 37 CFR 1.705(d). Patentee contests the period of adjustment of 0 days accorded pursuant to 37 CFR 1.702(b) and assert that the correct period of adjustment under 37 CFR 1.702(b) is 131 days.

Petitioner's arguments have been carefully considered, but are not persuasive. The period of adjustment pursuant to 37 CFR 1.702(b) was properly calculated at 0 days.

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.

Accordingly, in the instant matter, and in compliance with the provisions of law and rules set forth above, the period of adjustment under § 1.702(b) is 0 days.

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.

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) 272-3215.

Charlema Grant
Attorney
Office of Petitions

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In re Patent No. 7,865,684
Michaylov et al.
Issue Date: January 4, 2011
Application No. 11/169,074
Filed: June 27, 2005
Attorney Docket No. 07470-085001
Title: MANAGING MESSAGE QUEUES

DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

This is a decision on the "RESPONSE TO DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT" filed August 16, 2011. Patentees request that the determination of patent term adjustment under 35 U.S.C. § 154(b) be corrected from 33 days to 164 days.

Patentees also request that a decision on this request for reconsideration of patent term adjustment be deferred or delayed until after a final decision has been rendered in Abbott Biotherapeutics Corp v. Kappos, 1:2010cv01853 (D.D.C. 2010). There is no specific regulatory provision for requesting that a petition under 37 CFR 1.705(d) be held in abeyance.

The petition to change patent term adjustment determination under 35 U.S.C. § 154(b) from 33 days to a 164 days is **DENIED**.

**BACKGROUND**

The above-identified application matured into U.S. Pat. No. 7,865,684 on January 4, 2011. The patent issued with a patent term adjustment of 33 days. Patentees maintain that the Office incorrectly calculated Office delay pursuant to 37 CFR 1.702(b). Patentees contend that the Office erred in subtracting from the "B delay" a period of time that was not "consumed by continued examination of the application." Specifically, Patentees argue that (after the filing of the request for continued examination) the Office mailed a Notice of Allowance on August 27, 2010, thereby closing examination of the application on that date.

Thus, patentees argue no continued examination took place during the 131 day period from August 27, 2010 (the mailing date of the Notice of Allowance) until January 4, 2011 (the date the patent was issued). As such, patentees maintain that the "B delay" should include the 131 days. Patentees conclude that the correct patent term adjustment is 164 days (the sum of 282 days of "A delay" and 131 days of "B delay" minus 249 days of applicant delay").

**RELEVANT STATUTE AND REGULATIONS**

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including –

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(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), 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.

The implementing regulation, 37 CFR 1.702(b) provides that:

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);
(2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
(4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
(5) Any delay in the processing of the application by the Office that was requested by the applicant.

**OPINION**

Patentees' arguments have been considered, but not found persuasive. The Office calculated the period of "B delay" pursuant to 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.702(b)(1) as 224 days based on the application having been filed under 35 U.S.C. 111(a) on June 27, 2005 and the patent not having issued as of the day after the three year date, June 28, 2008, and a request for continued examination under 132(b) having been filed on June 16, 2008. In other words, the 131-day period beginning on the date of mailing of the notice of allowance to the date of issuance of the patent was considered time consumed by continued examination of an application under 35 U.S.C. 132(b) and was not included in the "B delay."

The Office's calculation of "B delay" is appropriate. 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

[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.

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 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,

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(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.

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, 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)[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

[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.

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[3] 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).

**CONCLUSION**

For the above-stated reasons, a review of the petition and file wrapper of the above-identified patent reveals that the above-

[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.

identified patent is not entitled to a patent term extension or adjustment of 164 days. Therefore, the petition to change the patent term adjustment indicated on the above-identified patent to 164 days is **denied**.

This decision may be viewed as final agency action. *See* MPEP § 1002.02(b).

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney at (571) 272-3215.

Anthony Knight
Director
Office of Petitions

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FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

In re Patent No. 7,865,684
Issued: January 4, 2011
Application No. 11/169,074
Filed: June 27, 2005
Attorney Docket No.: 07470-085001
For: MANAGING MESSAGE QUEUES

: FINAL AGENCY DECISION
: ON REQUEST TO INVOKE THE
: SUPERVISORY AUTHORITY
: OF THE DIRECTOR

This decision on the "PETITION UNDER 37 C.F.R. §1.181 (a)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR," filed November 20, 2011, requesting that the Director review the Final Agency Decision on Request for Reconsideration of Decision on Application for Patent Term Adjustment ("Decision") mailed by the Office of Petitions on September 19, 2011.

The Decision maintains that the above-identified patent is entitled to thirty-three (33) days of patent term adjustment ("PTA"). Patentees request that the Director review the decision and modify the PTA calculation to one hundred sixty-four (164) days.

The decision of the Director of the Office of Petitions has been reviewed. However, because no error has been found in the decision, the petition under 37 CFR 1.181 is **DENIED**.

The patent term adjustment remains 33 days, as indicated in the final agency decision of September 19, 2011. The patent 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 **thirty-three (33)** days.

Andrew Hirshfeld
Associate Commissioner for Patent Examination Policy

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/169,162 | 06/27/2005 | Anthony Baratta | 9064.009.NPUS00 | 1789 |

68769 7590 03/18/2011
HOUSTON OFFICE OF
NOVAK DRUCE AND QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

| EXAMINER |
|---|
| ELEY, TIMOTHY V |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3723 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/18/2011 | 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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HOUSTON OFFICE OF
NOVAK DRUCE AND QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON TX 77002

| | |
|---|---|
| In re Application of:<br>BARATTA, ANTHONY<br>Serial No.: 11/169,162<br>Filed: 27 December 2004<br>Docket: 9064.009.NPUS00<br>Title: TOOLS AND METHODS FOR MAKING AND USING TOOLS, BLADES AND METHODS OF MAKING AND USING BLADE | DECISION ON REQUEST FOR PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02(IV) |

This is a decision on the petition filed on June 27, 2005 to make the above-identified application special under the accelerated examination procedure set forth in MPEP § 708.02(IV) and in accordance with 37 C.F.R. § 1.102.

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

In the petition, petitioner indicates that the invention materially enhances the quality of the environment and provides supporting declaration by James Henricks. All the requirements of MPEP § 708.02(IV) are considered to have been met.

The application is being forwarded to the examiner via the Supervisory Patent Examiner awaiting a response to the outstanding non-final Office action mailed on Dec. 17, 2010. Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

For the above-mentioned reasons, the petition is granted. The application will therefore be taken up by the examiner for action in its accelerated turn.

/Henry C. Yuen/

Henry C. Yuen,
Special Programs Examiner,
Technology Center 3700

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**Margaret Anderson**
**106 E. 6th Street, Suite 900**
**Austin TX 78701**

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| | | |
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| In re Application of | : | |
| **EDWARD K.Y. JUNG, ET AL.** | : | |
| Application No. 11/169,174 | : | DECISION ON PETITION |
| Filed: June 28, 2005 | : | TO WITHDRAW |
| Attorney Docket No. **QQ1-0121US** | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed January 27, 2011.

The request is **NOT APPROVED**.

The request cannot be approved because the Office no longer accept address changes to a new practitioner/customer number or law firm filed with a request, absent the filing of a power of attorney to the new representative.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71* or, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

A courtesy copy of this decision is being mailed to the address on the request. However, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: LEE & HAYE, PLLC
601 W RIVERSIDE
SUITE 1400
SPOKANE, WA 99201

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150 EAST GILMAN STREET
P.O. BOX 1497
MADISON WI 53701-1497

| | |
|---|---|
| In re Patent No. 7,660,601 | : DECISION ON REQUEST |
| Janik, et al. | : FOR |
| Issue Date: February 9, 2010 | : RECONSIDERATION OF |
| Application No. 11/169,354 | : PATENT TERM ADJUSTMENT |
| Filed: June 29, 2005 | : and |
| Atty Docket No. 088245-8247 | : NOTICE OF INTENT TO ISSUE |
| | : CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on July 9, 2010, which is being treated as a renewed "Request for Recalculation of Patent Term Adjustment in View of *Wyeth*", 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 is extended or adjusted by seven hundred and ninety three (793) days is **GRANTED**.

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 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 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 ninety-three (793)** 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 : 7,660,601 B2

DATED : Feb. 9, 2010

INVENTOR(S) : Janik, 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 (415) days

Delete the phrase "by 415 days" and insert – by 793 days--

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|---|---|
| In re Patent No. 7,660,601 | : DECISION ON REQUEST |
| Janik, et al. | : FOR |
| Issue Date: February 9, 2010 | : RECONSIDERATION OF |
| Application No. 11/169,354 | : PATENT TERM ADJUSTMENT |
| Filed: June 29, 2005 | : and |
| Atty Docket No. 088245-8247 | : NOTICE OF INTENT TO ISSUE |
| | : CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on May 7, 2010, which is being treated as a renewed "Request for Recalculation of Patent Term Adjustment in View of *Wyeth*", requesting that the patent term adjustment indicated on the above-identified patent be recalculated.

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

On February 9, 2010, the above-identified application matured into U.S. Patent No. 7,660,601, with a revised patent term of 415 days. A Request for Recalculation of Patent Term Adjustment in View of Wyeth was filed on February 3, 2010. A decision was mailed on April 21, 2010, dismissing the request. The record reflects that the instant renewed request was filed on May 7, 2010; however, the request is not viewable in the Image File Wrapper (IFW) for the application. Patentees then filed a copy of the request on July 9, 2010. The request for recalculation was granted by a decision mailed September 10, 2010.

The request for recalculation filed May 7, 2010, is being dismissed as moot because the request filed May 7, 2010, does not appear to raise any issue that was not disposed of in the decision mailed September 10, 2010.

The period for judicial review of the patent term adjustment remains as set forth in 35 U.S.C. 154(b)(4).

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 mailed September 10, 2010**, to respond. No extensions of time will be granted under § 1.136.

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 **seven hundred and ninety-three (793)** 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 : 7,660,601 B2

DATED : Feb. 9, 2010

INVENTOR(S) : Janik, 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 (415) days

Delete the phrase "by 415 days" and insert – by 793 days--

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| In re Application of | : | |
| Hans Rudolf Nageli et al. | : | |
| Application No. 11/169,576 | : | DECISION ON PETITION |
| Filed: June 30, 2005 | : | |
| Attorney Docket No. ATM-6123 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 27, 2011, 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, August 4, 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 November 5, 2008. A Notice of Abandonment was mailed on May 8, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of 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.

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.

This application is being referred to Technology Center AU 1782 for appropriate action by the Examiner in the normal course of business on the reply received September 27, 2011.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Virgil H. Marsh
1156 15th Street, N.W.
Suite 603
Washington, DC 20005

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**1700 PENNSYLVANIA AVE., NW**
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**WASHINGTON DC 20006**

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|---|---|---|
| In re Patent No. 7,657,759 | : | |
| Issue Date: February 2, 2010 | : | |
| Application No. 11/169,823 | : | DECISION ON PETITION |
| Filed: June 28, 2005 | : | UNDER 37 CFR 1.55(c) |
| Attorney Docket No. FIN0004CIP4CIP1CON1 | : | |

This is a decision on the petition under 37 CFR 1.55(c), filed August 31, 2011, to accept an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for benefit of priority to the filing date of foreign Application (IL 127093) filed November 16, 1998, and foreign Application (IL 127869) filed December 30, 1998, by way of a certification of correction.

The petition is **DISMISSED**.

This application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, **and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6))**;
(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) 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); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The petition fails to comply with item (2) above. In this regard, a review of the file record fails to disclose that the priority information was included in an oath or declaration or in an Application Data Sheet (ADS) in accordance with 37 CFR 1.76(b)(6). Unless provided in an ADS, 37 CFR 1.63(c)(2) requires that the oath or declaration must identify the foreign application for patent (or inventor's certificate) for which priority is claimed under 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. *Note* MPEP 201.14.

The oath/declaration filed in the above application is acceptable because the instant application is a continuation of Application No. 09/996,623 which is a **Continuation-in-Part (CIP)** of Application No. 09/397,331. Therefore, the copy of the declaration submitted with the instant petition cannot execute the instant Application No. 11/169,823.

In view of the above, compliance with 37 CFR 1.63(c)(2) or 37 CFR 1.76(b)(6) must be satisfied if applicant desires to claim priority to the foreign applications noted in the petition. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 CFR 1.55(c)."

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

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

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

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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

**STOLOWITZ FORD COWGER LLP/PTOMAIL**
**621 SW MORRISON STREET**
**SUITE 600**
**PORTLAND OR 97205**

**MAILED**
JAN 18 2012
**OFFICE OF PETITIONS**

In re Patent No. 7,657,759
Issue Date: February 2, 2010
Application No. 11/169,823
Filed: June 28, 2005
Attorney Docket No. 1259-0023

DECISION ON PETITION
UNDER 37 CFR 1.55(c) AND
REQUEST FOR CERTIFICATE
OF CORRECTION

This is a decision on the renewed petition filed January 10, 2012, which is properly being treated as a petition under 37 CFR 1.55(c), to accept an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for the benefit of priority to prior-filed foreign Israel Application No. IL 127093, filed November 16, 1998 and Application No. IL 127869, filed December 30, 1998.

The petition is **GRANTED**.

This instant application was filed on June 28, 2005. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.55(c), 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 foreign application after issuance of the application into a patent. See MPEP 1481. A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6);

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) 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); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 119(a)-(d) is accepted as being unintentionally delayed.

A corrected Filing Receipt, which includes the priority claim to the prior-filed foreign 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 foreign 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.

Any inquiries directly pertaining to this matter may be directed to the undersigned at (571) 272-3208.

It is noted that a Certificate of Correction was issued on October 4, 2011to indicate the foreign applications.

/KOC/
Karen Creasy
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 |
|---|---|---|---|---|---|---|
| 11/169,823 | 06/28/2005 | 2431 | 1950 | 1259-0023 | 33 | 3 |

**CONFIRMATION NO. 2238**

**CORRECTED FILING RECEIPT**

11788
Stolowitz Ford Cowger LLP / ptomail
621 SW Morrison Street
Suite 600
Portland, OR 97205

*OC000000052028089*

Date Mailed: 01/18/2012

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)**

Moshe Rubin, Jerusalem, ISRAEL;
Daniel Schreiber, Beit Shemesh, ISRAEL;

**Power of Attorney:** The patent practitioners associated with Customer Number 73552

**Domestic Priority data as claimed by applicant**

This application is a CON of 09/996,623 11/28/2001 PAT 6993662
which is a CIP of 09/774,236 01/29/2001 ABN
which is a CIP of 09/397,331 09/14/1999 PAT 6298446

**Foreign Applications** (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see http://www.uspto.gov for more information.)
ISRAEL 127093 11/16/1998
ISRAEL 127869 12/30/1998

**If Required, Foreign Filing License Granted:** 07/18/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/169,823**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

METHOD AND SYSTEM FOR COPY PROTECTION OF DISPLAYED DATA CONTENT

**Preliminary Class**

713

## 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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JUL 21 2011
OFFICE OF PETITIONS

**AMY LACHMAN**
**75 N. PIONEER BLVD.**
**SPRINGBORO OH 45066**

| | | |
|---|---|---|
| In re Application of | : | |
| LACERDA, et al | : | |
| Application No. 11/169,872 | : | DECISION ON PETITION |
| Filed: June 30, 2005 | : | |
| Attorney Docket No. PHY1 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 27, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay the publication fee on or before June 2, 2011, as required by the Notice of Allowance and Fee(s) Due, mailed March 2, 2011, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on June 3, 2011. A Notice of Abandonment was mailed June 15, 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 publication fee of $300; (2) the petition fee of $810; and (3) the required statement of unintentional delay.

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

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

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

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

cc: LARRY A. FILLNOW
79 DENEEN AVENUE
MONROE, OH 45050

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**MAILED**
JUN 16 2011
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| | | |
|---|---|---|
| In re Application of | : | |
| **GOVARDHAN,** Chandrika et al. | : | |
| Application No. 11/169,956 | : | DECISION ON PETITION |
| Filed: June 28, 2005 | : | TO WITHDRAW |
| Attorney Docket No. **ALTH-018/01US 307255-2331** | : | 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 12, 2011.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Cooley LLP has been revoked by the assignee of the patent application on May 19, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the new address of record until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 7/12/10 **Paper No.:** ____

TO SPE OF : ART UNIT 2626

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/703,13 Patent No.: 7233897 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.

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

**Comments:** _____

U. Paul Harper 8/19/10

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AT&T CORP.
ROOM 2A-207
ONE AT&T WAY
BEDMINSTER NJ 07921

MAILED

JAN 25 2011

PCT LEGAL ADMINISTRATION

In re Patent of: KAPILOW
U.S. Application No.: 11/170313
Patent No.: 7233897
Filing Date: June 29, 2005
Attorney Docket No.: KAPILOW 1999-0096CON
For: METHOD AND APPARATUS FROR PERFORMING PACKET LOSS OR FRAME ERASURE CONCEALMENT

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3) filed June 28, 2010, to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed Certificate of Correction.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

U.S. application 11/170313 was filed on June 29, 2005. While a reference to the prior-filed nonprovisional application was not included in an application data sheet or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(3) is not included in the first sentence of the specification or in an application data sheet but does appear either in the oath or declaration or a letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(2)(ii). However, on the other hand, if the Office does not note the claim for priority to the prior-filed application set forth in the oath or declaration or letter submitted with the application, a petition will be required to accept the late claim for priority under 37 CFR 1.78(a)(3). In the instant application, the Office noted the claim for priority of the prior-filed application in the transmittal filed with the application,

as shown by its inclusion on the filing receipt and on the published patent application US 2005/0240402 A1.

In view of the above, no petition fee is required.

Any inquiries concerning this decision may be directed to PCT Special Program Examiner Tamara Graysay at (571) 272-6728.

Tamara Graysay
PCT Special Program Examiner
Office of PCT Legal Administration
(571) 272-6728

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

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DEC 02 2010

OFFICE OF PETITIONS

**KIRBY A. KINCHEN SR.**
**APT. A-1**
**2618 N.E. 195TH ST.**
**SHORELINE, WA 98155**

| | | |
|---|---|---|
| In re Application of | : | |
| Kirby A. Kinchen Sr. | : | |
| Application No. 11/170,321 | : | ON PETITION |
| Filed: June 28, 2005 | : | |
| Attorney Docket No. None | : | |

This is in response to the renewed communication, filed May 28, 2010, for reconsideration of abandonment, which is being treated as a petition under 37 CFR 1.181 requesting to withdraw the holding of abandonment.

The petition is **DISMISSED**.

On January 29, 2009, the Office mailed a non-final Office action, which set a three month shortened statutory period to reply. The application was held abandoned on April 30, 2009, for failure to submit a timely response to the non-final Office action. A Notice of Abandonment was mailed August 3, 2009.

In the current request petitioner asks that the Office still reconsider the abandonment of the above identified application because of the death of his attorney and other extreme circumstances.

Petitioner should note that the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987); California, 921 F.Supp. 1219, 1259 (D.Del. 1995).

In view of the above, the abandonment is considered proper. Therefore, the request to withdraw of the holding of abandonment in the above-identified application cannot be granted.

## DISCUSSION OF PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Petitions filed under 37 CFR 1.181 to withdraw holding of abandonment are filed to contend that an application is not in fact, abandoned. Petitions under 37 CFR 1.181 ask that the holding of abandonment be withdrawn based on failure to receive an Office action or based on the fact that a response to an Office action was timely filed. In this instance, a petition under 37 CFR 1.181 to withdraw holding of abandonment would not be appropriate. The petition requesting withdrawal of the holding of abandonment cannot be granted since there is no indication that there was a failure to receive the Office action or that a response to the Office action was timely filed.

**ALTERNATIVE VENUE**

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

> (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR 1.111 or (B) a continuing application under 37 CFR 1.53(b).
>
> (2) The petition fee as set forth in 37 CFR 1.17(m), **$810.00 for a small entity**;
>
> (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. The Director may require additional information where there is a question whether the delay was unintentional.

The forms for filing either a petition to revive an unintentionally abandoned application or a petition to revive an unavoidably abandoned application accompany this decision for petitioner's convenience. If petitioner desires to file a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), petitioner must complete one of the corresponding forms, (PTO/SB/61) or (PTO/SB/64) enclosed and pay the petition fee.

Petitioner may wish to consider hiring a registered patent attorney or agent to assist in the prosecution of this application. Additionally, petitioner is encouraged to contact the Inventors Assistance Center (IAC) by telephone at 800-786-9199 or 571-272-1000, Monday through Friday from 8:30 AM to 5:30 PM (EST). The IAC provides patent information and services to the public and is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

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

| | |
|---|---|
| By Mail: | Mail Stop Petition<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By Fax: | (571) 273-8300<br>Attn: Office of Petitions |
| By Hand: | Customer Service Window<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |

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

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

Enclosures: Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b); Form PTO/SB/64, Privacy Act Statement.

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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FISHER, CHRISTEN & SABOL
P.O. Box 18385
WASHINGTON DC 20036

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OCT 19 2011

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| | | |
|---|---|---|
| In re Application of | : | |
| Hans Rudolf Nageli et al. | : | |
| Application No. 11/170,399 | : | DECISION ON PETITION |
| Filed: June 30, 2005 | : | |
| Attorney Docket No. **ATM-6124** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 29, 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 August 7, 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 November 8, 2008.

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) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to Technology Center AU 1794 for appropriate action by the Examiner in the normal course of business.

JoAnne Burke
Petitions Examiner
Office of Petitions

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SEP 22 2010

OFFICE OF PETITIONS

SMITH FROHWEIN TEMPEL GREENLEE BLAHA, LLC
Two Ravinia Drive
Suite 700
ATLANTA GA 30346

| | | |
|---|---|---|
| In re Application of | : | |
| Archer et al. | : | |
| Application No. 11/170,457 | : | DECISION ON PETITION |
| Filed: June 29, 2005 | : | UNDER 37 CFR 1.78(a)(6) |
| Attorney Docket No. 07001.1190 | : | |

This is a decision on the renewed petition under 37 CFR 1.78(a)(6), filed June 30, 2010, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to a prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **GRANTED.**

A petition 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 expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) 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)(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.

Additionally, the instant nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Further, the nonprovisional application claiming the benefit of the prior-filed provisional application must have been filed within twelve months of the filing date of the prior-filed provisional application.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 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 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.***

***§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 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 the application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed provisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Charlema Grant at (571) 272-3215. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The application is being forwarded to Technology Center AU 2442 for consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional application.

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

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

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

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Charlema Grant at (571) 272-3215.

Christopher Bottorff
Supervisor
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 11/170,457 | 06/29/2005 | 2442 | 1130 | 07001.1190 | 20 | 2 |

**CONFIRMATION NO. 3245**

**CORRECTED FILING RECEIPT**

35856
SMITH FROHWEIN TEMPEL GREENLEE BLAHA, LLC
Two Ravinia Drive
Suite 700
ATLANTA, GA 30346

*OC000000043637874*

Date Mailed: 09/22/2010

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)**

Shafford R. Archer JR., Norcross, GA;
Florin D. Malita, Norcross, GA;
Ian M. Moraes, Suwanee, GA;
Jon S. Plotky, Lawrenceville, GA;

**Power of Attorney:** The patent practitioners associated with Customer Number 35856

**Domestic Priority data as claimed by applicant**

This application is a CIP of 11/080,744 03/15/2005
which claims benefit of 60/584,117 06/30/2004

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 07/21/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/170,457**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Load balancing in a distributed telecommunications platform

**Preliminary Class**

709

## 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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CURATOLO SIDOTI CO., LPA
24500 CENTER RIDGE ROAD, SUITE 280
CLEVELAND, OH 44145

MAILED
APR 11 2011
OFFICE OF PETITIONS

In re Application of :
John D. Ten Eyck et al :
Application No. 11/170,502 :
Filed: June 29, 2005 :
Attorney Docket No. EXHAUST GAS TREATMENT DEVICE AND METHOD FOR MAKING THE SAME

ON PETITION

This is a decision on the petition, filed April 11, 2011 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on February 14, 2011 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 3726 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

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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 Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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United States Patent and Trademark Office
P.O. Box 1450
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**IBM CORPORATION, T.J. WATSON RESEARCH CENTER**
**P.O. BOX 218**
**YORKTOWN HEIGHTS NY 10598**

MAILED
AUG 3 1 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Zhong TIAN et al. | : | |
| Application No. 11/170,596 | : | DECISION ON PETITION |
| Filed: June 29, 2005 | : | |
| Attorney Docket No. **CN920040002US1** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 11, 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 29, 2008. 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 July 30, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1620; and (3) a proper statement of unintentional delay.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.
It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at

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

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-2783.

This application is being referred to Technology Center AU 2193 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.

Ramesh Krishnamurthy

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

cc: **MICHAEL J. BUCHEONHORNER**
**8540 SW 83 STREET**
**MIAMI FL 33143**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03/09/11

TO SPE OF : ART UNIT: 2463 Attn: FERRIS DERRICK W (SPE)

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/170854 Patent No.: 7733906

C of C Mailroom date: 02/25/11

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:** Please approve Certificate of Correction mailed 02/25/2011.

/Derrick W. Ferris/ — SPE

2463 — 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

**SAMVEL ARTAVAZOVICH CHARUKHCHIAN**
**1086 N. HILLS DRIVE**
**DECATUR, GA 30033**

**MAILED**

NOV 02 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Samvel Artavazovich Charukhchian | : | |
| Application No. 11/170,903 | : | ON PETITION |
| Filed: June 29, 2005 | : | |
| Attorney Docket No. CHARUKHCHIAN | : | |

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

The petition is **GRANTED**.

The application became abandoned for failure to file a reply within the meaning of 37 CFR 1.113 to the final Office action of April 10, 2008. 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). In view of the three (3) month extensions of time obtained on October 8, 2008, the date of abandonment of this application is October 11, 2008. A Notice of Abandonment was mailed December 5, 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), including the fee of $405 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) 272-6059.

This application is being referred to Technology Center AU 3767 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.

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
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Paper No.

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DALLAS TX 75380

MAILED

SEP 17 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Anuradha K. Appaji | : | |
| Application No. 11/170924 | : | ON APPLICATION FOR |
| Filed: 06/30/2005 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. | : | |
| 2004.03.011.WS0 | : | |

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(b)," filed on May 25, 2010. Applicant asserts that the correct patent term adjustment is 929 days rather than 699 days as indicated in the Determination of Patent Term Adjustment Under 35 U.S.C. § 154(b) mailed with the notice of allowance. Applicant asserts entitlement to the additional patent term adjustment solely on the basis that the patent will issue more than 3 years after the filing date.

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].

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

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).

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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 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) 272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON KY 40550-0999

MAILED

AUG 30 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Edwards | : | |
| Application No. 11/170,929 | : | DECISION |
| Filed/Deposited: 30 June, 2005 | : | |
| Attorney Docket No. 2004-0928.01 | : | |

This is a decision on the petition filed on 19 July, 2010, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

## BACKGROUND

The record reflects as follows:

Applicant failed to reply timely and properly to the final Office action mailed on 6 January, 2010, with reply due absent extension of time on or before 6 April, 2010.

On 5 March, 2010, Petitioner filed an amendment after final, which the Examiner refused to enter and Petitioner—as one registered to practice before the Office—knew was not as of right

and not a proper reply[1] if it did not *prima facie* place the application in condition for allowance, and on 12 March, 2010, the Examiner mailed an Advisory Action.

The application went abandoned by operation of law after midnight 6 April, 2010.

The Office mailed the Notice of Abandonment 13 July, 2010.

On 19 July, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee, with a statement of unintentional delay and a reply in the form of a 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 (previously filed).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[3]
The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[4]))

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[1] A proper reply is an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission under 37 C.F.R. §1.114). (See: MPEP §711.03(c).)

[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).

[3] 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements under the rule have been satisfied.

## CONCLUSION

Accordingly, the petition pursuant to 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to the Technology Center/AU 2854 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 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[5]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

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[4] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

[5] 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

MICROSOFT CORPORATION
ONE MICROSOFT WAY
REDMOND, WA 98052

**MAILED**

AUG 09 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Stephen F. Potter, et al. | : | |
| Application No. 11/170,945 | : | DECISION GRANTING PETITION |
| Filed: June 30, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 311618.01 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 6, 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 13, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries 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 2626 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement

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

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

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

**FAY SHARPE LLP**
**1228 Euclid Avenue, 5th Floor**
**The Halle Building**
**Cleveland OH 44115**

MAILED
MAY 17 2011
OFFICE OF PETITIONS

In re Application of :
Victor R. KLASSEN :
Application No. 11/170,975 : ON PETITION
Filed: June 30, 2005 :
Attorney Docket No. 20040983USNP- :
XER00933US01

This is a decision on the petition under 37 CFR 1.137(b), filed April 18, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed July 21, 2010, which set a shortened statutory period for reply of three (3) months. A three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on January 22, 2011.

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, a Request for Continued Examination, and the $810 filing fee; (2) the petition fee of $1620; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office Action of July 21, 2010 is accepted as having been unintentionally delayed.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1110 extension of time fee submitted with the petition on April 18, 2011 was subsequent to the maximum extendable period for reply, petitioner may request a refund of this fee by writing to the following address: Mail Stop 16, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

Application No. 11/170,975

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.

The application file is being referred to Technology Center AU 2625 for appropriate action on the concurrently filed Request for Continued Examination and amendment.

David A. Bucci
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20120322

**DATE** : March 22, 2012

**TO SPE OF** : ART UNIT 3641

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,676,976

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:**

/MICHAEL CARONE/
Supervisory Patent Examiner.Art Unit 3641

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

Rankin, Hill & Clark LLP
23755 Lorain Road, Suite 200
North Olmsted OH 44070

MAILED

NOV 10 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Momoda et al. | : | |
| Application No. 11/171272 | : | ON PETITION |
| Filing or 371(c) Date: 07/01/2005 | : | |
| Attorney Docket Number: ONO-35167 | : | |

This is a decision on the petition to revive the above-identified application under the unintentional provisions of 37 CFR 1.137(b), filed October 20, 2011.

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 May 24, 2011. 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). Accordingly, the date of abandonment of this application is August 9, 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 Request for Continued Examination (RCE) and fee, and the submission required by 37 CFR 1.114; (2) the petition fee; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 1712 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.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
SEP 07 2011
OFFICE OF PETITIONS

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

In re Patent No. 7,459,451
Issued: December 2, 2008
Application No. 11/171,320
Filed: July 1, 2005
Attorney Docket No. 274726US0

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

This is a decision on the PETITION UNDER 37 C.F.R. § 1.705(d) AND REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT filed on December 8, 2008, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 433 days to 556 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 court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).[1]

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 adjusted by five hundred fifty-six (556) days and 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 **five hundred fifty-six (556)** days.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

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[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).

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,459,451 B2

DATED : December 2, 2008

INVENTOR(S) : Yoshito Abe

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 (433) days

Delete the phrase "by 433 days" and insert – by 556 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

1-5-2012

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

Patent No : 7,904,172 B2
Ser. No. : 11/171451
Inventor(s) : Oi Lian Kon, et. al.
Issued :

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.

Eva James
For Mary Diggs
Decisions & Certificates
of Correction Branch
(571) 272-3422 or 703- 756 -1580

George D. Liu
PYPRUS PTE LTD
30 Bideford Road, #07-01 Thongsia Building
Singapore 229922

ej

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FEB 06 2012

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.: 7,904,172
Application No.: 11/171,451
First-Named Inventor: Oi Lian Kon
Filed: July 1, 2005
Title: Programmable Apparatus And Method For Optimizing And Real Time Monitoring Of Gene Transfection Based On User Configured Arbitrary Waveform Pulsing Train
Confirmation No.: 7012

Attorney Docket No.: 1138.P022US
Customer No.: 38556

## Request To Correct Assignee under 37 CFR 3.81(b)

Commissioner For Patents
Office of Petitions

Fax No.: 571 273 8300
Total No. of pages including cover : 11

Dear Sirs,

This patent issued on March 8, 2011 lists only one assignee, that is Nanyang Polytechnic, at no. (73) on the title page. This is incorrect. In fact, there should be a second assignee, that is, **National Cancer Centre Of Singapore Pte Ltd**.

This error apparently arose due to an inadvertent mistake of not typing in the name of the second assignee in item 3 of PTOL-85B submitted on January 16, 2011.

We herein request correction to the assignee information under 37 CFR 3.81(b) and the followings are enclosed for your processing:-

(a) The processing fee of US$130 paid via credit card payment form PTO-2038;

(b) We state that the failure to include the correct assignee name on the PTOL-85B was purely inadvertent; and

(c) 2 copies of Notice of Recordation of Assignment Document evidencing that the assignments to Nanyang Polytechnic and National Cancer Centre Of Singapore Pte Ltd were recorded at Reel/Frame No.: 017907/0207 on May 31, 2006 and at Reel/Frame No.: 016754/0391 on July 1, 2005, respectively.

We respectfully request that the above request be granted and that the file be forwarded to the Certificates of Correction Branch for issuance of a Certificate of Correction as requested in our earlier letter dated December 29, 2011.

Thank you.



02/07/2012 KON111 00000005 11171451
01 FC:1464 130.00 OP

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FEB 06 2012

Yours faithfully,
**Pyprus Pte Ltd**

George D Liu
Registration No. 47,752

February 5, 2012
Date

Correspondence Address
Customer No.: 38556
Tel: (703) 536-1713
Fax: (65) 6732 3188 or (703) 415 8601

---

**Certificate of Transmission**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patents & Trademark Office, Fax No. 571 273 8300 on February 5, 2012.

Jace Cheong



PAGE 2/11 * RCVD AT 2/5/2012 11:08:44 PM [Eastern Standard Time] * SVR:W-PTOFAX-002/34 * DNIS:2738300 * CSID:+65 67348521 * DURATION (mm-ss):06-13

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

JULY 11, 2006

PTAS
LAWRENCE Y.D. HO & ASSOCIATES PTE LTD
30 BIDEFORD ROAD, #07-01, THONGSIA BUILD
SINGAPORE 229922

*103243854A*

UNITED STATES PATENT AND TRADEMARK OFFICE
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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 571-272-3350. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, MAIL STOP: ASSIGNMENT SERVICES BRANCH, P.O. BOX 1450, ALEXANDRIA, VA 22313.

RECORDATION DATE: 05/31/2006

REEL/FRAME: 017907/0207
NUMBER OF PAGES: 6

BRIEF: CORRECTIVE ASSIGNMENT PREVIOUSLY RECORDED AT REEL 016754, FRAME 0391 TO ADD AN OMITTED RECEIVING PARTY, THE CONVEYING PARTY HEREBY CONFIRMS THE ASSIGNMENT OF THE ENTIRE INTEREST

ASSIGNOR:
KON, OI LIAN

DOC DATE: 06/21/2005

ASSIGNOR:
HUSSEN, MOHAMAD PAUZI BIN

DOC DATE: 06/21/2005

ASSIGNOR:
YAP, STEVEN TECK BOON

DOC DATE: 06/21/2005

ASSIGNEE:
NANYANG POLYTECHNIC
180 ANG MO KIO AVE 8
SINGAPORE, SINGAPORE 569830



PAGE 4/11 * RCVD AT 2/5/2012 11:08:44 PM [Eastern Standard Time] * SVR:W-PTOFAX-002/34 * DNIS:2738300 * CSID:+65 67348521 * DURATION (mm-ss):06-13

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FEB 06 2012

017907/0207 PAGE 2

SERIAL NUMBER: 11171451 FILING DATE: 07/01/2005
PATENT NUMBER: ISSUE DATE:
TITLE: PROGRAMMABLE APPARATUS AND METHOD FOR OPTIMIZING AND REAL TIME MONITORING OF GENE TRANSFECTION BASED ON USER CONFIGURED ARBITRARY WAVEFORM PULSING TRAIN

MARGARET LASALLE, EXAMINER
ASSIGNMENT SERVICES BRANCH
PUBLIC RECORDS DIVISION

06-27-2006

103243854

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FEB 06 2012

Form PTO-1595 (Rev. 07/05)
OMB No. 0651-0027 (exp. 6/30/2008)

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

RECORDATION FORM COVER SHEET

5-31-06

# PATENTS ONLY

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

**1. Name of conveying party(ies)**
KON, Oi Lian
Mohamad Pauzi Bin Hussen (no family name)
YAP, Steven Teck Boon

Additional name(s) of conveying party(ies) attached? ☐ Yes ☑ No

**2. Name and address of receiving party(ies)**
Name: Nanyang Polytechnic
Internal Address: N/A
Street Address: 180 Ang Mo Kio Ave 8
City: Singapore
State: Singapore
Country: SINGAPORE Zip: 569830

Additional name(s) & address(es) attached? ☑ Yes ☐ No

**3. Nature of conveyance/Execution Date(s):**
Execution Date(s) 6-21-05
☐ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Joint Research Agreement
☐ Government Interest Assignment
☐ Executive Order 9424, Confirmatory License
☐ Other see attached continuation sheet for explanation.

**4. Application or patent number(s):** ☐ This document is being filed together with a new application.
A. Patent Application No.(s)
11/171,451
B. Patent No.(s)

Additional numbers attached? ☐ Yes ☑ No

**5. Name and address to whom correspondence concerning document should be mailed:**
Name: GEORGE D. LIU
Internal Address: N/A
Street Address:
Customer Number: 38556
City:
State: Zip:
Phone Number: (703) 356-1713
Fax Number: (65) 6732 3188 or (703) 415 8601
Email Address: angie.yu@patents.com.sg

**6. Total number of applications and patents involved:** 1

**7. Total fee (37 CFR 1.21(h) & 3.41)** $40.00
☐ Authorized to be charged by credit card
☐ Authorized to be charged to deposit account
☑ Enclosed
☐ None required (government interest not affecting title)

**8. Payment Information**
a. Credit Card Last 4 Numbers
Expiration Date
b. Deposit Account Number
Authorized User Name

**9. Signature:** [signature] May 31, 2006
Signature Date
GEORGE D. LIU (Reg No. 47,752)
Name of Person Signing
Total number of pages including cover sheet, attachments, and documents: 5

Documents to be recorded (including cover sheet) should be faxed to (571) 273-0140, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

Atty Docket No.: 1138.P022US/OCG/ay

OP $40.00 11171451

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Form PTO-1595 (Rev. 09/04)
OMB No. 0651-0027 (exp. 6/30/2005)

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

R.

# PATENTS ONLY

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

**1. Name of conveying party(ies)/Execution Date(s):**

Oi Lian KON
Mohamad Pauzi Bin Hussen (no family name)
Steven Teck Boon YAP

Execution Date(s) June 21, 2005

Additional name(s) of conveying party(ies) attached? ☐ Yes ☑ No

**2. Name and address of receiving party(ies)**

Name: National Cancer Centre of Singapore Pte Ltd

Internal Address: N/A

Street Address: 11 Hospital Drive

City: N/A

State: N/A

Country: SINGAPORE Zip: 169610

Additional name(s) & address(es) attached? ☐ Yes ☑ No

**3. Nature of conveyance:**

☑ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Government Interest Assignment
☐ Executive Order 9424, Confirmatory License
☐ Other

**4. Application or patent number(s):** ☑ This document is being filed together with a new application.

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☑ No

**5. Name and address to whom correspondence concerning document should be mailed:**

Name: GEORGE D. LIU

Internal Address: N/A

Street Address:

Customer Number: 38556

State: Zip:

Phone Number: (703) 356-1713

Fax Number: (65) 6732 3188

Email address: angie.yu@patent.com.sg

**6. Total number of applications and patents involved:**

**7. Total fee (37 CFR 1.21(h) & 3.41) $ 40**

☐ Authorized to be charged by credit card
☐ Authorized to be charged to deposit account
☑ Enclosed
☐ None required (government interest not affecting title)

**8. Payment Information**

a. Credit Card Last 4 Numbers
Expiration Date

b. Deposit Account Number

Authorized User Name

**9. Signature:** July 1, 2005

Signature Date

GEORGE D. LIU, Reg No. 47,752
Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 3

Documents to be recorded (including cover sheet) should be faxed to (703) 306-5995, or mailed to:
Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

113262 U.S. PTO
11/171451
070105

Continuation sheet of Recordation Form Cover Sheet (PTO-1595)

US Patent Application No. 11/171,451

3. Nature of conveyance:

Other: Corrective assignment previously recorded at reel 016754, frame 0391 to add an omitted receiving party, the conveying party hereby confirms the assignment of the entire interest.

05 DEC 2005
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FEB 06 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOVEMBER 09, 2005

PTAS

*103038255A*

LAWRENCE Y.D. HO & ASSOCIATES PTE LTD
30 BIDEFORD ROAD, #07-01, THONGSIA BUILD
SINGAPORE 229922

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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 571-272-3350. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, MAIL STOP: ASSIGNMENT SERVICES DIVISION, P.O. BOX 1450, ALEXANDRIA, VA 22313.

RECORDATION DATE: 07/01/2005

REEL/FRAME: 016754/0391
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
KON, OI LIAN

DOC DATE: 06/21/2005

ASSIGNOR:
MOHAMAD PAUZI BIN HUSSEN (NO FAMILY NAME)

DOC DATE: 06/21/2005

ASSIGNOR:
YAP, STEVEN TECK BOON

DOC DATE: 06/21/2005

ASSIGNEE:
NATIONAL CANCER CENTRE OF SINGAPORE PTE LTD
11 HOSPITAL DRIVE
, SINGAPORE 169610

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FEB 06 2012

016754/0391 PAGE 2

SERIAL NUMBER: 11171451 FILING DATE: 07/01/2005
PATENT NUMBER: ISSUE DATE:
TITLE: PROGRAMMABLE APPARATUS AND METHOD FOR OPTIMIZING AND REAL TIME MONITORING OF GENE TRANSFECTION BASED ON USER CONFIGURED ARBITRARY WAVEFORM PULSING TRAIN

ANTIONE ROYALL, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

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FEB 06 2012

07-12-2005

Form PTO-1595 (Rev. 09/04)
OMB No. 0651-0027 (exp. 6/30/2005)

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

RE 103038255

# PATENTS ONLY

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

**1. Name of conveying party(ies)/Execution Date(s):**

Oi Lian KON
Mohamad Pauzi Bin Hussen (no family name)
Steven Teck Boon YAP

Execution Date(s) June 21, 2005

Additional name(s) of conveying party(ies) attached? ☐ Yes ☑ No

**2. Name and address of receiving party(ies)**

Name: National Cancer Centre of Singapore Pte Ltd

Internal Address: N/A

Street Address: 11 Hospital Drive

City: N/A

State: N/A

Country: SINGAPORE Zip: 169610

Additional name(s) & address(es) attached? ☐ Yes ☑ No

**3. Nature of conveyance:**

☑ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Government Interest Assignment
☐ Executive Order 9424, Confirmatory License
☐ Other

**4. Application or patent number(s):** ☑ This document is being filed together with a new application.

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☑ No

**5. Name and address to whom correspondence concerning document should be mailed:**

Name: GEORGE D. LIU

Internal Address: N/A

Street Address:

Customer Number: 38556

City:

State: Zip:

Phone Number: (703) 356-1713

Fax Number: (65) 6732 3188

Email Address: angle.yu@patent.com.sg

**6. Total number of applications and patents involved:**

**7. Total fee (37 CFR 1.21(h) & 3.41) $ 40**

☐ Authorized to be charged by credit card
☐ Authorized to be charged to deposit account
☑ Enclosed
☐ None required (government interest not affecting title)

**8. Payment Information**

a. Credit Card Last 4 Numbers
Expiration Date

b. Deposit Account Number

Authorized User Name

**9. Signature:**

Signature — July 1, 2005 — Date

GEORGE D. LIU, Reg No. 47,752
Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 3

Documents to be recorded (including cover sheet) should be faxed to (703) 306-5995, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

7/06/2005 RHEBRAHT 00000007 11171451
2 FC:8021 40.00 OP

113262 U.S. PTO
11/171451
070105

7-1-05

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 10-5-11 Paper No.: _____

TO SPE OF : ART UNIT 2814

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/171,483 Patent No.: 7205177

CofC mailroom date: 9-30-11

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

**FOR IFW FILES:** Should cofc be approved

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**

Dee Yang

**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:** See attached

Thao Le 2892

SPE Art Unit

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION



**PATENT NO.** : 7,205,177
**APPLICATION NO.** : 11/171,483
**ISSUE DATE** : April 17, 2007
**INVENTOR(S)** : Eric Beyne

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

At Column 1, Line 49, after "larger" delete "then" and insert --than--, therefor.

At Column 3, Line 2, after "smaller" delete "then" and insert --than--, therefor.

At Column 3, Line 5, after "higher" delete "then" and insert --than--, therefor.

At Column 3, Line 6, after "lower" delete "then" and insert --than--, therefor.

At Column 3, Line 14, after "smaller" delete "then" and insert --than--, therefor.

At Column 3, Line 49, after "smaller" delete "then" and insert --than--, therefor.

At Column 3, Line 61, after "more" delete "then" and insert --than--, therefor.

At Column 4, Line 23, after "lower" delete "then" and insert --than--, therefor.

At Column 4, Line 61, before "FIG. 5" insert --In--.

At Column 6, Line 28, before "approximately" delete "a" and insert --an--, therefor.

At Column 7, Line 9, delete "step," and insert --step--, therefor.

At Column 7, Line 34, after "to" delete "the".

At Column 7, Line 56, after "smaller" delete "then" and insert --than--, therefor.

At Column 8, Line 30, after "smaller" delete "then" and insert --than--, therefor.

At Column 8, Line 64, before "sensor" delete "an" and insert --a--, therefor.

At Column 9, Line 12, before "ECG" delete "and" and insert --an--, therefor.

At Column 9, Line 39, delete "ASIC" and insert --ASIC.--, therefor.

At Column 9, Line 40, before "battery" delete "a" and insert --A--, therefor.

MAILING ADDRESS OF SENDER:

Raimond J. Salenieks
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, California 92614

DOCKET NO. IMEC390.001AUS

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20111024

**DATE** : October 24, 2011

**TO SPE OF** : ART UNIT 2617

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,822,000

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 BOST/
Supervisory Patent Examiner.Art Unit 2617

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 02/07/11

TO SPE OF : ART UNIT 2614

SUBJECT : Request for Certificate of Correction for Appl. No.: 11171615 Patent No.: 7778394

CofC mailroom date: 01/18/11

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**
[redacted]

Certificates of Correction Branch

*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.

| | |
|---|---|
| **XApproved** | **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

/Curtis Kuntz/ SPE AU 2614

Formatted: French (France)

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

**LEXMARK INTERNATIONAL, INC.**
**INTELLECTUAL PROPERTY LAW DEPARTMENT**
**740 WEST NEW CIRCLE ROAD**
**BLDG. 082-1**
**LEXINGTON KY 40550-0999**

**MAILED**

FEB 10 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| CONNORS, et al | : | |
| Application No. 11/171,626 | : | DECISION ON PETITION |
| Filed: June 30, 2005 | : | |
| Attorney Docket No. 2005-0108.02 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 11, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before January 30, 2009, as required by the Notice of Allowance and Fee(s) Due, mailed October 30, 2008, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on January 31, 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 $1510 and publication fee of $300; (2) the petition fee of $1620; and (3) a 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.

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

required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted.

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.

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

PTO/SB/131 (01-10)
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: 042390.P21998 | Patent Number: 7,669,242 |
| Filing Date (or 371(b) or (f) Date): 06-30-2005 | Issue Date: 02-23-2010 |
| First Named Inventor: Ravi Sahita | |
| Title: AGENT PRESENCE MONITOR CONFIGURED TO EXECUTE IN A SECURE ENVIRONMENT | |

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 /Shireen Irani Bacon/ | Date July 14, 2010 |
| Name (Print/Typed) Shireen Irani Bacon | Registration Number 40,494 |

***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.*

PTO/SB/131 (01-10)
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.

# 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

INTEL/BSTZ
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Mail Date: 09/13/2010

| | | |
|---|---|---|
| **Applicant** | : Ravi Sahita | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7669242 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/171,859 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/30/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1115** 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 : 5/02/11

TO SPE OF : ART UNIT 3744

SUBJECT : Request for Certificate of Correction for Appl. No.: 11171884 Patent No.: 7559210

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**

You can fax the Director's/SPE response to 571-270-9990

*Lamonte Newsome*

**Certificates of Correction Branch**

571-272-3421

**Thank You For Your Assistance**

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

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

**Comments:** _____

/Cheryl J. Tyler/ AU 3744

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/02/11

TO SPE OF : ART UNIT 3744

SUBJECT : Request for Certificate of Correction for Appl. No.: 11171884 Patent No.: 7559210

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**

You can fax the Director's/SPE response to 571-270-9990

*Lamonte Newsome*

**Certificates of Correction Branch**

571-272-3421

**Thank You For Your Assistance**

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

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

**Comments:** _____

/Cheryl J. Tyler/ SPE, AU 3744

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

**LUCE, FORWARD, HAMILTON & SCRIPPS LLP**
**2050 MAIN STREET, SUITE 600**
**IRVINE, CA 92614**

**MAILED**
MAY 09 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **PHAM,** Thuy Thanh | : | |
| Application No. 11/171,900 | : | DECISION ON PETITION |
| Filed: June 30, 2005 | : | TO WITHDRAW |
| Attorney Docket No. **34914-10100** | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 15, 2011.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Luce, Forward, Hamilton & Scripps, LLP has been revoked by the assignee of the patent application on April 07, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **BAKER & HOSTETLER LLP**
**WASHINGTON SQUARE, SUITE 1100**
**1050 CONNECTICUT AVE. N.W.**
**WASHINGTON DC 20036-5304**

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 B. BATHURST**
**19857 SUSAN CT.**
**CLINTON TOWNSHIP MI 48035**

**MAILED**

**DEC 06 2010**

**OFFICE OF PETITIONS**

In re Application of
David B. BATHURST, et al
Application No. 11/171,991
Filed: July 1, 2005
Attorney Docket No.

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

This is a decision on the petition under 37 CFR 1.102(c)(1), filed October 7, 2010, to make the above-identified application special based on applicant's health as set forth in M.P.E.P. § 708.02, Section III.

The petition is **DISMISSED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section III: Applicant's Health, must be accompanied by evidence, such as a doctor's certificate or other medical certificate, showing that the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course. No fee is required

The instant petition is not accompanied by evidence, which is immediately available, to determine if applicant's health is such that she might not be available to assist in prosecution of the application if it were to run its normal course.

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14).

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

| | |
|---|---|
| By Mail: | Mail Stop PETITION<br>Commissioner for Patents<br>P. O. Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | U. S. Patent and Trademark Office<br>Customer Service Window, Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By FAX: | (571) 273-8300 |

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6735.

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

This application is being referred back to the Technology Center Art Unit 3726 for processing in its regular turn.

/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
www.uspto.gov

**DAVID B. BATHURST**
**19857 SUSAN CT.**
**CLINTON TOWNSHIP MI 48035**

MAILED
JAN 13 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| David B. BATHURST, et al | : | |
| Application No. 11/171,991 | : | DECISION ON PETITION |
| Filed: July 1, 2005 | : | TO MAKE SPECIAL UNDER |
| Attorney Docket No. | : | 37 CFR 1.102(c)(1) |
| | : | |

This is a decision on the petition under 37 CFR 1.102(c)(1), filed December 13, 2010, to make the above-identified application special based on applicant's health as set forth in M.P.E.P. § 708.02, Section III.

The petition is **DISMISSED because it is moot.**

The instant petition is dismissed because it is abandoned, in favor of the continuation filed March 15, 2010. Please see the petition decision dated April 5, 2010.

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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**CANTOR COLBURN LLP**
**20 CHURCH STREET**
**22ND FLOOR**
**HARTFORD CT 06103**

MAILED

OCT 26 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Tatsuya Uchiyama | : | |
| Application No. 11/172,189 | : | DECISION ON PETITION |
| Filed: June 30, 2005 | : | |
| Attorney Docket No. 158541-2 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 11, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to take appropriate action in a timely manner after the decision of July 28, 2010 by the Board of Patent Appeals and Interferences. Therefore, 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 September 29, 2010. *See* MPEP 1214.06. A Notice of Abandonment was mailed October 5, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810.00 and the submission required by 37 CFR 1.114; (2) the petition fee of $1,620.00; and (3) a proper statement of unintentional delay.

Further, 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) 272-7751.

The file is now being forwarded to Technology Center 1761 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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
www.uspto.gov

Paper No.

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

**MAILED**

FEB 15 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,528,820 | : | DECISION ON REQUEST |
| Yoon et al. | : | FOR |
| Issue Date: May 5, 2009 | : | RECONSIDERATION OF |
| Application No. 11/172,232 | : | PATENT TERM ADJUSTMENT |
| Filed: June 29, 2005 | : | and |
| Atty Docket No. 12576-7011 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on June 30, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by eight hundred four **(804)** 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 **seven hundred eighty-one (781)** 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 June 30, 2008 and ends on November 16, 2008, the day before the RCE was filed. See 35 U.S.C. 154(b)(1)(B)(i). Thus, the over 3 year period is 140 not 141 days.

In addition, a review of the application history reveals that entry of an additional period of reduction of 22 days is warranted. After the filing of a response on September 30, 2008, on October 22, 2008, applicant filed a paper entitled

"Record of Interview." This paper was not expressly requested by the examiner. Accordingly, its filing was a failure to engage within the meaning of 37 CFR 1.705(c)(8) for which entry of a period of reduction of 22 days is warranted.

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 seven hundred eighty-one **(781)** 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 : 7,528,820 B2

DATED : **May 5, 2009** **DRAFT**

INVENTOR(S) : Yoon 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 663 days

Delete the phrase "by 663 days" and insert – by 781 days--

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

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

Mail Date: 08/03/2010

| | | |
|---|---|---|
| **Applicant** | : Steven C. Bartling | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7644383 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/05/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/172,284 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/30/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **577** 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 : 6/1511

TO SPE OF : ART UNIT: 1625

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/172,289 Patent No. 7,709,641

CofC mailroom date 6/6/11

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

*Ernest C. White, LIE*

**Certificates of Correction Branch**

**703-756-1814** _____

**Thank You For Your Assistance**

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

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

**Comments:** _____

Okay to make the replacement.

/Janet L. Andres/ — **SPE**

1625 — **Art Unit**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : **6-1-11**

**TO SPE OF** : ART UNIT **3749**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **11172304** Patent No.: **7828546**

**CofC mailroom date: 5-26-11**

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 – 9D40-E**
**Palm Location 7580**

**Note:** _____

_____

**Omega Lewis**

**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.

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

**Comments:**_____

_____

_____

_____

/Steven B. McAllister/ — **SPE**

3749 — **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
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LATHROP & GAGE LLP
2345 GRAND Boulevard
SUITE 2400
KANSAS CITY MO 64108

MAILED
SEP 08 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,533,490 | : | |
| Issue Date: May 19, 2009 | : | |
| Application No. 11/172,328 | : | ON PETITION |
| Filed: June 30, 2005 | : | |
| Attorney Docket No. **438616** | : | |

This is a decision on the petition filed November 20, 2009, which is being treated as a petition 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 to correct the assignee's name by way of a certificate of correction in the name of "Innovative Agricultural Concepts, LLC."

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 a corrective assignment to correct the assignee name from "Innovated Agricultural Concepts, LLC" to "Innovative Agricultural Concepts, LLC" was recorded on July 17, 2009, **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 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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LATHROP & GAGE LLP
2345 GRAND Boulevard
SUITE 2400
KANSAS CITY MO 64108

MAILED

SEP 28 2010

OFFICE OF PETITIONS

In re Patent No. 7,533,490 :
Issue Date: May 19, 2009 :
Application No. 11/172,328 : ON PETITION
Filed: June 30, 2005 :
Attorney Docket No. **438616** :

This is a corrected decision on the petition filed November 20, 2009, which is being treated as a petition 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 request is **GRANTED**.

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

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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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

MAILED
AUG 30 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,586,475 | : | |
| Lee et al. | : | DECISION ON REQUEST |
| Issue Date: 09/08/2009 | : | FOR RECONSIDERATION OF |
| Application No. 11/172600 | : | PATENT TERM ADJUSTMENT |
| Filed: 06/30/2005 | : | and |
| Attorney Docket No. | : | NOTICE OF INTENT TO ISSUE |
| 10125-4195 | : | CERTIFICAE OF CORRECTION |

This is a decision on the petition filed 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 seventy-seven (1077) 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 seventy-seven (1077) days is **GRANTED to the extent indicated herein.**

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 July 1, 2008 and ends on March 23, 2009, the day before the RCE was filed, and is 266 days not 432 days. See, 35 U.S.C. 154(b)(1)(B)(i). As such, the patent term adjustment is 908[1], not 1077 days.

In addition, on April 21, 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 1171 days.

[1] The period of adjustment also excludes overlap between the "A" period and the "B" period of three (3) days, beginning on July 1, 2008, and ending on July 3, 2008.

The Office notes that the decision of April 21, 2010 erroneously accorded patentee 263 more days of patent term adjustment than were warranted. The 263 additional days of adjustment has been removed. Accordingly, the decision of April 21, 2010, is vacated. The present decision supersedes the decision mailed on April 21, 2010.

The Office has determined that the patent term adjustment for the above-identified patent is **908 days**. The 263 additional days of adjustment will be removed.

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 eight (908)** days.

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

/DW/

Derek Woods
Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,586,475 B2

DATED : **September 8 2009**

INVENTOR(S) : Lee 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 1171 days.

Delete the phrase "by 1171 days" and insert – by 908 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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**MICROSOFT CORPORATION**
**ONE MICROSOFT WAY**
**REDMOND WA 98052-6399**

MAILED

AUG 3 1 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| John L. Miller | : | |
| Application No. 11/172,686 | : | DECISION ON PETITION |
| Filed: July 01, 2005 | : | |
| Attorney Docket No. **311385.01** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 18, 2009 and resubmitted on January 19, 2009, 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 December 29, 2009, as required by the Notice of Allowance and Fee(s) Due, mailed September 29, 2009. Accordingly, the date of abandonment of this application is December 30, 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 $1510 and the publication fee of $300, (2) the petition fee of $1620; and (3) a proper statement of unintentional delay. Accordingly, the failure to timely pay the issue fee as required by the Notice of Allowance and Fee(s) is accepted as being unintentionally delayed.

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

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

Ramesh Krishnamurthy

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

**MAILED**

SEP 28 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent of Mark Kent et al. | : | DECISION ON REQUEST |
| Patent No. 7,593,492 | : | FOR RECONSIDERATION OF |
| Issue Date: September 22, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/172,702 | : | AND NOTICE OF INTENT TO |
| Filing Date: June 30, 2005 | : | ISSUE CERTIFICATE OF |
| Attorney Docket No. 16213US02 | : | CORRECTION |

This is a decision on the petition filed May 21, 2010, requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by nine hundred ninety-nine (999) days.

The request for reconsideration of the patent term adjustment indicated on the patent is **dismissed**.

Patentees contend the Office improperly entered a 2-day reduction for delay under 37 C.F.R. § 1.704(b) as a result of a reply filed February 2, 2009.

On May 14, 2009, the Office issued the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) advising Patentees of a patent term adjustment to date of 548 days.

37 C.F.R. § 1.705(b) states,

> Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, ... must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee.

Patentees could have filed a petition under 37 C.F.R. § 1.705(b) disputing the propriety of the 2-day reduction on or before the date the issue fee was submitted.

Patentees did *not* file a petition under 37 C.F.R. § 1.705(b) disputing the propriety of the 2-day reduction.

The patent issued September 22, 2009. The patent set forth a patent term adjustment of 548 days.

The patent term adjustment of 548 days on the patent was the sum of 581 days of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") and 449 days of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") reduced by 449 days of overlap between A Delay and B Delay and reduced by 33 days of delay under 35 U.S.C. § 154(b)(2)(C) ("Applicant Delay").

Patentees filed a Request for Recalculation of Patent Term Adjustment in View of *Wyeth* ("Wyeth Request") on March 10, 2010.

The Office issued a decision in response to the March 10, 2010 request on April 21, 2010. The decision stated a certificate of correction setting forth a patent term adjustment of 997 days would be issued unless a request for reconsideration of the decision was filed within the longer of one month or 30 days from the issuance date of the decision.

The patent term adjustment of 997 days was the sum of 581 days of A Delay and 449 days of B Delay reduced by 0 days of overlap between A Delay and B Delay and reduced by 33 days of Applicant Delay.

The instant petition was filed May 21, 2010. The petition does not assert the patent term adjustment in the April 21, 2010 decision was based on an improper determination of the number of days of B Delay or the number of days of overlap between A Delay and B Delay. Instead, the petition asserts the Office miscalculated the number of days of Applicant Delay.

Patentees' appear to misunderstand the nature of the Wyeth Request filed February 2, 2010. A Wyeth Request only allows a party to challenge the number of days by which the Office reduced the patent term adjustment for overlap between A Delay and B Delay. The Wyeth Request form submitted by Patentees explicitly states, with emphasis added, "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)."

A party may not challenge the Office's determination of Applicant Delay via a Wyeth Request or via a request for reconsideration of a decision in response to a Wyeth Request. Therefore, the petition is dismissed.

In view of the prior discussion, a certificate of correction will be issued indicating the term of the patent is extended or adjusted by nine hundred ninety-seven (997) days.

Submission of the $200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

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. 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-seven (997) 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

Attached: Draft Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE**

# CERTIFICATE OF CORRECTION

| | | |
|---|---|---|
| PATENT NO. | : | 7,593,493 B2 |
| APPLICATION NO. | : | 11/172,702 |
| DATED | : | September 22, 2009 |
| INVENTOR(S) | : | Mark Kent 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 548 days.

Delete the phrase "by 548 days" and insert -- by 997 days--

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LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK NY 10016

MAILED
AUG 02 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Onoet al. | : | |
| Application No. 11/172712 | : | DECISION |
| Filing or 371(c) Date: 07/01/2005 | : | ON PETITION |
| Patent No.: 7553797 | : | |
| Issue Date: 06/30/2009 | : | |
| Attorney Docket Number: KOY-55 | : | |

This is a decision on the "Request to Correct Assignee Under 37 CFR 3.81(b)," filed March 24, 2010, 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 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 DAI NIPPON PRINTING CO. LTD. is assignee 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.

The Certificate of Correction fee has been charged to Petitioner's deposit account.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

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FREEDMAN & ASSOCIATES
55 MURRAY ST
SUITE 230
K1N 5M3
CANADA

MAILED
APR 14 2011
OFFICE OF PETITIONS

In re
Application No. 11/172,947
Filed: July 5, 2005
Patent No. 7,250,899
Attorney Docket No. 027066-003300US

DECISION

This is a decision on the fee deficiency submission under 37 CFR 1.28(c), filed March 4, 2011, and again on March 7, 2011.

The fee deficiency submission under 37 CFR 1.28 of $490 for the four year maintenance fee is hereby accepted.

The change of status to large entity has been entered.

As petitioner was charged the $490 on two separate occasions, $490 has been refunded to Deposit Account No. 50-1142.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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**F. CHAU & ASSOCIATES, LLC**
**130 WOODBURY ROAD**
**WOODBURY NY 11797**

**MAILED**

SEP 2 1 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Christopher J. VITITO | : | |
| Application No. 11/173,058 | : | ON PETITION |
| Filed: July 5, 2005 | : | |
| Attorney Docket No. VIT-016 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 20, 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 December 31, 2008. 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). 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 April 1, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1620; and (3) the required statement of unintentional delay have been received.

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 undersigned at (571) 272-6735.

This application is being referred to Technology Center 3636 for further processing in the normal course of business.

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

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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

MAILED
DEC 06 2010
OFFICE OF PETITIONS

In re Patent No. 7,422,868
Issued: September 9, 2008
Application No. 11/173,092
Filed: July 1,2005
Attorney Docket No. 10743/25 (BH-25)

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(d)" filed November 11, 2008, requesting that the patent term adjustment determination for the above-identified patent be changed from 34 days to 104 days. Since the request is after issuance, the request is being treated under 37 CFR 1.705(d). 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 court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).[1]

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 adjusted by one hundred four (104) days and 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 **one hundred four (104)** 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

---

[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).

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,422,868 B2

DATED : September 9, 2008

INVENTOR(S) : Frank Fan

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 (34) days

Delete the phrase "by 34 days" and insert – by 104 days--

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**MARGARET ANDERSON**
**106 E. 6TH STREET, SUITE 900**
**AUSTIN TX 78701**

MAILED
MAR 14 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jung et al. | : | DECISION ON PETITION |
| Application No. 11/173,166 | : | TO WITHDRAW |
| Filed: July 1, 2005 | : | FROM RECORD |
| Attorney Docket No. QQ1-0122US | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 26, 2011.

The request is **NOT APPROVED**.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

***An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.***

According to a review of current USPTO records petitioner has not requested the address be changed to a properly recorded assignee or the first listed inventor. The Customer Number 55922 is neither the first named inventor nor the assignee who properly became of record under 37 CFR 3.71 As such, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

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.

Currently, there is no outstanding Office action that requires a reply.

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

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: LEE & HAYES, PLLC
601 W RIVERSIDE
SUITE 1400
SPOKANE, WA 99201

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PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS MN 55402-2100

**MAILED**

OCT 08 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent of Fiedler | : | |
| Patent No. 7,573,967 | : | ON PETITION REGARDING |
| Issue Date: August 11, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/173,226 | : | |
| Filed: July 1, 2005 | : | |
| Atty. Docket No. 3510.39US01 | : | |

This is a decision on the petition filed on May 26, 2010, which is being treated as a petition under 37 CFR 1.181 requesting that the Office reconsider its decision to deny patentee's Request for Recalculation of Patent Term Adjustment, mailed April 26, 2010.

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, mailed April 26, 2010, in which the Office dismissed patentee's request as untimely filed.

The petition is **dismissed as moot.**

The Office mailed a Notice Concerning Improper Dismissal of the Request for Recalculation of Patent Term Adjustment in View of Wyeth on May 18, 2010. This Notice explained that the April 26, 2010 decision was vacated because the Office was closed from February 8 - 11, 2010 due to a snowstorm. The Office considers each day from February 8 - 11, 2010 a federal holiday. Thus, any actions due from February 6 - 11, 2010 will be considered timely if action was taken on the next succeeding business day on which the Office was open, February 12, 2010. The Office concluded that patentee's Request for Recalculation of Patent Term Adjustment in View of Wyeth, filed February 10, 2010, was timely filed and determined the patent term adjustment to be 964 days.

As patentee did not request reconsideration of the May 18, 2010 Notice within one month/30 days of the mail date of the May 18, 2010 Notice, 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 **nine hundred sixty-four (964)** days.

No fee has been charged in connection with this matter.

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

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**MARJAMA MULDOON BLASIAK & SULLIVAN LLP**
**250 SOUTH CLINTON STREET**
**SUITE 300**
**SYRACUSE NY 13202**

MAILED
MAY 31 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,301,152 | : | |
| Issue Date: November 27, 2007 | : | |
| Application No. 11/173,260 | : | NOTICE |
| Filed: July 1, 2005 | : | |
| Attorney Docket No. 1179_036 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed April 18, 2011. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

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

Your fee deficiency submission under 37 CFR 1.28 is hereby accepted. The petition is **GRANTED**.

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

This file is being forwarded to Files Repository.

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

/Kimberly Inabinet/
Kimberly Inabinet
Petitions Examiner
Office of Petitions

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United States Patent and Trademark Office
P.O. Box 1450
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Olson & Cepuritis, LTD.
20 NORTH WACKER DRIVE
36TH FLOOR
CHICAGO IL 60606

MAILED
AUG 30 2011
OFFICE OF PETITIONS

In re Patent No. 7,648,764 :
Issue Date: January 19, 2010 :
Application No. 11/173,474 : DECISION ON PETITION
Filed: June 30, 2005 :
Attorney Docket No. TSP-105 :

This is a decision on the Request To Correct Assignee Under 37 CFR 3.81(b) And Request For Certificate Of Correction Under 37 C.F.R. §1.322 And §1.323, filed July 19, 2010, which is being treated as a 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 requests that the present Petition was submitted to correct the assignee's name on the previously submitted PTOL 85B and such error was inadvertent and unintentional. 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:

"UChicago Argonne, LLC., Chicago, IL"

to:

--Tech-Seal Products, Inc., Schaumburg, IL--

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. 7,648,764

Cheryl Gibson Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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**ORUM & ROTH LLC**
**53 WEST JACKSON BLVD.**
**CHICAGO IL 60604**

MAILED

SEP 24 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hafele et al. | : | |
| Application No. 11/173,484 | : | DECISION ON PETITION |
| Filed: July 1, 2005 | : | |
| Attorney Docket No. 14199 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 16, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 30, 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 timely obtained. Accordingly, the application became abandoned on August 31, 2007. A Notice of Abandonment was mailed January 11, 2008.

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 $1,620.00, and (3) a proper statement of unintentional delay.

Additionally, 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 $1,110.00, three- month extension of time fee submitted with the petition on January 16, 2009 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be refunded to petitioner's credit card in due course.

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

This application is being referred to Technology Center AU 2612 for appropriate action by the Examiner in the normal course of business on the reply received.

Joan Olszewski
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE of Data Management

Orum & Roth LLC
53 West Jackson Blvd.
Chicago IL 60604

MAY 23 2011

In re Application of
HAFELE, ULRICH et al.
Application No. 11/173, 484
Filed: July 1, 2005
Attorney Docket No.: 14199

**DECISION ON PETITION**

This is a decision on the Petition To Withdraw Holding Of Abandonment, received in the United States Patent & Trademark (USPTO) on April 25, 2011.

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 October 28, 2010. The Notice of Abandonment, mailed on February 15, 2011 indicates, "The submitted fee of $0 is insufficient. A balance of $1810.00 is due".

The Office acknowledges receipt of Part B – Fee(s) Transmittal via facsimile transmission on February 4, 2011 authorizing that the Issue Fee be charged to Deposit Account No. 04-2219. On February 4, 2011 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

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| In re Application of | : | |
| Hafele et al. | : | DECISION ON PETITION |
| Application Number: 11/173,484 | : | |
| Filing Date: 07/01/2005 | : | |
| Attorney Docket Number: 14199 | : | |
| | : | |

This is a decision on the petition filed on June 7, 2011, under 37 CFR 1.137(a), 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(a)," or "Petition Under 37 CFR 1.137(b)."

The application became abandoned on January 29, 2011, for failure to timely submit the issue and publication fee as required by the Notice of Allowance and Fee(s) Due mailed on October 28, 2010, which set a three (3) month statutory period for reply.

On February 4, 2010 (certificate of mailing date January 28, 2011), the issue fee transmittal form, accompanied by a transmittal letter and amendment under 37 CFR 1.312, was filed. However, no payment of the issue and publication fees was included with the submission filed on February 4, 2010, and counsel's deposit account, for which authorization to charge any required fees was provide in the amendment under 37 CFR 1.312, contained a balance of $49.00, which was insufficient to charge

the amount due for the issue and publication fees. Accordingly, a Notice of Abandonment was mailed on February 15, 2011.

On April 25, 2011, a petition to withdraw the holding of abandonment was filed. On May 23, 2011, the Office of Data Management mailed a decision dismissing the petition.

On June 7, 2011, the subject petition was filed.

Petitioners assert that payment of $1,810.00 for the issue and publication fee was timely submitted on January 28, 2011 by means of a check. Petitioners further state that an itemized return receipt postcard was also submitted, but was not returned to petitioners. Petitioners aver that the check and postcard became lost after receipt at the USPTO.

A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. 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(l);

(3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The petition lacks item (3).

With regards to item (3), the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".[1] 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.[2]

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[3]

---

[1] 35 U.S.C. § 133.

[2] 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).

[3] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioners' argument has been considered, but is not persuasive. The U.S. Patent and Trademark Office (Office) Image File Wrapper (IFW) is the official record of the papers originally filed in this application.[4] A review of the IFW reveals that no payment of the issue or publication fees was submitted on February 4, 2011. No check for payment was received since no such check for $1,810.00 is present among the application papers received on that date. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence.

With regard to petitioners' assertion that an itemized postcard was filed, MPEP 503 states, in pertinent part:

> 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).

It is an unfortunate circumstance if a properly itemized postcard was filed with applicants' reply, and the stamped postcard was not received by applicants after the reply was filed. Nevertheless, the showing of record does not support petitioners' contention that a check in payment of $1,810.00 for the issue and

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[4] MPEP 103.

publication fees was timely received by the USPTO. In the absence of an itemized, stamped postcard in compliance with MPEP 503, the showing of record is insufficient to establish that the check for payment of the issue and publication fees was received in the Office on the date asserted by petitioner. Alternatively, petitioners may present a canceled check or other evidence that the payment was timely received in the USPTO.

It is further noted that the copy of the postcard provided simply itemizes the filing of "Government Fees: $1810-". The postcard, however, does *not* itemize the filing of a check for $1810.00. As such, assuming, *arguendo*, the postcard as shown in the petition was received by petitioner, the postcard does not serve as *prima facie* evidence that a check for $1,810.00 was received in the USPTO on February 4, 2011.

Furthermore, petitioner' could have avoided the predicament which has now occurred by ensuring that an adequate balance was present in counsel's deposit account to charge the issue and publication fees. In this regard, 37 CFR 1.25 states that an amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. Petitioners have not explained why the deposit account did not contain a sufficient balance to cover the payment of the issue and publication fees.

In summary, the showing of record is that rather than unavoidable delay, petitioner failed to take adequate precautions to ensure that the issue and publication fees were timely paid. As petitioners has not shown that they exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.[5]

**ALTERNATIVE VENUE**

Petitioners may wish to consider filing a petition under 37 CFR 1.137(b), 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). A grantable petition pursuant to 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 utility or plant application

[5] See note 7, supra.

filed on or after 8 June, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The 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 petitioners 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
Attn: Office of Petitions

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

Correspondence may also be submitted via the Electronic Filing System of the USPTO.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Sep-11

ORUM & ROTH LLC
53 WEST JACKSON BLVD.
CHICAGO IL 60604

MAILED
SEP 06 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hafele et al. | : | |
| Application No. 11/173,484 | : | ON PETITION |
| Filed: 07/01/2005 | : | |
| Attorney Docket No. 14199 | : | |

This is a decision in response to the petition under 37 CFR 1.137(b) filed on August 3, 2011, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on January 29, 2011, for failure to timely submit the issue and publication fees as required by the Notice of Allowance and Fee(s) Due mailed on October 28, 2010, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on February 15, 2010.

Receipt of the issue and publication fee and petition fee filed on August 3, 2011 is acknowledged.

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

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

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

**BALLARD SPAHR LLP**
**SUITE 1000**
**999 PEACHTREE STREET**
**ATLANTA GA 30309-3915**

MAILED
DEC 01 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **JAY,** Richard M. et al. | : | |
| Application No. 11/173,510 | : | DECISION ON PETITION |
| Filed: July 01, 2005 | : | TO WITHDRAW |
| Attorney Docket No. **10128.0001U1** | : | 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 05, 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 John A. Chionchio on behalf of all attorneys of record who are associated with customer No. 23859. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Dr. Richard M. Jay at the address indicated below.

There are no outstanding Office actions at this time.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **DR. RICHARD M. JAY**
**340 S. SIXTH STREET**
**PHILADELPHIA, PA 19106**

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

ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO CA 92101

MAILED
FEB 14 2011
OFFICE OF PETITIONS

In re Application of :
Collins, et al. :
Application No. 11/173,554 : NOTICE
Filed: July 1, 2005 :
Attorney Docket No. 1156.044 :

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 undersigned at (571) 272-3205.

*/ALESIA M. BROWN/*

Alesia M. Brown
Attorney Advisor
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

Bib Data Sheet

**CONFIRMATION NO. 8568**

| SERIAL NUMBER | FILING OR 371(c) DATE | CLASS | GROUP ART UNIT | ATTORNEY DOCKET NO. |
|---|---|---|---|---|
| 11/173,554 | 07/01/2005<br>RULE | 062 | 3744 | 1156.044 |

**APPLICANTS**

Kenneth A. Collins, Mission Viejo, CA;
David Seari Kimball, Irvine, CA;

**** CONTINUING DATA ****************************

**** FOREIGN APPLICATIONS ************************

**IF REQUIRED, FOREIGN FILING LICENSE GRANTED**
** 07/25/2005

| | | STATE OR COUNTRY | SHEETS DRAWING | TOTAL CLAIMS | INDEPENDENT CLAIMS |
|---|---|---|---|---|---|
| Foreign Priority claimed<br>35 USC 119 (a-d) conditions met<br>Verified and Acknowledged | ☐ yes ☐ no<br>☐ yes ☐ no ☐ Met after Allowance<br>Examiner's Signature Initials | CA | 2 | 17 | 3 |

**ADDRESS**
24955

**TITLE**
PRIMARY HEAT EXCHANGER FOR PATIENT TEMPERATURE CONTROL

| FILING FEE RECEIVED | | |
|---|---|---|
| 800 | FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following: | ☐ All Fees<br>☐ 1.16 Fees ( Filing )<br>☐ 1.17 Fees ( Processing Ext. of time )<br>☐ 1.18 Fees ( Issue )<br>☐ Other _____<br>☐ Credit |

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : July 24, 2009

TO SPE OF : ART UNIT 3711
SUBJECT : Request for Certificate of Correction for Appl. No.: 11/173570
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**

Magdalene Talley
**Certificates of Correction Branch**
**703-308-9390 ext. 120**

**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:** _____

_____

_____

_____

_____

EUGENE KIM
SUPERVISORY PATENT EXAMINER

**SPE** — 3711 **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

December 12, 2011

James C. Scheller, Jr.
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles CA 90025-1026

| | | |
|---|---|---|
| In re Application of | : | |
| DOWNING, ELIZABETH A. | : | **DECISION ON PETITION** |
| Application No. 11/173,620 | : | |
| Filed: 07/01/2005 | : | ***ACCEPTANCE OF COLOR*** |
| Attorney Docket No. 06893-P004 | : | ***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) July 01, 2005.

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, and
3. The specification containing the following language as the first paragraph in that portion of the specification relating to the brief description of the drawings.

   *"The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."*

Note: Only one set of drawings is required when petition is filed via EFS WEB.

The petition was accompanied by all of the requirements above. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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**DISCUS DENTAL, LLC**
**8550 HIGUERA STREET**
**CULVER CITY CA 90232**

MAILED
SEP 13 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jeff MacDonald, et al. | : | |
| Application No. 11/173,632 | : | ON PETITION |
| Filed: June 30, 2005 | : | |
| Attorney Docket No. P1027US01 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 23, 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 January 21, 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). A three (3) month extension of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is July 22, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of 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 1612 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

| 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 | 11173659 |
| Filing Date | 30-Jun-2005 |
| First Named Inventor | Mark Lindner |
| Art Unit | 2614 |
| Examiner Name | WILLIAM DEANE JR |
| Attorney Docket Number | 030358 |
| Title | SYSTEM AND METHOD FOR RESOLVING CONFLICTS IN MULTIPLE SIMULTANEOUS COMMUNICATIONS IN A WIRELESS SYSTEM |

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 | /Raphael Freiwirth/ |
| Name | Raphael Freiwirth |
| Registration Number | 52918 |

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 23,2011

In re Application of :

Mark Lindner

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 11173659

Filed : 30-Jun-2005

Attorney Docket No : 030358

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed May 23,2011 , 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 2614 for processing of the request for continuing examination under 37 CFR 1.114 .

Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

**MAILED**
DEC 15 2011
**OFFICE OF PETITIONS**

In re Application of :
Kent et al. :
Application No. 11/173,727 :
Filed: June 30, 2005 :
Attorney Dkt. No. 16214US02 :
For: METHOD AND SYSTEM FOR PRE-EQUALIZATION IN A SINGLE WEIGHT SPATIAL MULTIPLEXING MIMO SYSTEM :

ON APPLICATION FOR PATENT TERM ADJUSTMENT

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 December 7, 2011. This request is properly treated under 37 CFR 1.705(b). Applicants request that the determination of patent term adjustment be corrected from five hundred seventy-three (573) days to six hundred ninety-six (696) 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].

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

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

The Office of Data Management has been advised of this decision. This 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 the undersigned at (571) 272-3215.

Charlema Grant

Charlema Grant
Attorney Advisor
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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PO BOX 1022
MINNEAPOLIS MN 55440-1022

MAILED

JUN 27 2011

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,885,940 | : DECISION ON |
| Hegde, et al. | : REQUEST FOR RECONSIDERATION |
| Application No. 11/173,737 | : of PATENT TERM ADJUSTMENT |
| Issue Date: January 11, 2011 | : |
| Filed: June 30, 2005 | : |
| Attorney Docket No. 26310-0086001 | : |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)", filed April 8, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected from four hundred fifty-one (451) days to five hundred eighty-one (581) days.

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

On February 8, 2011, the instant application matured into U.S. Patent No. 7,885,940 with a patent term adjustment of four hundred fifty-one (451) days. The Office determined a patent term adjustment of 451 days based upon 386 days of Office delay pursuant to 37 CFR 1.703(a)(1), 3 days of Office delay pursuant to 37 CFR 1.703(a)(2), and 62 days of Office delay pursuant to 37 CFR 1.703(a)(3), reduced by 0 days of Applicant delay.

Patentees argue that even though they filed an RCE on April 24, 2008 (and again on March 10, 2009 and March 31, 2010), they should be awarded 37 CFR 1.703(b) "over three year" delay from the time the Office mailed a Notice of Allowance on October 1, 2010 until the issue date of the patent. In other words, Patentees argue that no continued examination took place during this time period, and the Office should be accorded 131 days of delay pursuant to 37 CFR 1.703(b). Patentees' argument has been considered, but is not persuasive.

## RELEVANT STATUTE AND REGULATIONS

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(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), 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.

The implementing regulation, 37 CFR 1.702(b) provides that:

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);
(2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
(4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
(5) Any delay in the processing of the application by the Office that was requested by the applicant.

## OPINION

Patentee's arguments have been considered, but not found persuasive. The Office calculated the period of "B delay" pursuant to 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.702(b)(1) as 0 days based on the application having been filed under 35 U.S.C. 111(a) on June 30, 2005 and a request for continued examination under 132(b) having been filed on April 24, 2008. In other words, the 130 day period beginning on the date of mailing of the notice of allowance to the date

of issuance of the patent was considered time consumed by continued examination of an application under 35 U.S.C. 132(b) and was not included in the "B delay."

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.

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

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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.

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), 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.

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

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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.

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 procedures3 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

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[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.

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 April 24, 2008, and the patent issued by virtue of that request on February 8, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on April 24, 2008 and ending on February 8, 2011 is not included in calculating Office delay.

## CONCLUSION

In view thereof, it is concluded that the patent term adjustment of 451 days indicated on the patent is correct.

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

Cliff Congo
Petitions Attorney
Office of Petitions

PTO/SB/131 (01-10)
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U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
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# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH**

| | |
|---|---|
| Attorney Docket Number: TI-38835 | Patent Number: 7,668,265 |
| Filing Date (or 371(b) or (f) Date): 07-01-2005 | Issue Date: 02/23/2010 |
| First Named Inventor: Jaiganesh Balakrishnan | |
| Title: ULTRA WIDEBAND INTERFERENCE CANCELLATION FOR ORTHOGONAL FREQUENCY DIVISION MULTIPLEX TRANSMITTERS BY PROTECTION-EDGE TONES | |

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 / Wade J. Brady III / | Date August 12, 2010 |
| Name (Print/Typed) Wade J. Brady III | Registration Number 32,080 |

***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.*

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

Mail Date: 08/18/2010

| | | |
|---|---|---|
| **Applicant** | : Jaiganesh Balakrishnan | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7668265 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/173,840 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/01/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1207** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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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MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

MAILED
NOV 01 2010
OFFICE OF PETITIONS

In re Application of :
Stephen J. Murrell et al :
Application No. 11/173,856 : ON PETITION
Filed: June 30, 2005 :
Attorney Docket No. 149.0002-01000

This is a decision on the petition, filed October 29, 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 September 22, 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 2457 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

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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 Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

MAILED

JAN 11 2011

OFFICE OF PETITIONS

In re Application of :
Kent et al. :
Application No. 11/173871 :
Filed: 06/30/2005 :
Atty Docket No. :
16202US02 :

ON APPLICATION FOR
PATENT TERM ADJUSTMENT

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 on November 3, 2010, which is treated as a petition under 37 CFR 1.705(b). Applicants submit that the patent term adjustment to be indicated on the patent should be increased from 572 days by 923 days to 1495 days. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue the patent.

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). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

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

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, 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). No additional fees are required.

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.

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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.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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CHICAGO IL 60661

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OFFICE OF PETITIONS

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|---|---|---|
| In re Patent No. 7,894,507 | : | DECISION ON APPLICATION |
| Kent et al. | : | FOR RECONSIDERATION OF |
| Issue Date: 02/22/2011 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/173,871 | : | AND NOTICE OF INTENT TO |
| Filing Date: 06/30/2005 | : | ISSUE CERTIFICATE OF |
| Attorney Docket No. | : | CORRECTION |
| 16202US02 | : | |

This is a decision on the petition filed on April 22, 2011, under 37 C.F.R. § 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 four hundred thirty-two (1432) 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 three hundred ninety-seven (1397) days**.

Patentee disputes the period of time excluded from B delay for appellate review. Patentee's argument has been considered, but not found persuasive.

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). In this instance, the "over three year period" is 967 days, beginning on July 1, 2008, the date after the date that is three years after the filing date of the application and ending on February 22, 2011, the date the patent issued.

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, 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 period consumed by appellate review is 108 days, beginning on June 30, 2010, the date of filing of the notice of appeal and ending on October 15, 2010, the subsequent date of the mailing of the notice of allowance. Thus, B delay is 859 (967 - 108) days.

Patentees dispute the period of reduction of 3 days entered for applicant delay, pursuant to 35 U.S.C. § 154(b)(2)(C) and 37 CFR 1.704(b). This reduction has been reconsidered, and it is determined that entry of a reduction for this reply timely filed pursuant to 35 U.S.C. §21(b) is not warranted. Accordingly, the period of reduction of 3 days is being removed.

Accordingly, the patent term adjustment is 1397 days (687 days of A delay + 859 days of B delay - 34 days of overlap - 115 (118 - 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.

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, Patentee is 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.

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

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 three hundred ninety-seven (1397) 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 : 7,894,507 B2

DATED : **Feb. 22, 2011** **DRAFT**

INVENTOR(S) : Kent 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 1394 days.

Delete the phrase "by 1394 days" and insert – by 1397 days--

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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SEP 15 2011
OFFICE OF PETITIONS

MCANDREWS HELD & MALLOY, LTD.
500 W. MADISON ST.
SUITE 3400
CHICAGO IL 60661

| | | |
|---|---|---|
| In re Patent No. 7,894,507 | : | DECISION ON REQUEST |
| Kent et al. | : | FOR |
| Application Number: 11/173,871 | : | RECONSIDERATION OF |
| Issue Date: 02/22/2011 | : | PATENT TERM ADJUSTMENT |
| Filing or 371(c) Date: 06/30/2005 | : | |
| Atty Docket No. | : | |
| 16202US02 | : | |

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 § 1.705b,d)) RESPECTING A SUCCESSFUL APPEAL, filed on August 16, 2011, which is being treated as a renewed petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be revised to indicate that the term of the above-identified patent is extended or adjusted by one thousand five hundred five (1505) 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 one thousand three hundred ninety-seven (1397) days.

Patentee again disputes the period of time excluded from "B" delay for appellate review. Patentee's argument has been considered, but is not found persuasive.

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). In this instance, the "over three year period" is 967 days, beginning on July 1, 2008, the date after the date that is three years after the filing date of the application and ending on February 22, 2011, the date the patent issued.

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, 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 period consumed by appellate review is 108 days, beginning on June 30, 2010, the date of filing of the notice of appeal and ending on October 15, 2010, the subsequent date of the mailing of the notice of allowance. Thus, B delay is 859 (967 – 108) days.

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, Patentee is 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.

Accordingly, no change will be made to the patent term adjustment of 1397 days (687 days of A delay + 859 days of B delay – 34 overlapping days - 115 days of applicant delay) as set forth in the decision mailed on July 19, 2011.

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) 272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 30, 2010

TO SPE OF : ART UNIT 2191

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/173923 No.: 7836443

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**

**Magdalene Talley**

_____
**Certificates of Correction Branch**
**(571)272-0XXX**

**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** WEI ZHEN **Art Unit** 2191

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:1010

**DATE** : October 12, 2010

**TO SPE OF** : ART UNIT 2833

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7094102

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:**

/renee s luebke/
SPE - AU 2833

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:1107

**DATE** : July 27, 2011

**TO SPE OF** : ART UNIT 2833

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7108556

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:**

/renee s luebke/
SPE - AU 2833

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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**FISH & RICHARDSON P.C. (AT)**
**P.O. BOX 1022**
**MINNEAPOLIS, MN 55440-1022**

**MAILED**

FEB 02 2012

**OFFICE OF PETITIONS**

In re Application of :
**Paul JUDGE, et al** :
Application No. 11/173,941 :
Filed: July 1, 2005 :
Attorney Docket No. 20281-010001 :

ON PETITION

This is a decision on the petition, filed on December 6, 2011, Petition Under 37 CFR § 1.183 requesting waiver of the requirement of 37 CFR §§ 1.48(a)(3), 1.63 and 1.64(a). The processing fees of $400.00 under 37 CFR § 1.17(f) and $130.00 under 37 CFR § 1.17(i) have been charged to Deposit Account 06-1050.

The petition under 37 CFR § 1.183 is **GRANTED**.

The petition under 37 CFR § 1.48(a) is **GRANTED**.

Petitioner indicates that during a review of the inventorship of the abovementioned application, that it was discovered that without any deceptive intent on behalf of any party, the listed inventorship was incorrect. Petitioner indicates that SVEN KRASSER was also an inventor of the subject matter claimed and submits the consent of the assignee to the addition of SVEN KRASSER. Petitioner also indicates that it was discovered that without any deceptive intent on behalf of any party, SVEN KRASSER was incorrectly not listed as an inventor. All signatures for a subsequent declaration have been obtained, except for Paul Judge and Guru Rajan. Petitioner identifies the last known addresses of Paul Judge and Guru Rajan, whose signatures are required on the declaration, and submits statements of facts regarding the unsuccessful attempts to reach Pail Judge and Guru Rajan. Petitioner now submits a petition under 37 CFR 1.183 requesting a waiver of the requirements of 37 CFR §§ 1.48(a)(3), 1.63 and 1.64.

37 CFR § 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations which is not a requirement of the statutes may be suspended or waived by the Commissioner. The declarations along with the submitted exhibits are sufficient to establish due diligence for granting of the petition. The rule will be waived to comply with the

requirement, since there is no other way to present the required declaration. The request under 37 CFR § 1.183 to waive the requirements of 37 CFR §§ 1.48(a)(3), 1.63 and 1.64 is granted. The substitute declaration filed December 6, 2011 is accepted and will be entered. The inventorship of this application has been amended by the addition of **SVEN KRASSER**.

The application file is being forwarded to Technology Center 2400, Art Unit 2431 for further action as appropriate.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-0602.

Thurman K. Page
Petitions Examiner
Office of Petitions

cc: Corrected Filing Receipt

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 NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 11/173,941 | 07/01/2005 | 2431 | 1840 | 20281-010001 | 47 | 6 |

**CONFIRMATION NO. 7449**

**CORRECTED FILING RECEIPT**

26167
FISH & RICHARDSON P.C. (AT)
P.O BOX 1022
Minneapolis, MN 55440-1022

*OC000000052375466*

Date Mailed: 02/03/2012

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)**

Paul Judge, Alpharetta, GA;
Guru Rajan, Duluth, GA;
Dmitri Alperovitch, Atlanta, GA;
Matt Moyer, Lawrenceville, GA;
Sven Krasser, Atlanta, GA;

**Assignment For Published Patent Application**

CipherTrust, Inc.

**Power of Attorney:**

John Hayden--37640
Nagendra Setty--38300
Troy Van Aacken--50847
Christopher Green--52964

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/625,507 11/05/2004
and is a CIP of 11/142,943 06/02/2005 ABN
and is a CIP of 10/093,553 03/08/2002 PAT 6941467
and is a CIP of 10/094,211 03/08/2002 PAT 7458098
and is a CIP of 10/094,266 03/08/2002 PAT 7124438
and is a CIP of 10/361,091 02/07/2003 PAT 7096498
and is a CIP of 10/373,325 02/24/2003 PAT 7213260
and is a CIP of 10/361,067 02/07/2003 ABN
and is a CIP of 10/384,924 03/06/2003 PAT 7694128

**Foreign Applications** (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see http://www.uspto.gov for more information.)

**If Required, Foreign Filing License Granted:** 07/25/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/173,941**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**Title**

MESSAGE PROFILING SYSTEMS AND METHODS

**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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ALEXANDRIA, VA 22313-1450
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**ILLUMINA, INC.**
**LEGAL DEPARTMENT**
**9885 TOWNE CENTRE DRIVE**
**SAN DIEGO CA 92121-1975**

MAILED
AUG 04 2010
OFFICE OF PETITIONS

In re Application of :
Nels OLSON et al. :
Application No. 11/173,952 :
Filed: July 1, 2005 :
Attorney Docket No. IP-0216-US (01-00020) :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 9, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed November 18, 2009, which set a statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on February 19, 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[1]; (2) the petition fee of $1620; and (3) the required statement of unintentional delay have been received. Accordingly, the Issue Fee payment is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099 or in his absence, the undersigned at (571) 272-3219.

The Office of Data Management (Pubs) has been advised of this decision. The application is, thereby, referred to the Office of Data Management (Pubs) for processing into a patent. Any questions regarding the printed copy of the patent may be directed to Pubs at (571) 272-4200.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

[1] There was no distinct but concurrent requirement for drawings or payment of a publication fee.

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

**Margaret Anderson**
**106 E. 6th Street, Suite 900**
**Austin TX 78701**

MAILED

MAR 14 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **ROYCE A. LEVIEN, ET AL.** | : | |
| Application No. 11/173,990 | : | DECISION ON PETITION |
| Filed: July 1, 2005 | : | TO WITHDRAW |
| Attorney Docket No. **QQ1-0134US** | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed January 27, 2011.

The request is **NOT APPROVED**.

The request cannot be approved because the Office no longer accept address changes to a new practitioner/customer number or law firm filed with a request, absent the filing of a power of attorney to the new representative.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71* or, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

A courtesy copy of this decision is being mailed to the address on the request. However, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: LEE & HAYE, PLLC
601 W RIVERSIDE
SUITE 1400
SPOKANE, WA 99201

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) |
|---|---|---|---|---|
| 7,251,471 | 2007-07-31 | 11/174,191 | 2005-06-30 | 07438-00011 |

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 | /Craig J. Cox/ | Date (YYYY-MM-DD) | 2011-11-04 |
| Name | Craig J. Cox | Registration Number | 39643 |

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. 7251471
Issue Date: July 31,2007
Application No. 11174191
Filed: June 30,2005
Attorney Docket No. 66914/P001US/10507189

:
: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

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

Omidyar Network Commions LLC
1881 Broadway, sls, 200
Redwood CA 94083

MAILED

SEP 22 2010

OFFICE OF PETITIONS

In re Application of :
OMIDYAR, PIERRE :
Application No. 11/174,280 : DECISION ON PETITION
Filed: 07/01/2005 :
Attorney Docket No. 24803-10513 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 2, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely and proper reply within the meaning of 37 CFR 1.113 to the final Office action, mailed July 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 obtained. Accordingly, the application became abandoned on October 7, 2009. A Notice of Abandonment was mailed on February 17, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that applicant has supplied (1) the reply in the form of a RCE, the RCE fee, and the submission required by 37 CFR 1.114; (2) the petition fee; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 2456 for processing of the RCE and for appropriate action by the Examiner on the amendment submitted in accordance with 37 CFR 1.114.

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

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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SEP 20 2010
OFFICE OF PETITIONS

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

| | | |
|---|---|---|
| In re Patent No. 7,643,839 | : | DECISION ON REQUEST |
| Kent et al. | : | FOR |
| Issue Date: 01/05/2010 | : | RECONSIDERATION OF |
| Application No. 11/174,303 | : | PATENT TERM ADJUSTMENT |
| Filed: 06/30/2005 | : | |
| Atty Docket No. | : | |
| 16200US02 | : | |

This is a decision on the petition filed on June 3, 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 sixty-seven (767) 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 seven hundred sixty-six (766) 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 July 1, 2008, and ends on August 5, 2009, the day before the RCE was filed, and is 401 days, not 402 days as asserted by patentee. See 35 U.S.C. 154(b)(1)(B)(i).

Accordingly, no change will be made to the patent term adjustment of 766 days (524 days Office delay + 401 days three years delay – 159 days of applicant delay) days indicated in the Decision on Request for Recalculation of Patent Term Adjustment in View of *Wyeth* and Notice of Intent to Issue Certificate of Correction, mailed on May 4, 2010.

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

**JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE**
**7 FLOOR-1, NO. 100**
**ROOSEVELT ROAD, SECTION 2**
**TAIPEI 100 TW TAIWAN**

MAILED
SEP 09 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Chungche Yu | : | |
| Application No. 11/174,421 | : | PETITION DECISION |
| Filed: July 1, 2005 | : | |
| Attorney Docket No. 26942-US-PA | : | |

Papers filed on August 19, 2010 in response to a "Petition Decision" mailed June 25, 2010, included a Reissue Applicatin Supplemental Declaration signed by previously non-signing inventor, Yu Chungche. A petition under 37 CFR 1.183 requesting waiver of the signature requirement of non-signing inventor was filed December 28, 2009 and was dismissed in a decision mailed June 25, 2010.

The petition is **Dismissed as being Moot** in view of the signed declaration.

This application is being referred to Technology Center Art Unit 2629

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

David Bucci
Petitions Examiner
Office of Petitions

11174423

**UNITED STATES DEPARTMENT OF COMMERCE**
**Patent and Trademark Office**
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Patent No. : 8111770
Inventor(s) : Jaekyun Moon
Issued : 2/7/12
For : High-bandwidth over-the-air signal processing

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule 1.322 and 1.323.

Granting of a petition under 37 CFR 1.183, requesting the requirements of 37 CFR 3.81 to be waived, is required to correct applicant's error in the Assignee, when the correct name of the assignee was not provided in accordance with either section 3.81(a) or (b) (either no name or an incorrect name was provided in item 3 of the Issue Fee Transmittal, when the assignment had been recorded or submitted for recordation at the time the issue fee was paid, including after issuance of the patent.

A petition to correct the Assignee, under 37 CFR 1.183 should include:

(1) the petition fee set forth in 37 CFR 1.117(h) (currently $130);
(2) the correct name and address of the assignee; and
(3) the reel and frame number where the assignment is recorded or proof of the date the assignment was submitted for recordation.

Any petition under 37 CFR 1.183 should be directed to the attention of the Assistant Commissioner for Patents, using the following mailing address or FAX number.

By Mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By Fax: (703) 308-6916
Attn.: Office of Petitions

If, the petition under 37 CFR 1.183, is filed and granted, the patentee would be entitled to a certificate of correction under 37 CFR 1.323 (required fee currently $100), due to the mistake in not complying with CFR 3.81.

In view of the foregoing, your request is hereby denied.

RoChaun Hardwick
Decisions & Certificates
of Correction Branch
(571) 272-0470

JOHN A. DRAGSETH
FISH & RICHARDSON P.C.
MINNEAPOLIS, MINNESOTA 55440-1022

**RMH**

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

**Margaret Anderson**
**106 E. 6th Street, Suite 900**
**Austin TX 78701**

MAILED

MAR 14 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **ROYCE A. LEVIEN, ET AL.** | : | |
| Application No. 11/174,432 | : | DECISION ON PETITION |
| Filed: July 1, 2005 | : | TO WITHDRAW |
| Attorney Docket No. **QQ1-0149US** | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed January 27, 2011.

The request is **NOT APPROVED**.

The request cannot be approved because the Office no longer accept address changes to a new practitioner/customer number or law firm filed with a request, absent the filing of a power of attorney to the new representative.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71* or, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

A courtesy copy of this decision is being mailed to the address on the request. However, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: LEE & HAYE, PLLC
601 W RIVERSIDE
SUITE 1400
SPOKANE, WA 99201

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No**.:20100830

**DATE** : August 30, 2010

**TO SPE OF** : ART UNIT 2881

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,196,342

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 KIM/
Supervisory Patent Examiner.Art Unit 2881

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.

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

MAILED
SEP 12 2011
OFFICE OF PETITIONS

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| In re Application of | : | |
| Jung et al. | : | |
| Application No. 11/174,507 | : | DECISION ON PETITION |
| Filed: July 6, 2005 | : | PURSUANT TO |
| Attorney Docket No.: 1793.1664 | : | 37 C.F.R. § 1.181(A) |
| Title: APPARATUS, METHOD, AND | : | |
| MEDIUM FOR VIDEO | : | |
| SYNCHRONIZATION | : | |

This is a decision on the petition filed August 11, 2011, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This petition pursuant to 37 C.F.R. § 1.181(a) is **DISMISSED.**

## BACKGROUND

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 April 13, 2011, 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 July 14, 2011. A Notice of Abandonment was mailed on July 29, 2011.

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

## RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

> An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

> In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. **The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable.** It is expected that the record would include, but not be limited to, the application number, attorney

> docket number, the mail date of the Office action and the due date for the response.
>
> **Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received.** A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.
>
> A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.
>
> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
>
> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).
>
> Emphases added.

## ANALYSIS

With this petition, Petitioner has stated that the Office action was not received at the correspondence address of record,[3] and has provided both a copy of the master docket for the relevant time period and a copy of the docket report that is associated with this particular application.

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3 Petition, page 1.

Petitioner's assertion of non-receipt has not been adequately supported, as will be now pointed out.

First, it is not clear if a search of the practitioner's record(s) was performed, including any file jacket or the equivalent, and the application contents. The petition makes a passing reference to a search on the first page of the same, however the concurrently submitted Berry declaration of facts does not explicitly mention any search that might have been performed.

Second, the statement of Mr. Berry which was included with this petition describes the system used for recording an Office action received at the correspondence address of record with the USPTO, however the statement is insufficient to describe the docketing system to such a degree so as to establish the reliability of the same. Petitioner has established that incoming mail is opened, date-stamped, "separated into a specific USPTO received mail file," delivered to the manager of the law firm's Docketing Department, and a response-date is docketed in the law firm's docketing database if appropriate.[4] It is not clear how this docketing system serves to apprise members of the law firm that a response date is coming due. The record suggests, but does not explicitly state, that the docketing system sends daily e-mails which contain a listing of matters which must be attended to on that date.[5] On renewed petition, this matter should be further developed, and it should be indicated to whom these e-mails are sent.[6]

## CONCLUSION

The time period for filing a renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, if reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision, and **extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.181(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be

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4 Berry declaration of facts, paragraphs 1 and 3.
5 Berry declaration of facts, paragraph 4 and the two attachments which consist of print-outs of e-mails, each of which is dated July 13, 2011.
6 It is noted that each of these e-mails was sent to the groups entitled "Attorneys" and "Secretaries."

submitted by mail,[7] hand-delivery,[8] or facsimile.[9] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[10]

Statements based on hearsay will not normally be accepted.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

7 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
8 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
9 (571) 273-8300: please note this is a central facsimile number.
10 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

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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MAILED
SEP 28 2011
OFFICE OF PETITIONS

Paper No.

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

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| In re Application of | : | |
| Jung et al. | : | |
| Application No. 11/174,507 | : | DECISION ON RENEWED |
| Filed: July 6, 2005 | : | PETITION PURSUANT TO |
| Attorney Docket No.: 1793.1664 | : | 37 C.F.R. § 1.181(A) |
| Title: APPARATUS, METHOD, AND | : | |
| MEDIUM FOR VIDEO | : | |
| SYNCHRONIZATION | : | |

This is a decision on the renewed petition filed September 20, 2011, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This renewed petition pursuant to 37 C.F.R. § 1.181(a) is **GRANTED**.

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 April 13, 2011, 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 July 14, 2011. A Notice of Abandonment was mailed on July 29, 2011.

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on August 11, 2011, where Petitioner stated that the Office action was not received at the correspondence address of record and provided both a copy of the master docket for the relevant time period and a copy of the docket report that is associated with this particular application.

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

The original petition was dismissed via the mailing of a decision on September 12, 2011.

With this renewed petition, Petitioner has established that a search of the practitioner's record(s) was performed and the relevant notice was not located,[3] and that the law firm's docketing system sends daily e-mails which contain a listing of matters which must be attended to on that date.[4]

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the Notice of Allowance and Issue Fee Due of April 13, 2011 was not received, pursuant to MPEP § 711.03(c).

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's support staff will re-mail the Notice of Allowance and Issue Fee Due of April 13, 2011, and will set a new period for response.

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.[5] All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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3 Berry declaration of facts submitted with renewed petition, paragraph 6.
4 Id. at 4.
5 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).

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PO Box 747
Falls Church Va 22040-0747

MAILED

AUG 03 2010

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,563,811 | : |
| Nagato et al. | : DECISION UPON REMAND AND |
| Issue Date: July 21, 2009 | : RECONSIDERATION OF |
| Application No. 11/174,514 | : PATENT TERM ADJUSTMENT |
| Filed: July 6, 2005 | : AND NOTICE OF INTENT |
| Attorney Docket No. 0425-0990PUS2 | : TO ISSUE CERTIFICATE OF CORRECTION |
| Title: 1,2-Dihyropyridine compounds, manufacturing method thereof and use thereof | : |

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 six hundred eighteen(618) 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 six hundred eighteen (618) 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 : 7,563,811

DATED : **July 21, 2009** **DRAFT**

INVENTOR(S) : Nagato 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 309 days

Delete the phrase "by 309 days" and insert – by 618 days--

PALM INTRANET

Day : Monday
Date: 8/2/2010
Time: 09:50:10

| PTA Calculations for Application: 11/174514 | | | |
|---|---|---|---|
| Application Filing Date: | 07/06/2005 | PTO Delay (PTO): | 380 |
| Issue Date of Patent: | 07/21/2009 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 70 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 618 |
| PTO Delay Adjustment: | 308 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 77 | 08/02/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 309 | | |
| 69.5 | 07/01/2009 | PTA 36 MONTHS | 47 | | |
| 69 | 07/21/2009 | PATENT ISSUE DATE USED IN PTA CALCULATION | 24 | | 59 |
| 68 | 06/19/2009 | EXPORT TO FINAL DATA CAPTURE | | | |
| 67 | 06/18/2009 | DISPATCH TO FDC | | | |
| 66 | 06/18/2009 | EMAIL NOTIFICATION | | | |
| 65 | 06/16/2009 | MAIL-RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE | | | |
| 64 | 06/15/2009 | RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE | | | |
| 64 | 06/15/2009 | RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE | | | |
| 63 | 06/14/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | | |
| 63 | 06/14/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 1 | |
| 62 | 05/08/2009 | FINISHED INITIAL DATA CAPTURE | | | |
| 61 | 02/27/2009 | PETITION ENTERED | | | |
| 60 | 03/09/2009 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 59 | 02/27/2009 | ISSUE FEE PAYMENT VERIFIED | | | |
| 58 | 02/27/2009 | ISSUE FEE PAYMENT RECEIVED | | | |
| 56 | 12/02/2008 | ELECTRONIC REVIEW | | | |
| 55 | 12/02/2008 | EMAIL NOTIFICATION | | | |
| 54 | 12/01/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 53 | 11/25/2008 | ISSUE REVISION COMPLETED | | | |
| 52 | 11/25/2008 | DOCUMENT VERIFICATION | | | |

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|---|---|---|---|---|---|
| 51 | 11/25/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 50 | 11/18/2008 | NOTICE OF ALLOWABILITY | | | |
| 47 | 11/03/2008 | DATE FORWARDED TO EXAMINER | | | |
| 46 | 10/26/2008 | AMENDMENT AFTER FINAL REJECTION | | 1 | 43 |
| 45 | 07/25/2008 | ELECTRONIC REVIEW | | | |
| 44 | 07/25/2008 | EMAIL NOTIFICATION | | | |
| 43 | 07/25/2008 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 42 | 07/21/2008 | FINAL REJECTION | | | |
| 40 | 05/13/2008 | DATE FORWARDED TO EXAMINER | | | |
| 39 | 04/09/2008 | RESPONSE AFTER NON-FINAL ACTION | | 69 | 34 |
| 38 | 04/09/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 37 | 04/09/2008 | CERTIFIED TRANSLATION OF FOREIGN PRIORITY DOCUMENT | | | |
| 36 | 11/01/2007 | ELECTRONIC REVIEW | | | |
| 35 | 10/31/2007 | EMAIL NOTIFICATION | | | |
| 34 | 10/31/2007 | MAIL NON-FINAL REJECTION | | | |
| 33 | 10/26/2007 | NON-FINAL REJECTION | | | |
| 32 | 07/06/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 31 | 12/21/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 30 | 07/24/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 29 | 07/24/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 25 | 08/16/2007 | DATE FORWARDED TO EXAMINER | | | |
| 24 | 08/13/2007 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 23 | 07/24/2007 | REFERENCE CAPTURE ON IDS | | | |
| 22 | 07/24/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 21 | 07/24/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 20 | 07/24/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 19 | 07/14/2007 | ELECTRONIC REVIEW | | | |
| 18 | 07/13/2007 | EMAIL NOTIFICATION | | | |
| 17 | 07/12/2007 | MAIL RESTRICTION REQUIREMENT | 309 | | -1 |
| 16 | 07/05/2007 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 15 | 06/28/2006 | PRELIMINARY AMENDMENT | | | |

| | | | | | |
|---|---|---|---|---|---|
| 14.7 | 12/21/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 14 | 12/21/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 13 | 10/14/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 12 | 10/14/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 11 | 07/06/2005 | REFERENCE CAPTURE ON IDS | | | |
| 10.7 | 07/06/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 10 | 07/06/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 9 | 07/06/2005 | PRELIMINARY AMENDMENT | | | |
| 8 | 07/25/2005 | APPLICATION RETURN FROM OIPE | | | |
| 7 | 07/26/2005 | APPLICATION IS NOW COMPLETE | | | |
| 6 | 07/25/2005 | APPLICATION RETURN TO OIPE | | | |
| 5 | 07/22/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 4 | 07/25/2005 | APPLICATION IS NOW COMPLETE | | | |
| 3 | 07/20/2005 | CLEARED BY OIPE CSR | | | |
| 2 | 07/18/2005 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 07/06/2005 | 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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**Suite 900**
**Washington, DC 20004**

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NOV 05 2010

**OFFICE OF PETITIONS**

In re Application of
Mark J. Stefik et al.
Application No. 11/174,654
Filed: July 6, 2005
Attorney Docket No. 111325-026900

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 10, 2010.

The request is **moot because a revocation of power of attorney has been filed.**

A review of the file record indicates that the power of attorney to Jeffrey L. Costellia and all attorneys/agents of record has been revoked by the assignee of the patent application on September 16, 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: Reed Smith, LLP
P.O. Box 488
Pittsburgh, PA 15230

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LEONARD TACHNER,
A PROFESSIONAL LAW CORPORATION
17961 SKY PARK CIRCLE, SUITE 38-E
IRVINE CA 92614

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FEB 27 2012

OFFICE OF PETITIONS

In re Patent No. 7,309,672
Issue Date: 18 December, 2007
Application No. 11/174,689
Filed: 5 July, 2005
Attorney Docket No. MOSK-173

DECISION

This is a decision on the petition filed on 16 December, 2011, under 37 C.F.R. §1.27(g)(2) requesting that status as a Small Entity be removed.

**NOTE**:

In view of their duty of candor to the Office to properly inquire to ascertain the accuracy of representations made before the Office (*see*: 37 C.F.R. §1.4, §10.18, MPEP §410), Petitioners always are reminded of the responsibility to review their records and submit accurate information to the Office.

Petitioners also are reminded to chart out the fees paid/fees due/balance due in their submission(s) to the Office. (*See, generally*: 37 C.F.R. §1.27, §1.28, MPEP §509.02 and 509-03.)

Petitioner's submission is **ACCEPTED**.

In accordance with the request, status as a Small Entity will be removed, and Petitioner is required to pay fees at the schedule set forth for not-small entities. **The additional fees were charged as authorized.**

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

In re Patent No. 7,309,672
Application No. 11/174,689

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

The instant application is released to the IFW Files Repository in due course.

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

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

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

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

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

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

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20110128B

**DATE** : April 20, 2011

**TO SPE OF** : ART UNIT 2627

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7729216

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

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

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

the request for corrections has been approved. /ME/ 1/28/2011

**SPE:** /Hoa Nguyen/, SPE **Art Unit** 2627

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AUG 3 1 2010

OFFICE OF PETITIONS

In re Patent No. 7,267,808 :
Issue Date: September 11, 2007 :
Application No. 11/174,723 :
Filed: July 6, 2005 :
Attorney Docket No. 018765-225 :

ON PETITION

This is a decision on the petition filed January 26, 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**.

The required certificate of correction fee of $100.00 has been charged to the authorized deposit account.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

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

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**KNOBLE, YOSHIDA & DUNLEAVY**
**EIGHT PENN CENTER**
**SUITE 1350, 1628 JOHN F. KENNEDY BLVD**
**PHILADELPHIA, PA 19103**

MAILED
OCT 08 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Susan HUBERMAN et al | : | |
| Application No. 11/174,871 | : | DECISION ON PETITION |
| Filed: July 5, 2005 | : | |
| Attorney Docket No. MBI-1036CON | : | |

This is a decision on the petition under 37 CFR 1.59(b), filed October 5, 2010, to expunge information from the above identified application. The petition will be considered under 37 CFR 1.181.

The petition is **GRANTED.**

Petitioner requests that a document filed August 2, 2010, , be expunged from the record. The proprietary information in question has been determined by the undersigned to not be material to the examination of the instant application.

In a paper file, the unintentionally submitted exhibits could, but not necessarily would, have been physically removed from the file wrapper and returned to applicant. In the IFW realm the corresponding action(s) is to close the document and also remove such from the listing of "Publicly available Documents." It is agreed that it would be appropriate in this instance to close the information in application serial no. 11/174,871, which was erroneously filed in the above identified application, and also remove such from the listing of publicly available documents for this Image File Wrapper (IFW). Petitioner understands that upon granting the petition, the image of the inadvertently recorded document would remain in the records, but that the link to said information in the application would be deleted.

Applicant is required to retain the expunged material(s) for the life of the patent which issued on the above-identified application.

The petitions fee of $200.00 required, and submitted under 37 CFR 1.59 will be refunded to petitioner's Deposit Account No. 50-0462.

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.

Telephone inquiries concerning this communication should be directed to the undersigned at 571-272-0602.

Thurman K. Page
Petitions Examiner
Office of Petitions

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**Robert F. Frijouf, Esquire**
**Frijouf, Rust & Pyle, P.A.**
**201 East Davis Boulevard**
**Tampa FL 33606**

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| | | |
|---|---|---|
| In re Application of | : | |
| Richard M. Silva et al. | : | |
| Application No. 11/174,907 | : | DECISION ON PETITION |
| Filed: July 5, 2005 | : | |
| Attorney Docket No. 2005-0058 | : | |

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

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue fee on or before June 1, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed March 1, 2010. Accordingly, the date of abandonment of this application is June 2, 2010. A Notice of Abandonment was mailed on June 21, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $755, (2) the petition fee of $810, and (3) a proper statement of unintentional delay. Accordingly, the issue fee is accepted as being unintentionally delayed.

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

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

/Kimberly A. Inabinet/

Kimberly A. Inabinet
Petitions Examiner
Office of Petitions

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Chrysler Group LLC
CIMS 483-02-19
800 CHRYSLER DR EAST
AUBURN HILLS MI 48326-2757

In re Patent No. 7,066,519
Issue Date: June 27, 2006
Application No. 11/174,923
Filed: July 5, 2005
Attorney Docket No. 706441US7

ON PETITION

This is a decision on the petition under 37 CFR 1.378(c), filed August 30, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on June 27, 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.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-3213.

The patent file is being forwarded to Files Repository.

Cheryl Gibson Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

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MIELE LAW GROUP PC
277 Main Street, Suite 209
Marlborough MA 01752

MAILED
NOV 16 2010
OFFICE OF PETITIONS

In re Application of :
MANCHALA, DANIEL W. : APPLICATION FOR PATENT
Application No. 11/174,943 : TERM ADJUSTMENT
Filed: 07/05/2005 :
Docket No. A3613-US-NP/XERX-P003US :

This is a decision on the Application for Patent Term Adjustment under 37 CFR 1.705(b) filed October 25, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is a minimum of one thousand six hundred ninety (1690) 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 **eight hundred eighteen (818) days**. A copy of the updated PAIR screen, showing the corrected determination, is enclosed.

Initially, applicants disclose that the period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(2) should be 104 days, not 149 days. The Office concurs with applicants.

Pursuant to 37 CFR 1.702(a), failure of the Office to respond to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken is a ground for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999. The phrase the date on which "an appeal was taken" in 35 U.S.C. 154(b)(i)(A)(ii) means the date on which an appeal brief (and not a notice of appeal) was filed. The phrase "appeal brief in compliance with 37 CFR 1.192" requires that: (i) the appeal brief fee (37 CFR 1.17(c)) be paid (37 CFR 1.192(a)); and (2) the appeal brief complies with 37 CFR 1.192(c)(i) through (c)(9). Accordingly, 37 CFR 1.703(a)(4) pertains to the provisions of 35 U.S.C. 154(b)(i)(A)(ii) and specifies that the period of adjustment for Office delay includes the number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 1.192 was filed and ending on the date of mailing of any of an examiner's answer under § 1.193, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

In this instance, an appeal brief was filed on November 24, 2009. On December 8, 2009, a notification of non-compliant appeal brief was mailed, stating that the brief was defective for failure to comply with one or more provisions of 37 CFR 41.37. On January 8, 2010, a corrected appeal brief was filed. On August 20, 2010, the Office mailed a notice of allowance four (4) months and 104 days after the filing of the appeal brief in compliance with 37 CFR 1.192. Thus, a period of adjustment of 104 days is warranted. Accordingly, the period of adjustment of 149 days is being removed and a period of adjustment of 104 days is being 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]

---

[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).

In view of the above, the patent term adjustment determination at the time of the mailing of the notice of allowance should be 818 days (819 days of Office delay - 1 days of applicant delay).

The Office will charge 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) to the Deposit Account as authorized.

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: 11/174,943

| | | | |
|---|---|---|---|
| Filing or 371(c) Date: | 07-05-2005 | Overlapping Days Between {A and B} or {A and C}: | 0 |
| Issue Date of Patent: | - | Non-Overlapping USPTO Delays: | 864 |
| A Delays: | 864 | PTO Manual Adjustments: | -45 |
| B Delays: | 0 | Applicant Delays: | 1 |
| C Delays: | 0 | Total PTA Adjustments: | 818 |

**Patent Term Adjustment History** **Explanation Of Calculations**

| Number | Date | Contents Description | PTO (Days) | APPL (Days) | Start |
|---|---|---|---|---|---|
| 68 | 11-15-2010 | Adjustment of PTA Calculation by PTO | 104 | | 0 |
| 67 | 11-15-2010 | Adjustment of PTA Calculation by PTO | | 149 | 0 |
| 59 | 08-20-2010 | Mail Notice of Allowance | 149 | | 47 |
| 58 | 08-19-2010 | Issue Revision Completed | | | 0 |
| 57 | 08-19-2010 | Document Verification | | | 0 |
| 56 | 08-19-2010 | Notice of Allowance Data Verification Completed | | | 0 |
| 55 | 08-12-2010 | Examiner's Amendment Communication | | | 0 |
| 54 | 08-12-2010 | Notice of Allowability | | | 0 |
| 53 | 02-01-2010 | Appeal Brief Review Complete | | | 0 |
| 52 | 02-01-2010 | Date Forwarded to Examiner | | | 0 |
| 51 | 01-08-2010 | Appeal Brief Filed | | | 0 |
| 50 | 12-08-2009 | Notice -- Defective Appeal Brief | | | 0 |
| 49 | 12-08-2009 | Appeal Brief Review Complete | | | 0 |
| 48 | 12-08-2009 | Date Forwarded to Examiner | | | 0 |
| 47.1 | 11-24-2009 | Defective / Incomplete Appeal Brief Filed | | | 0 |
| 47 | 11-24-2009 | Appeal Brief Filed | | | 0 |
| 46 | 09-23-2009 | Notice of Appeal Filed | | | 0 |
| 45 | 09-01-2009 | Mail Advisory Action (PTOL - 303) | | | 0 |

| | | | | | |
|---|---|---|---|---|---|
| 44 | 08-29-2009 | Advisory Action (PTOL-303) | | | 0 |
| 43 | 08-27-2009 | Date Forwarded to Examiner | | | 0 |
| 42 | 08-24-2009 | Amendment after Final Rejection | | | 0 |
| 41 | 06-23-2009 | Mail Final Rejection (PTOL - 326) | | | 0 |
| 40 | 06-19-2009 | Final Rejection | | | 0 |
| 36 | 06-15-2009 | Date Forwarded to Examiner | | | 0 |
| 35 | 06-05-2009 | Amendment after Final Rejection | | | 0 |
| 34 | 03-05-2009 | Mail Final Rejection (PTOL - 326) | | | 0 |
| 33 | 03-02-2009 | Final Rejection | | | 0 |
| 30 | 12-19-2008 | Date Forwarded to Examiner | | | 0 |
| 29 | 11-21-2008 | Response after Non-Final Action | | 1 | 25 |
| 28 | 11-21-2008 | Request for Extension of Time - Granted | | | 0 |
| 27 | 11-16-2008 | Case Docketed to Examiner in GAU | | | 0 |
| 26 | 08-29-2008 | Case Docketed to Examiner in GAU | | | 0 |
| 25 | 08-20-2008 | Mail Non-Final Rejection | 715 | | -1 |
| 24 | 08-18-2008 | Non-Final Rejection | | | 0 |
| 21 | 07-05-2005 | Information Disclosure Statement considered | | | 0 |
| 20 | 04-17-2008 | Case Docketed to Examiner in GAU | | | 0 |
| 19 | 01-07-2008 | Correspondence Address Change | | | 0 |
| 18 | 06-29-2007 | Correspondence Address Change | | | 0 |
| 17 | 01-11-2007 | PG-Pub Issue Notification | | | 0 |
| 16 | 04-28-2006 | Case Docketed to Examiner in GAU | | | 0 |
| 15 | 02-27-2006 | Miscellaneous Incoming Letter | | | 0 |
| 14 | 08-18-2005 | IFW TSS Processing by Tech Center Complete | | | 0 |
| 13 | 08-18-2005 | Case Docketed to Examiner in GAU | | | 0 |

| | | | |
|---|---|---|---|
| 12 | 07-05-2005 | Reference capture on IDS | 0 |
| 11.7 | 07-05-2005 | Information Disclosure Statement (IDS) Filed | 0 |
| 11 | 07-05-2005 | Information Disclosure Statement (IDS) Filed | 0 |
| 10 | 08-12-2005 | Cleared by L&R (LARS) | 0 |
| 9 | 08-11-2005 | Application Return from OIPE | 0 |
| 8 | 08-11-2005 | Application Is Now Complete | 0 |
| 7 | 08-11-2005 | Application Return TO OIPE | 0 |
| 6 | 08-11-2005 | Application Dispatched from OIPE | 0 |
| 5 | 08-11-2005 | Application Is Now Complete | 0 |
| 4 | 07-20-2005 | Referred to Level 2 (LARS) by OIPE CSR | 0 |
| 3 | 07-20-2005 | CASE CLASSIFIED BY OIPE | 0 |
| 2 | 07-18-2005 | IFW Scan & PACR Auto Security Review | 0 |
| 1 | 07-05-2005 | Initial Exam Team nn | 0 |

**Close Window**

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JUL 21 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,860,801 | : | DECISION ON APPLICATION |
| MANCHALA, DANIEL W. | : | FOR RECONSIDERATION OF |
| Issue Date: 12/28/2010 | : | PATENT TERM ADJUSTMENT |
| Application No. 11/174,943 | : | AND NOTICE OF INTENT TO |
| Filing Date: 07/05/2005 | : | ISSUE CERTIFICATE OF |
| Docket No. A3613-US-NP/XERX-P003US | : | CORRECTION |

This is a decision on the petition filed on February 7, 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 twenty-two (1622) 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 two hundred eighty-eight (1288) days.**

In the present petition, patentee acknowledges 819 days of A delay, 104 days of overlap, and 1 day of applicant delay. However, patentee disputes the 574 days of B delay. Patentee's argument has been considered, but not found persuasive.

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). In this instance, the "over three year period" is 906 days, beginning on July 6, 2008, the date after the date

that is three years after the filing date of the application and ending on December 28, 2010, the date the patent issued.

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, 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 period consumed by appellate review is three hundred thirty-two (332) days, beginning on September 23, 2009, the date of filing of the notice of appeal and ending on August 20, 2010, the subsequent date of the mailing of the Notice of Allowance. Thus, B delay is 574 (906 - 332) days.

Accordingly, the patent term adjustment is 1288 days (819 days of A delay + 574 days of B delay - 104 days of overlap - 1 day 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.

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, Patentee is 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.

The Office will charge the $200.00 fee set forth in 37 CFR 1.18(e) to the Deposit Account as authorized. No additional fees are required.

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 two hundred eighty-eight (1288) 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

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,860,801 B2

DATED : Dec. 28, 2010

INVENTOR(S) : Manchala

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 (1243) days.

Delete the phrase "by 1243 days" and insert – by 1288 days--

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS MI 48303

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OFFICE OF PETITIONS

In re Patent No. 7,609,404
Issued: October 27, 2009
Application No. 11/174,953
Filed: July 5, 2005
Attorney Docket No. 9319G-001184/US

: LETTER REGARDING
: PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT" filed on May 21, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 1148 days to 1313 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.

It is undisputed that the period of examination delay, "A" delay", pursuant to 37 CFR 1.702(a)(1) is 671 days and the "B" delay period, the over three year period begins on July 5, 2008 and ends on October 27, 2009, the day the patent was issued. However, a period of overlap begins on July 5, 2008, and ends on December 17, 2008, the period of overlap is 165 days, and therefore, considering the 165 days of overlap, the "B" delay is 479 days. As such, the patent term adjustment is 1148 days (834 plus 479 minus 165 overlap minus 0 applicant delay), not 1313 days.

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

Telephone inquiries specific to this 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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In re Patent No. 7148422
Issue Date: December 12,2006
Application No. 11175058
Filed: July 5,2005
Attorney Docket No. IG-40100 (71024-908)

:

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

:

This is a decision on the electronic petition, filed August 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 August 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.

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) |
|---|---|---|---|---|
| 7148422 | 2006-12-12 | 11175058 | 2005-07-05 | FOUR B-2255 |

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 | /wrg/ | Date (YYYY-MM-DD) | 2011-08-04 |
| Name | William R. Gustavson | Registration Number | 29160 |

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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**Alexandria VA 22314**

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JAN 24 2011
OFFICE OF PETITIONS

In re Patent No. 7,092,107 :
Issue Date: August 15, 2006 :
Application No. 11/175,186 : NOTICE
Filed: July 7, 2005 :
Attorney Docket No. 25582AY :

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. The petition is **GRANTED**.

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

This file is being forwarded to Files Repository.

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

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

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**CHANTILLY VA 20153-0746**

**MAILED**

AUG 30 2010

**OFFICE OF PETITIONS**

ON PETITION

| | | |
|---|---|---|
| In re Patent No. 7,554,699 | : | |
| Issue Date: June 30, 2009 | : | |
| Application No. 11/175,203 | : | |
| Filed: July 7, 2005 | : | |
| Attorney Docket No. PB0814 | : | |

This is a decision on the petition filed June 29, 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.

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Paper No.

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

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SEP 13 2010
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| | | |
|---|---|---|
| In re Patent No. 7,622,181 | : | DECISION ON REQUEST |
| Miyakawa et al. | : | FOR |
| Issue Date: November 24, 2009 | : | RECONSIDERATION OF |
| Application No. 11/175,259 | : | PATENT TERM ADJUSTMENT |
| Filed: July 7, 2005 | : | and |
| Atty Docket No. 1642.1001C | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on (Monday) January 25, 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 fifty-two (752) 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 fifty-two (752) days is **GRANTED.**

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. 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 **seven hundred fifty-two (752)** 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 : 7,622,181 B2

DATED : **November 24, 2009** **DRAFT**

INVENTOR(S) : Miyakawa 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 247 days

Delete the phrase "by 247 days" and insert – by 752 days--

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**Nixon Peabody, LLP**
**401 Ninth Street, NW**
**Suite 900**
**Washington, DC 20004**

MAILED

NOV 05 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Mark J. Stefik et al. | : | |
| Application No. 11/175,452 | : | DECISION ON PETITION |
| Filed: July 7, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 111325-028200 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 10, 2010.

The request is **moot because a revocation of power of attorney has been filed.**

A review of the file record indicates that the power of attorney to Jeffrey L. Costellia and all attorneys/agents of record has been revoked by the assignee of the patent application on September 16, 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: Reed Smith, LLP
P.O. Box 488
Pittsburgh, PA 15230

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ONE NORTH LASALLE STREET
44TH FLOOR
CHICAGO IL 60602

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SEP 23 2010

OFFICE OF PETITIONS

In re Application of

Dragovic, et al.

Application No. 11/175,464

Filed: July 6, 2005

Attorney Docket No. Dragovic 1-31-1

DECISION ON PETITION

This is a decision on the renewed petition to withdraw the holding of abandonment under 37 CFR 1.181(a), filed August 4, 2010.

The petition is **granted**.

This application was held abandoned May 2, 2008, after no reply was received to the Notice Requiring Excess Claim Fees, mailed April 1, 2008. The notice set forth a shortened extendable period of reply of one month from its mailing date. No response was received within the allowable period and the application became abandoned on May 2, 2008. A Notice of Abandonment was mailed March 19, 2009. The instant petition was filed on April 14, 2009. Petitioner maintains that the notice of April 1, 2008, was never received.

When, as in this case petitioner is arguing that an Office communication was not received, petitioner must establish non-receipt of the Office communication in accordance with section 711.03(c) of the *Manual of Patent Examining Procedure* that requires the following:

> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

> Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

Petitioner has met the burden of proof as established by Section 711.03(c)(II) of the MPEP. The holding of abandonment is, therefore, withdrawn.

The application file is being forwarded to Technology Center 2600, GAU 2613 for further processing that will include remailing the Notice Requiring Excess Claim Fees and resetting of the period for reply.

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

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450

**Mr. Henri Duong**
**316 ½ E. Glendon Way**
**Alhambra, California 91801**

MAILED

JAN 21 2011

OFFICE OF PETITIONS

In re Application of :
Henri DUONG : DECISION DISMISSING PETITION
Application No. 11/175,645 : UNDER 37 CFR 1.181
Filed: 6 July 2005 :

This is in response to the communications, filed January 13, 2009 and supplemented on March 19, 2010 and September 17, 2010, which are being treated as a petition to withdraw the holding of abandonment.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be submitted within two (2) months from the mail date of this decision and be entitled "Renewed Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181." See 37 CFR 1.181(f).

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed January 28, 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) was obtained. Accordingly, the application became abandoned on April 29, 2008.

Petitioner requests that the holding of abandonment be withdrawn because he was not informed that an Appeal Brief was required after the filing of a Notice of Appeal.

**DISCUSSION OF PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

Petitioner filed a Notice of Appeal on March 19, 2008. Unfortunately, the Notice of Appeal was not accompanied by the proper fee. This fee deficiency was corrected on July 18, 2008; however, petitioner failed to include the required three (3) month extension of time under 37 CFR 1.136(a). Therefore, the Notice of Appeal was untimely.

**In view of the above, the petition is dismissed as holding of abandonment may not be withdrawn at this time as petitioner's reply was untimely.**

**ALTERNATIVE VENUE**

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

> (1) The reply required to the outstanding Office action or notice, unless previously
> filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR 1.111 or (B) a continuing application under 37 CFR 1.53(b).
>
> (2) The petition fee as set forth in 37 CFR 1.17(m), **$810.00 for a small entity**;
>
> (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. The Director may require additional information where there is a question whether the delay was unintentional.

As 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 August 13, 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 (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). In this application petitioner may request the previously submitted untimely Notice of Appeal and appeal fee be entered as the required reply.

A form for filing a petition to revive an unintentionally abandoned application accompanies this decision for petitioner's convenience. If petitioner desires to file a petition under 37 CFR 1.137(b) instead of filing a request for reconsideration, petitioner must complete the enclosed petition form (PTO/SB/64) and pay the $810.00 petition fee.

Petitioner may wish to consider hiring a registered patent attorney or agent to assist in the prosecution of this application. Additionally, petitioner is encouraged to contact the Inventors Assistance Center (IAC) by telephone at 800-786-9199 or 571-272-1000, Monday through Friday from 8:30 AM to 5:30 PM (EST). The IAC provides patent information and services to the public and is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

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 (571-272-6051), or, if unavailable, the undersigned at 571-272-7099.

David Bucci
Petitions Examiner
Office of Petitions

Enclosures.
Form PTO/SB/64, Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450

**Mr. Henri Duong**
**316 ½ Glendon Way**
**Alhambra, California 91801**

MAILED
MAY 12 2011
OFFICE OF PETITIONS

In re Application of :
Henri DUONG : ON PETITION
Application No. 11/175,645 :
Filed: July 6, 2005 :

This is a decision on the request for reconsideration, filed January 31, 2011, requesting withdrawal of the holding of abandonment in the above-identified application, that is being treated under 37 CFR 1.181.

The petition is **DISMISSED.**

Any request for reconsideration of this decision should be filed within TWO (2) MONTHS from the mailing 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."

In Petitioner's Request for Reconsideration, Petitioner asserts that total fees for the Notice of Appeal were received (by the Office) on July 18, 2008, and therefore the Notice of Appeal was timely filed. Petitioner's states,

> "Your Advisory Action of 03/12/2008 indicates that (b) the date set forth in SIX MONTHS from the mailing date of the final rejection."

Petitioner should note that the SIX MONTH period refers to the <u>maximum extendable period</u> for replying to the final Office action. Petitioner should note the following text that follows 1(b) in the Advisory Action,

> 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.

In this instance, the final Office action was mailed on January 28, 2010, that set a shortened statutory period of reply of 3 months. Accordingly, a reply was due on or

before April 28, 2010, or, on or before July 28, 2010 with a three-month extension of time.

Petitioner filed a Notice of Appeal on March 19, 2008. Unfortunately, the Notice of Appeal was not accompanied by the proper fee. This fee deficiency was corrected on July 18, 2008; however, petitioner failed to include the required three (3) month extension of time under 37 CFR 1.136(a). As an extension of time was not purchased, the Notice of Appeal was untimely filed.

**In view of the above, the application became abandoned by law on April 29, 2008. Accordingly, the instant petition is dismissed.**

**ALTERNATIVE VENUE**

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) The reply required by the outstanding Office action or notice, unless previously filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR 1.111 or (B) a continuing application under 37 CFR 1.53(b).

(2) The petition fee as set forth in 37 CFR 1.17(m), **$810.00 for a small entity;**

(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. The Director may require additional information where there is a question whether the delay was unintentional.

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 August 13, 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 (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). In this application petitioner may request the previously submitted untimely Notice of Appeal and appeal fee be entered as the required reply.

A form for filing a petition to revive an unintentionally abandoned application accompanies this decision for petitioner's convenience. If petitioner desires to file a petition under 37 CFR 1.137(b) instead of filing a request for reconsideration, petitioner must complete the enclosed petition form (PTO/SB/64) and pay the $810.00 petition fee.

Petitioner may wish to consider hiring a registered patent attorney or agent to assist in the prosecution of this application. Additionally, petitioner is encouraged to contact the Inventors Assistance Center (IAC) by telephone at 800-786-9199 or 571-272-1000, Monday through Friday from 8:30AM to 5:30PM (EST). The IAC provides patent information and services to the public and is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

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

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Alexandria, Virginia 22313-1450

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Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

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

General inquiries relating to this decision should be directed to Robert DeWitty (571-272-8427).

for Ramesh Krishnamurthy

David Bucci
Petitions Examiner
Office of Petitions

Enclosures.
Form PTO/SB/64, Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b).

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**P O BOX 655474, M/S 3999**
**DALLAS, TX 75265**

**MAILED**

AUG 01 2011

**OFFICE OF PETITIONS**

In re Application of :
**Christian SORACE**, et *al.* :
Application No. 11/175,784 : DECISION ON PETITION
Filed: July 5, 2005 : UNDER 37 CFR 1.137(b)
Attorney Docket No. **TI-37137** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 12, 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 August 5, 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 November 6, 2010.

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 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 $1620; and (3) an adequate statement of unintentional delay.

Application No. 11/175,784

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 2614 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.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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**P O BOX 655474, M/S 3999**
**DALLAS, TX 75265**

**MAILED**

JAN 11 2011

**OFFICE OF PETITIONS**

In re Application of :
**Paolo CUSINATO**, et *al.* :
Application No. 11/175,785 :
Filed: July 5, 2005 :
Attorney Docket No. **TI-37136** :

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 11, 2010, 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 reply within the meaning of 37 CFR 1.113 to the final Office action, mailed December 22, 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 March 23, 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 petition lacks item (3). In this regard, the unintentional statement provided is considered improper because it does not cover the period of March 23, 2010 to August 11, 2010.

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

By Mail: Mail Stop PETITION
Commissioner for Patents
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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 Monica A. Graves at (571) 272-7253.

Thurman K. Page
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUL 28 2011
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| | | |
|---|---|---|
| In re Application of | : | |
| **Paolo CUSINATO**, et *al.* | : | |
| Application No. 11/175,785 | : | DECISION ON PETITION |
| Filed: July 5, 2005 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. **TI-37136** | : | |

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed January 14, 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 December 22, 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 March 23, 2010.

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 requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal, Appeal Brief; (2) the petition fee of $1620; and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 2614 for appropriate action by the Examiner in the normal course of business on the Notice of Appeal and Appeal Brief filed August 11, 2010.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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NEIL STEINBERG
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WASHINGTON, DC 20037

| | | |
|---|---|---|
| In re Application of Narendran | : | |
| Application No. 11/175,860 | : | Decision on Petition |
| Filing Date: July 6, 2005 | : | |
| Attorney Docket No. 311.001 | : | |

This is a decision on the petition filed under 37 CFR 1.137(b) on March 7, 2011, which requests revival of the above-identified application.

The petition is **granted**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 26, 2010, which set a shortened statutory period for reply of three (3) months. An extension of time under the provisions of 37 CFR 1.136(a) was not obtained. Accordingly, the above-identified application became abandoned on August 27, 2010. A Notice of Abandonment was mailed on December 22, 2010.

The instant petition requests revival of the application.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed,
(2) The petition fee,
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) A terminal disclaimer and fee if the application was filed on or before June 8, 1995, or if the application is a design application.

The petition satisfies the requirements of 37 CFR 1.137(b) in so far as petitioner has supplied a reply to the outstanding Office action in the form of an amendment, the required petition fee of $810, and the required statement of unintentional delay. Therefore, the petition is granted and the application is hereby revived.

Technology Center Art Unit 2464 will be informed of the instant decision and the application will be further examined in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions